

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/1. THE PATENT SYSTEM/(1) INTRODUCTION/301. Rationale of the patent system.

PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)

1. THE PATENT SYSTEM

(1) INTRODUCTION

301. Rationale of the patent system.

The basic purpose of the patent system is to encourage innovation and the improvement of industrial techniques¹. In return for the disclosure of his invention² the inventor³ is given a monopoly in the use of it for a period of 20 years⁴ after which time it passes into the public domain.

It is not mandatory to obtain a patent⁵ in order to protect a new invention; the inventor may instead choose to keep the details secret. Indeed, not all technical developments are patentable⁶. Tricks of the trade, detailed process specifications and modes of operation which do not involve an inventive step⁷ may, therefore, be unpatentable, although they are capable of protection as trade secrets or know-how⁸. As a matter of public policy, discoveries, scientific theories and mathematical methods are not patentable⁹. Products whose novelty resides in the design and not in the function are not patentable¹⁰ but may be protected either as a registered design¹¹ or by means of copyright¹² or by means of unregistered design right¹³.

1 See the Report of the Banks Committee on the British Patent System 1970 (Cmnd 4407) para 1; White Paper on Patent Law Reform 1975 (Cmnd 6000) paras 1-4; Gowers Review of Intellectual Property (December 2006) paras 1.4-1.8.

2 The Patents Act 1977 contains no statutory definition of 'invention' but instead prescribes the criteria to be satisfied by a 'patentable invention': see s 1(1); and PARA 430. For the purposes of the Patents Act 1977, however, an invention for a patent for which an application has been made or for which a patent has been granted is, unless the context otherwise requires, taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification; and the extent of the protection conferred by a patent or application for a patent is to be determined accordingly: s 125(1).

3 For these purposes, 'inventor' means, in relation to an invention, the actual deviser of the invention; and 'joint inventor' is to be construed accordingly: Patents Act 1977 ss 7(3), 130(1). Where a person comes up with and communicates an idea consisting of all the elements in a claim, even though it is just an idea at that stage, he is normally an inventor: *Stanelco Fibre Optics Ltd's Applications* [2004] EWHC 2263 (Pat), [2005] RPC 319. To be regarded as an inventor a person must have been responsible for the inventive concept and have contributed to that invention: *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693 (affd [1999] RPC 442, [1998] All ER (D) 545, CA); *Markem Corpn v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 761; *University of Southampton's Applications* [2006] EWCA Civ 145, [2006] RPC 567; *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2007] UKHL 43, [2008] 1 All ER 425, [2008] RPC 1.

4 As to the term of patents see PARA 339 et seq.

5 As to the meaning of 'patent' see PARA 303.

6 As to the criteria of patentability in respect of inventions see the Patents Act 1977 s 1(1); and PARA 430.

7 It is a criterion of patentability that the invention involves an inventive step: see the Patents Act 1977 s 1(1)(b); and PARA 430.

8 Trade secrets, know-how and non-patented inventions may be protected by means of a claim for breach of confidence: see **EQUITY** vol 16(2) (Reissue) PARA 855. Information of a confidential nature, supplied for one purpose, may not be used by the recipient for other purposes to the detriment of the owner of the information: *Cranleigh Precision Engineering Ltd v Bryant* [1964] 3 All ER 289, [1965] 1 WLR 1293, [1966] RPC 81.

9 See the Patents Act 1977 s 1(2)(a); and PARA 431.

10 See the Patents Act 1977 s 1(2)(b); and PARA 431.

11 As a design registered under the Registered Designs Act 1949: see PARA 681 et seq. The effect of registration is to give to the registered proprietor the exclusive right of commercial exploitation of the registered design: see s 7(1); and PARA 762.

12 See **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 3 et seq.

13 See **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 10.

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302. Historical development of the patent system.

Patents giving monopolies for new inventions were first granted by Elizabeth I to encourage the establishment of new industries within the realm. The power to grant such monopolies was abused by the Stuarts and in 1623 Parliament secured the passing of the Statute of Monopolies¹, which restricted monopolies already granted² and prohibited the granting of new monopolies, except to the true and first inventors of a manner of new manufacture, which others at the time of the grant were not using³. Modern patent legislation⁴ dates from the establishment of the Patent Office in 1853⁵ and the Patents, Designs and Trade Marks Act 1883⁶, which established the practice of examination by the Patent Office of the patent specification before grant⁷. The official search through prior specifications to establish novelty⁸ dates from the Patents and Designs Act 1907⁹. A major recasting of the statutory provisions took place in 1949 in the Patents Act 1949¹⁰. In respect of patents granted on applications filed on or after 1 June 1978¹¹ the Patents Act 1949 was replaced by the Patents Act 1977, itself amended and supplemented by the Copyright, Designs and Patents Act 1988 and by the Patents Act 2004.

To obtain protection of patent rights outside the United Kingdom, an application must normally be made to the national offices in the individual countries. Protection can be obtained throughout Europe by application to the European Patent Office under the European Patent Convention¹² and may be facilitated in many other countries through the Patent Co-operation Treaty¹³.

1 Ie the Statute of Monopolies (1623), now largely superseded, but see s 6; and note 3.

2 Statute of Monopolies (1623) s 1.

3 Statute of Monopolies (1623) s 6. The grant was for a term not exceeding 14 years: s 6. As to the term of modern patents see PARA 339 et seq.

4 As to current legislation generally see PARA 304.

5 Ie under the Patent Law Amendment Act 1852 (repealed). As to the modern Patent Office see PARA 579. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 This Act has been repealed.

7 For the modern procedure see PARAS 328-329.

8 See PARA 329.

9 Much of this Act has been repealed: see PARA 304.

10 A patent under the Patents Act 1949 was a grant from the Crown of a monopoly and was a matter of the Sovereign's grace. The patent was granted in a form authorised by rules made under statutory power, and was sealed with the seal of the Patent Office, which had the same effect as if the patent were sealed, as patents used to be, with the Great Seal of the United Kingdom: see the Patents Act 1949 s 21 (repealed). A patent under the Patents Act 1949 had effect throughout the United Kingdom and the Isle of Man.

11 Ie the date on which the Patents Act 1977 largely came into force: see PARA 304. In respect of patents granted on applications filed before 1 June 1978 the Patents Act 1949 continued to apply, subject to modifications, together with certain provisions of the Patents Act 1977: see s 127, Schs 1, 2 (Sch 1 amended by

the Copyright, Designs and Patents Act 1988 ss 293, 294; the Patents Act 1977 Sch 2 amended by the Supreme Court Act 1981 s 152(4), Sch 7). All such patents have now expired.

12 See PARA 668 et seq.

13 See PARA 653 et seq.

UPDATE

302 Historical development of the patent system

NOTE 11--Supreme Court Act 1981 now cited as Senior Courts Act 1981: Constitutional Reform Act 2005 Sch 11 para 1 (in force 1 October 2009: SI 2009/1604).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/1. THE PATENT SYSTEM/(1) INTRODUCTION/303. Meaning of 'patent'.

303. Meaning of 'patent'.

The word 'patent'¹ as used in this title denotes a monopoly right in respect of an invention. A patent is a collection of rights conferred by the Patents Act 1977 in respect of a patentable invention². A certificate that a patent has been granted is in a form authorised by rules made pursuant to the Act³ and must include the name of the proprietor, the date of filing of the application and the number of the patent⁴. A patent has effect throughout the United Kingdom⁵ and the Isle of Man⁶.

Patents and applications for them are personal property but without being things in action⁷.

1 The term 'patent' (short for 'letters patent') is derived from the fact that the forms of grant were *litterae patentes*, or open letters, being addressed to all to whom they may come. The term now bears none of its original meaning and the 'grant' is purely notional: see PARA 338. As to current legislation generally see PARA 304.

In the Patents Act 1977 'patent' means a patent under that Act (s 130(1)). As to the meaning of 'invention' see PARA 301 note 2. The term 'patent' also includes, unless the context otherwise requires, a patent granted on an international application for a patent (UK) (ie an application filed under the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340)), which is treated as an application under the Patents Act 1977: see s 89; and PARA 664. Similarly, a European patent (UK) (ie a patent granted under the Convention on the Grant of European Patents (the European Patent Convention) (Munich, 5 October 1973; TS 20 (1978); Cmnd 7090) designating the United Kingdom: see PARA 668 et seq) is treated as a patent granted under the Patents Act 1977: see s 77; and PARA 675.

2 See the Patents Act 1977 s 60 (acts which, if done without the consent of the proprietor of the patent, infringe the patent: see PARA 512). As to the meaning of 'patentable invention' see PARA 430.

3 See the Patents Act 1977 s 24(2); and PARA 338.

4 See the Patents Rules 2007, SI 2007/3291, r 34; and PARA 338.

5 'United Kingdom' means Great Britain and Northern Ireland: Interpretation Act 1978 s 5, Sch 1. 'Great Britain' means England, Scotland and Wales: Union with Scotland Act 1706 preamble art 1; Interpretation Act 1978 s 22(1), Sch 2 para 5(a). Neither the Isle of Man nor the Channel Islands are within the United Kingdom. The Patents Act 1977 does, however, extend to the Isle of Man, subject to any modifications contained in an Order made by Her Majesty in Council and accordingly, subject to any such order, references in the Patents Act 1977 to the United Kingdom are to be construed as including references to the Isle of Man: s 132(2). In exercise of the power so conferred the Patents Act 1977 (Isle of Man) Order 2003, SI 2003/1249, has been made. As to the territorial scope of the legislation generally see PARA 305.

6 See the Patents Act 1977 s 132(2). As to territorial scope generally see PARA 305.

7 Patents Act 1977 s 30(1). This reverses the position at common law, where a patent was held to be in the nature of a chose in action: see **CHOSES IN ACTION** vol 13 (2009) PARA 4. As to patents as personal property see **PERSONAL PROPERTY** vol 35 (Reissue) PARA 1204.

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(2) LEGISLATION

304. Legislation in force.

The current legislation relating to patents consists primarily of the Patents Act 1977¹, amended and supplemented by the Copyright, Designs and Patents Act 1988, the Patents Act 2004 and the Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007².

Prior to this, the Patents Act 1949 consolidated the bulk of the pre-existing patent law³ as laid down by the Patents and Designs Act 1907 and a long series of amending Acts⁴, ending with the Patents and Designs Act 1949⁵. The Patents Act 1949 was replaced by the Patents Act 1977 in respect of patents granted on applications filed on or after 1 June 1978⁶. The Patents Act 1977 established a new code of domestic patent law and gives effect in the United Kingdom⁷ to certain international conventions and treaties⁸.

The Patents Act 1977 fulfils two functions:

- 1 (1) to harmonise internal United Kingdom patent law with European law⁹ and to enable international applications filed through the Patent Co-operation Treaty¹⁰ to enter the United Kingdom patent system¹¹; and
- 2 (2) to modernise United Kingdom patent law¹².

The main changes resulting from the Patents Act 1977 were:

- 3 (a) the introduction of a statutory definition of 'infringement' and the widening of the class of infringing acts to include so-called contributory infringement¹³;
- 4 (b) the removal of opposition before grant¹⁴;
- 5 (c) the narrowing of the grounds of revocation¹⁵; in particular the removal of the grounds of prior claiming, false suggestion, lack of utility and secret prior use;
- 6 (d) the provision of 'compensation' for employee-inventors where patents for their inventions are outstandingly successful¹⁶;
- 7 (e) the removal of special provisions for compulsory licences for food and medicines¹⁷;
- 8 (f) the extension of the term of a patent to 20 years, with no provision for extension¹⁸;
- 9 (g) the abolition of provisional specifications, the old system of provisional patenting being replaced by a comparable provision for claiming priority from earlier applications¹⁹.

The Patents Act 1977 does not, however, form a complete code²⁰. Many of the expressions in it are only intelligible by reference to decisions under earlier Acts²¹, and many matters are covered by rules of practice²². Details of the UK Intellectual Property Office procedure are in large part laid down by the Patents Rules 2007²³. In addition, certain agreements relating to patents are covered by European and international law²⁴.

1 As to the historical development of the patent system see PARA 302.

2 le the Patents (Compulsory Licensing and Supplementary Protection Certificates) Regulations 2007, SI 2007/3293.

3 Only the Patents and Designs Act 1907 ss 62(1)-(3), 63 and s 64 (see PARA 579) remain in force. As to the repeal of the remainder of the legislation see note 5.

4 The Patents and Designs Act 1907 has at various times been reprinted with amendments, the last occasion being under the authority of the Patents and Designs Act 1946 s 8(4) (repealed).

5 The Patents and Designs Act 1907 and the various Acts amending it were repealed by the Patents Act 1949 s 106(1), Sch 2, the Registered Designs Act 1949 s 48(1), Sch 2, the Patents Act 1977 s 132(7), Sch 6, the Statute Law (Repeals) Act 1986 s 1, Sch 1 Pt VI and the Patents, Designs and Marks Act 1986 s 3(2), Sch 3 Pt II, except for the provisions cited in note 3. The Patents Act 1949 was amended by (inter alia) the Patents Act 1957, the Defence Contracts Act 1958 and the Patents Act 1977.

6 No application for a patent could be made under the Patents Act 1949 on or after 1 June 1978: see the Patents Act 1977 s 127(1). Existing patents granted under the Patents Act 1949 expired after a 20-year period (see the Patents Act 1977 s 127, Sch 1 para 4) and so the provisions of the Patents Act 1949 which were preserved by the Patents Act 1977 to govern such patents have lapsed, all such patents having expired. The remainder of the Patents Act 1949 was repealed: see the Patents Act 1977 ss 127(5), 132(7), Schs 3, 6.

7 As to the meaning of 'United Kingdom' see PARA 303 note 5.

8 le the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) (see PARA 653 et seq); the Convention on the Grant of European Patents (Munich, 5 October 1973; TS 20 (1978); Cmnd 7090) (see PARA 668 et seq); and the Patent Law Treaty (Geneva, 1 June 2000; TS 6 (2006); Cm 6779) (see PARA 680).

9 See PARA 668 et seq.

10 le the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340): see PARAS 653-663.

11 See the Patents Act 1977 ss 89-89B; and PARAS 664-667.

12 See generally the White Paper on Patent Law Reform 1975 (Cmnd 6000).

13 See the Patents Act 1977 s 60; and PARAS 512-516.

14 A patent can be revoked by the comptroller or the court on a number of specified grounds: see the Patents Act 1977 ss 72, 73; and PARAS 430 et seq, 571.

15 See the Patents Act 1977 s 72; and PARA 430 et seq.

16 See the Patents Act 1977 ss 40-43; and PARA 370 et seq.

17 See, however, the requirement for a supplementary protection certificate under the Patents Act 1977 s 128B, Sch 4A (see PARA 341 et seq).

18 See the Patents Act 1977 s 25; and PARA 339.

19 See the Patents Act 1977 s 15(1); and PARA 316.

20 In addition to the extant provisions of the earlier legislation cited in note 3, certain other enactments directly relate to patent law eg the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 (see PARAS 391, 401, 592; and **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARAS 32, 33, 504); the Crown Proceedings Act 1947 s 3 (see PARAS 404, 525; and **CROWN PROCEEDINGS AND CROWN PRACTICE** vol 12(1) (Reissue) PARA 113); and the Income and Corporation Taxes Act 1988 Pt XIII (ss 524-533) (see **INCOME TAXATION** vol 23(1) (Reissue) PARA 1484 et seq).

21 This is notably so in the provisions concerned with invalidity (see PARA 430 et seq).

22 Some such matters are reported, as official rulings or as decisions upon individual cases, in the Reports of Patent Cases (RPC) (see PARA 580); some are unpublished.

23 le the Patents Rules 2007, SI 2007/3291, which came into force on 17 December 2007 (see r 1). Certain provisions of the Patents Rules 1995, SI 1995/2093, have been preserved in relation to proceedings commenced before that date: see the Patents Rules 2007, SI 2007/3291, r 120(1), Sch 5. The UK Intellectual

Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

24 See PARA 652 et seq.

UPDATE

304 Legislation in force

NOTE 23--SI 2007/3291 amended: SI 2009/546.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/1. THE PATENT SYSTEM/(2) LEGISLATION/305. Territorial scope of legislation.

305. Territorial scope of legislation.

The patents legislation¹ has effect throughout the United Kingdom² and the Isle of Man, subject to modifications in its application to Scotland, Northern Ireland and the Isle of Man³. For the purposes of the Patents Act 1977, the territorial waters of the United Kingdom are treated as part of the United Kingdom⁴; and the Patents Act 1977 applies to acts done in an area designated by order under the Continental Shelf Act 1964⁵ or specified by Order under the Petroleum Act 1998⁶ as they apply to acts done in the United Kingdom⁷. 'Patent' in this legislation means a United Kingdom patent, unless the context otherwise requires⁸. It would seem that a United Kingdom patent is property situated in the United Kingdom⁹.

1 As to current legislation generally see PARA 304.

2 As to the meaning of 'United Kingdom' see PARA 303 note 5.

3 Patents Act 1977 s 131 (amended by the Companies Consolidation (Consequential Provisions) Act 1985 s 30, Sch 2; the Arbitration Act 1996 s 107(2), Sch 4; and the Patents Act 2004 s 16(1), Sch 2 paras 1, 28) (Northern Ireland); Patents Act 1977 s 131A (added by SI 1999/1820); Patents Act 1977 s 132(2) (Isle of Man); Patents Act 1977 (Isle of Man) Order 2003, SI 2003/1249.

4 Patents Act 1977 s 132(3).

5 I.e. an area designated by Order in Council under the Continental Shelf Act 1964 s 1(7): see **INTERNATIONAL RELATIONS LAW** vol 61 (2010) PARA 172.

6 I.e. an area specified by Order in Council under the Petroleum Act 1998 s 10(8) in connection with any activity falling within s 11(2): see **FUEL AND ENERGY** vol 19(3) (2007 Reissue) PARA 1679.

7 Patents Act 1977 s 132(4) (amended by the Oil and Gas (Enterprise) Act 1982 s 37, Sch 3 para 39; and the Petroleum Act 1998 s 50, Sch 4 para 14).

8 Patents Act 1977 s 130(1). Cf ss 77-82 (European patents (UK): see PARAS 675-678); ss 89-89B (international applications for patents: see PARAS 664-668).

9 Cf *English, Scottish and Australian Bank Ltd v IRC* [1932] AC 238 at 249, HL. This case, which concerned the locality of simple contract debts, overruled *Smelting Co of Australia Ltd v IRC* [1897] 1 QB 175, CA, where it had been held that patent rights are not capable of having a local situation.

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(3) DEVELOPMENT OF INVENTIONS

306. Government initiatives.

The National Research Development Corporation was established by the Development of Inventions Act 1948¹ with the functions of securing, where the public interest so required, the development or exploitation of inventions² resulting from public research³, and of any other invention which appeared to the corporation as not being developed or exploited or sufficiently developed or exploited⁴, and of acquiring, holding, disposing of and granting rights, whether gratuitously or for consideration, in connection with inventions resulting from public research and, where the public interest so required, in connection with inventions resulting from other sources⁵. Where the public interest so required and, subject to the approval of the Secretary of State⁶, the functions of the corporation also included promoting and assisting research for satisfying specific practical requirements brought to the corporation's knowledge, where it was of opinion that the research was likely to lead to an invention⁷, and power to assist the continuation of research, where it appeared to the corporation that a course of research had resulted in a discovery such that the continuation of the research might lead to inventions of practical importance⁸.

British Technology Group plc took over all the property, rights and liabilities to which the National Research Development Corporation was entitled or subject on 6 January 1992⁹. Following privatisation in 1992, the company floated on the London Stock Exchange in 1995 as BTG plc.

The Technology Strategy Board was established in October 2004 to advise the government on business research, technology and innovation priorities for the United Kingdom, the allocation of funding across priorities and the most appropriate ways to support them. In 2007 the Technology Strategy Board was recast as a non-departmental public body¹⁰.

The Strategic Advisory Board for Intellectual Property Policy (SABIP) has been established as an advisory non-departmental public body with the UK Intellectual Property Office¹¹ as its sponsor agency. SABIP's remit is to provide a strategic overview of intellectual policy, challenge government policy-making, and advise on the United Kingdom's stance in international negotiations.

1 See the Development of Inventions Act 1948 s 1(1). That Act and the Development of Inventions Acts 1954 and 1965 were repealed and replaced by the Development of Inventions Act 1967, which provided for the continuation of the corporation as a body corporate: s 1(1).

2 For these purposes, 'invention' included any new process or new technique and was to be construed without regard to whether or not a patent has been or could be granted: Development of Inventions Act 1967 s 15(2).

3 For these purposes, 'public research' meant research carried out by a government department or other public body or any other research in respect of which financial assistance was provided out of public funds: Development of Inventions Act 1967 s 2(5) (repealed).

4 Development of Inventions Act 1967 s 2(1)(a) (repealed).

5 Development of Inventions Act 1967 s 2(1)(b) (repealed).

6 See the Development of Inventions Act 1967 s 4(1) (repealed).

- 7 Development of Inventions Act 1967 s 2(1)(c) (repealed).
- 8 Development of Inventions Act 1967 s 2(1)(d) (repealed).
- 9 See the British Technology Group Act 1991 s 1 (amended by the Statute Law (Repeals) Act 2004); the British Technology Group Act 1991 (Appointed Day) Order 1991, SI 1991/2721; the British Technology Group Act 1991 (Nominated Company) Order 1991, SI 1991/2722; and **TRADE AND INDUSTRY** vol 97 (2010) PARA 951 t seq.
- 10 See the Technology Strategy Board Order 2007, SI 2007/280.
- 11 As to the UK Intellectual Property Office see PARA 579.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/2. GRANT AND DURATION OF PATENT/(1) APPLICANTS AND APPLICATIONS/(i) The Applicant/307. Right to apply for and obtain a patent.

2. GRANT AND DURATION OF PATENT

(1) APPLICANTS AND APPLICATIONS

(i) The Applicant

307. Right to apply for and obtain a patent.

Any person¹ may make an application for a patent² either alone or jointly with another³. A patent for an invention⁴ may, however, be granted:

- 10 (1) primarily to the inventor⁵ or joint inventors⁶;
- 11 (2) in preference to the inventor or joint inventors, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it, other than equitable interests, in the United Kingdom⁷;
- 12 (3) in any event, to the successor or successors in title of any person or persons mentioned in head (1) or head (2) above or any person so mentioned and the successor or successors in title of another person so mentioned⁸,

and to no other person⁹.

Except so far as the contrary is established, a person who makes an application for a patent is taken to be the person who is entitled to be so granted a patent and two or more persons who make such an application jointly are to be taken to be the persons so entitled¹⁰.

1 'Person' includes a body of persons corporate or unincorporate: Interpretation Act 1978 ss 5, 22(1), Sch 1, Sch 2 para 4(1)(a).

2 I.e. under the Patents Act 1977: see PARA 303. As to the application see PARA 315.

3 Patents Act 1977 s 7(1). As to co-ownership of patents see PARA 372.

4 As to the meaning of 'invention' see PARA 301 note 2.

5 As to the meaning of 'inventor' see PARA 301 note 3.

6 Patents Act 1977 s 7(2)(a). As to the right of the inventor or joint inventors to be mentioned in the patent or the application for it see PARA 308. As to the meaning of 'joint inventor' see PARA 301 note 3.

7 Patents Act 1977 s 7(2)(b). For an example of an enactment giving such entitlement see s 39 (employer's right to employee's invention); and PARA 369. For the meaning of 'United Kingdom' see PARA 303 note 5.

8 Patents Act 1977 s 7(2)(c).

9 Patents Act 1977 s 7(2). The provisions of the Patents Act 1977 s 7 form an exhaustive code in determining who is entitled to the grant of a patent: *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2007] UKHL 43, [2008] 1 All ER 425, [2008] RPC 1.

10 Patents Act 1977 s 7(4). As to the determination of questions relating to entitlement see PARAS 361-367.

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308. Mention of the inventor.

The inventor or joint inventors¹ of an invention² have a right to be mentioned as such in any patent granted for the invention³. They also have a right to be so mentioned, if possible, in any published application⁴ for a patent for the invention⁵ and, if not so mentioned, a right to be so mentioned in an addendum or erratum slip⁶.

Unless he has already given the UK Intellectual Property Office⁷ the following information, an applicant for a patent must, within the prescribed period⁸, file with the UK Intellectual Property Office a statement in the prescribed form⁹ identifying the person or persons whom he believes to be the inventor or inventors¹⁰ and, where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent¹¹. Where he fails to do so, the application is taken to be withdrawn¹². Where a person has been so mentioned as sole or joint inventor, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect and the comptroller may issue a certificate¹³. If the comptroller does so issue a certificate, he must rectify accordingly any undistributed copies of the patent and of any addendum or erratum slips¹⁴.

The inventor¹⁵ may, before preparations for the application's publication have been completed by the UK Intellectual Property Office, apply to the comptroller¹⁶ in writing to waive his right: (1) to have his name and address mentioned as those of the inventor¹⁷; or (2) to have his address mentioned as that of the inventor¹⁸. Where the comptroller has accepted an inventor's application to make a waiver, the inventor may apply to the comptroller to end that waiver¹⁹. The comptroller may, if he thinks fit, accept an application to end a waiver, and his acceptance may be made subject to such conditions as he may direct²⁰.

1 As to the meanings of 'inventor' and 'joint inventor' see PARA 301 note 3.

2 As to the meaning of 'invention' see PARA 301 note 2.

3 Patents Act 1977 s 13(1). A person who alleges that any person ought to have been mentioned as the inventor or joint inventor of an invention may apply to the comptroller for that person to be so mentioned: (1) in any patent granted for the invention; and (2) if possible in any published application for a patent for the invention, and, if not so mentioned, in the manner prescribed by the Patents Rules 2007, SI 2007/3291, r 10(1) (see the text to note 6): r 10(2). As to the comptroller see PARA 577; and as to applications to the comptroller see PARA 348 et seq.

4 As to the publication of applications see the Patents Act 1977 s 16; and PARA 327.

5 Patents Act 1977 s 13(1).

6 Patents Act 1977 s 13(1); Patents Rules 2007, SI 2007/3291, r 10(1).

7 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

8 Subject to the provisions of the Patents Rules 2007, SI 2007/3291, r 21 (extensions for new applications), r 58(4) (see PARA 678), r 59(3) (see PARA 678) and r 68(2), the period prescribed for the purposes of the Patents Act 1977 s 13(2) is 16 months beginning with: (1) where there is no declared priority date, the date of filing of the application; or (2) where there is a declared priority date, that date: Patents Rules 2007, SI 2007/3291, r 10(3). As to the extension of time limits see para 599. As to the meaning of 'declared priority date' see PARA 311 note 9; and as to the meaning of 'date of filing' see PARA 316.

Where a new application is filed under the Patents Act 1977 s 8(3) (see PARA 362), s 12(6) (see PARA 364) or s 37(4) (see PARA 366) or as mentioned in s 15(9) (see PARA 317), the period prescribed for the purposes of s 13(2) is two months beginning with its initiation date, or if it expires later, the period prescribed by the Patents Rules 2007, SI 2007/3291, r 10(3), and the reference in r 10(3) to the date of filing of the application is a reference to the date of filing of the earlier application: r 21(1)(a). But where the new application is filed less than six months before the compliance date the period prescribed for the purposes of the Patents Act 1977 s 13(2) is the period ending with its initiation date: Patents Rules 2007, SI 2007/3291, r 21(2)(a). The second requirement in Sch 1 (see PARA 322) must be complied with on the initiation date or, if it expires later, before the end of the relevant period specified in Sch 1 para 3(3) (see PARA 322): r 21(3). As to the extension of time limits see para 599. 'Initiation date' means the date on which a new application was initiated by documents, mentioned in the Patents Act 1977 s 15(1) (see PARA 316), being filed at the UK Intellectual Property Office (see note 7): Patents Rules 2007, SI 2007/3291, r 2(1).

Where an international application for a patent (UK) has begun the national phase of the application (see PARA 665), the period prescribed for the purposes of the Patents Act 1977 s 13(2) is the period prescribed by the Patents Rules 2007, SI 2007/3291, r 10(3) or, if it expires later, the period of two months beginning with the date on which the national phase begins: r 68(1), (2). As to the extension of time limits see para 599.

9 A statement filed under the Patents Act 1977 s 13(2) must be made on Patents Form 7: Patents Rules 2007, SI 2007/3291, r 10(4).

10 Patents Act 1977 s 13(2)(a).

11 Patents Act 1977 s 13(2)(b). As to the consequence of failure to file a statement where required see *Nippon Piston Ring Co Ltd's Applications* [1987] RPC 120; and PARA 332.

12 Patents Act 1977 s 13(2).

13 Patents Act 1977 s 13(3).

14 Patents Act 1977 s 13(3); Patents Rules 2007, SI 2007/3291, r 10(1).

15 An application to waive the right to be mentioned may also be made by a person who is not the inventor, but who has been identified as such for the purposes of the Patents Act 1977 s 13(2): Patents Rules 2007, SI 2007/3291, r 11(6). Where a person makes an application in reliance on r 11(6), the reference to an application to waive his right to have his name and address (or his address) mentioned is to be construed as a reference to an application not to have his name and address (or his address) mentioned; and the provisions of r 11(4), (5) are to be construed accordingly: r 11(7).

16 As to the comptroller see PARA 577.

17 An application by an inventor under head (1) in the text must include his reasons for making the application, and be accepted by the comptroller where the comptroller is satisfied by those reasons: Patents Rules 2007, SI 2007/3291, r 11(2).

18 Patents Rules 2007, SI 2007/3291, r 11(1). An application by an inventor under head (2) in the text must be accepted by the comptroller: r 11(3).

19 Patents Rules 2007, SI 2007/3291, r 11(4).

20 Patents Rules 2007, SI 2007/3291, r 11(5).

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(ii) Priority Dates

309. The priority date.

For the purpose of ascertaining whether an invention¹ which is the subject of a patent or an application for a patent is new² or lacks an inventive step³ or has been anticipated by some other applicant for a patent, it is necessary to assign to the invention a date at which these questions are to be judged. That date is known as the 'priority date'⁴. Where more than one invention is specified in an application, each invention may have a different priority date, whether or not it is the subject of a separate claim⁵. Further, in view of the provisions relating to novelty⁶, it is necessary to assign a priority date not only to the claims, but also to the matter disclosed⁷ by patent specifications.

1 As to the meaning of 'invention' see PARA 301 note 2.

2 As to novelty see PARA 435 et seq.

3 As to lack of inventive step see PARA 452 et seq.

4 As to the meaning of 'priority date' see PARA 311 note 6.

5 Patents Act 1977 s 125(2).

6 See the Patents Act 1977 s 2(3); and PARA 435.

7 As to what constitutes disclosure of matter see PARA 311 note 8.

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310. Priority date in case of obtaining.

Where a patent has been applied for by or is granted to a wrongful applicant¹, provision is made for allowing the true owner of the invention² to be accorded for his own application the date of filing³ of the application which would result or has resulted in the wrongful grant⁴. To secure for the rightful owner of the invention the wrongful applicant's priority date⁵ where that is earlier than the wrongful applicant's date of filing, although possible, is, however, a matter of some complexity⁶.

1 As to persons who may apply for and obtain a patent see PARA 307.

2 As to the meaning of 'invention' see PARA 301 note 2.

3 As to the meaning of 'date of filing' see PARA 316.

4 See the Patents Act 1977 s 8(3) (pending applications: see PARA 362) and s 37(4) (wrongful grant: see PARA 366).

5 As to the meaning of 'priority date' see PARA 311 note 6.

6 It would seem necessary in general to apply under the Patents Act 1977 s 8 (see PARA 361), as soon as the wrongful application is published both in respect of the wrongful application itself and for authority to make an application, back-dated, corresponding to each application from which priority is sought.

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311. Ascertainment of priority date.

If in, or in connection with, an application for a patent¹ (the 'application in suit'), a declaration of priority is made², whether by the applicant or any predecessor in title of his, specifying one or more relevant applications³ made by the applicant or any predecessor in title of his and each having a date of filing⁴ during the period allowed⁵, then:

- 13 (1) the priority date⁶ of the invention⁷ to which the application in suit relates is the date of filing of the relevant application or, if there are more than one, of the earliest of them, provided that the invention is supported by matter disclosed⁸ in the earlier relevant application or applications⁹;
- 14 (2) the priority date of any matter contained in the application in suit is the date of filing the relevant application, or the earliest relevant application if there is more than one, provided that the matter was disclosed in the earlier relevant application or applications¹⁰.

Where there is no declaration of priority, the priority date of an invention to which an application for a patent relates and also of any matter, whether or not the same as the invention, contained in the application is the date of filing the application¹¹.

The above provisions also apply for determining the priority date of an invention for which a patent has been granted as they apply for determining the priority date of an invention to which an application for that patent relates¹².

1 Ie under the Patents Act 1977: see PARA 303.

2 Ie under the Patents Act 1977 s 5(2). A declaration for the purposes of s 5(2) must be made at the time of filing the application for a patent: Patents Rules 2007, SI 2007/3291, r 6(1). Subject to r 7(9) (see note 5), a declaration for the purposes of the Patents Act 1977 s 5(2) may be made after the date of filing provided that it is made on Patents Form 3, it is made before the end of the period of 16 months beginning immediately following the date of filing of the earlier relevant application (or if there is more than one, the earliest of them) specified in that, or any earlier, declaration and the applicant has not made a request under the Patents Act 1977 s 16(1) for publication of the application during the prescribed period or any request made was withdrawn before preparations for the application's publication have been completed by the UK Intellectual Property Office: Patents Rules 2007, SI 2007/3291, r 6(2), (3). The prescribed time limit may not be extended: see PARA 599. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

In respect of every priority application, except where the application in suit is an international application for a patent (UK) and the application number of the priority application was indicated in compliance with the Patent Co-operation Treaty (see PARA 653 et seq), the applicant must, before the end of the period of 16 months beginning with the declared priority date (subject to the Patents Rules 2007, SI 2007/3291, r 21), furnish to the comptroller the application number of that application; otherwise the comptroller must disregard the declaration made for the purposes of the Patents Act 1977 s 5(2), in so far as it relates to the priority application: Patents Rules 2007, SI 2007/3291, r 8(1), (3), (5). As to the extension of time limits see para 599. Where a new application is filed under the Patents Act 1977 s 8(3) (see PARA 362), s 12(6) (see PARA 364) or s 37(4) (see PARA 366) or as mentioned in s 15(9) (see PARA 317), the relevant period for the purposes of the Patents Rules 2007, SI 2007/3291, r 8 is two months beginning with its initiation date or, if it expires later, the 16 month period specified in r 8(5): r 21(1)(b). But where the new application is filed less than six months before the compliance date the relevant period for the purposes of r 8 is the period ending with its initiation date: r 21(2)(b). As to the meaning of 'initiation date' see PARA 308 note 8.

In respect of every priority application, except where the application in suit is an international application for a patent (UK) and a certified copy of the priority application was filed in compliance with the Patent Co-operation

Treaty, or the priority application or a copy of the priority application is available to the comptroller, the applicant must, before the end of the period of 16 months beginning with the declared priority date (subject to the Patents Rules 2007, SI 2007/3291, r 21), furnish to the comptroller a copy of that application duly certified by the authority with which it was filed, or otherwise verified to the satisfaction of the comptroller, otherwise the comptroller must disregard the declaration made for the purposes of the Patents Act 1977 s 5(2), in so far as it relates to the priority application: Patents Rules 2007, SI 2007/3291, r 8(2), (4), (5). As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1. As to the translation of priority documents see r 9.

For the purposes of the Patents Rules 2007, SI 2007/3291, a document is available to the comptroller where: (1) it is in electronic storage (whether in the UK Intellectual Property Office or elsewhere) and he can access it by using electronic communications; or (2) it is kept at the UK Intellectual Property Office, and he has been furnished with sufficient information to obtain a copy of the document: r 2(3). But a document may be treated as unavailable to the comptroller where: (a) its accuracy cannot be verified to his satisfaction; or (b) he has to pay to access it: r 2(4).

3 As to the meaning of 'relevant application' see PARA 312.

4 As to the meaning of 'date of filing' see PARA 316. The declaration under the Patents Act 1977 s 5(2) (see note 2) must specify the date of filing of each earlier relevant application and the country it was filed in or in respect of: Patents Rules 2007, SI 2007/3291, r 6(4).

The comptroller may extend any period of time specified in the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291, where he is satisfied that the failure to do something under the Act or the Rules was wholly or mainly attributable to a delay in, or failure of, a communication service: r 111(1). Any such extension must be made after giving the parties such notice and subject to such conditions as the comptroller may direct: r 111(2). 'Communication service' means a service by which documents may be sent and delivered and includes post, electronic communications, and courier: r 111(3). As to the comptroller see PARA 577.

5 The period allowed under the Patents Act 1977 s 5(2A)(a) or (b): s 5(2) (amended by SI 2004/2357). The periods are: (1) the period of 12 months immediately following the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them; and (2) where the comptroller has given permission under the Patents Act 1977 s 5(2B) for a late declaration to be made under s 5(2), the period commencing immediately after the end of the period allowed under head (1) above and ending at the end of the prescribed period: s 5(2A) (added by SI 2004/2357). The applicant may make a request to the comptroller for permission to make a late declaration under the Patents Act 1977 s 5(2): s 5(2B) (added by SI 2004/2357). The comptroller must grant a request made under the Patents Act 1977 s 5(2B) if, and only if the request complies with the relevant requirements of rules and the comptroller is satisfied that the applicant's failure to file the application in suit within the period allowed under head (1) above was unintentional: s 5(2C) (added by SI 2004/2357). For a discussion of unintentional failure see *Sirna Therapeutics Inc's Application* [2006] RPC 351; *Re Abaco Machines (Australasia) Pty Ltd* [2007] EWHC 347 (Pat), [2007] Bus LR 897.

The period prescribed for the purposes of the Patents Act 1977 s 5(2A)(b) (see head (2) above) is two months: Patents Rules 2007, SI 2007/3291, r 7(1). The prescribed time limit may not be extended: see PARA 599. A request under the Patents Act 1977 s 5(2B) must be made on Patents Form 3 and supported by evidence of why the application in suit was not filed before the end of the period allowed under s 5(2A)(a) (see head (1) above): Patents Rules 2007, SI 2007/3291, r 7(2). Where that evidence does not accompany the request, the comptroller must specify a period within which the evidence must be filed: r 7(3). In relation to a new application, a request under the Patents Act 1977 s 5(2B) may be made in writing, instead of on Patents Form 3, and no evidence need accompany it: Patents Rules 2007, SI 2007/3291, r 7(4). A request under the Patents Act 1977 s 5(2B) may only be made before the end of the period allowed under s 5(2A)(b) (see head (2) above): Patents Rules 2007, SI 2007/3291, r 7(5). However, where a new application is filed after the end of that period, a request under the Patents Act 1977 s 5(2B) may be made on the initiation date: Patents Rules 2007, SI 2007/3291, r 7(6).

Where an international application for a patent (UK) has begun the national phase (see PARA 664 et seq), a request for permission to make a late declaration may be made under the Patents Act 1977 s 5(2B) before the end of the period of one month beginning with the date the national phase of the application begins: Patents Rules 2007, SI 2007/3291, r 66(3). The prescribed time limit may not be extended: see PARA 599. A request under the Patents Act 1977 s 5(2B) may only be made where the request is made in relation to an international application for a patent (UK) (see PARA 664 et seq) or where the applicant has not made a request under s 16(1) (see PARA 327) for publication of the application during the period prescribed for the purposes of that provision or any request made was withdrawn before preparations for the application's publication have been completed by the UK Intellectual Property Office: Patents Rules 2007, SI 2007/3291, r 7(8). Where an applicant makes a request under the Patents Act 1977 s 5(2B), he must make the declaration for the purposes of s 5(2) at the same time as making that request: Patents Rules 2007, SI 2007/3291, r 7(9).

6 'Priority date' means the date determined as such under the Patents Act 1977 s 5: s 130(1).

7 As to the meaning of 'invention' see PARA 301 note 2.

8 Matter is taken to have been disclosed in any relevant application if it was either claimed or disclosed, other than by way of a disclaimer or acknowledgment of prior art, in that application: Patents Act 1977 s 130(3). As to the meaning of 'supported by' see PARA 314.

9 Patents Act 1977 s 5(2)(a). 'Declared priority date' means the date of filing of the earliest relevant application specified in a declaration made for the purposes of s 5(2) in, or in connection with, an application in suit: Patents Rules 2007, SI 2007/3291, rr 2(1), 3(1). For the purposes of the Patents Rules 2007, SI 2007/3291, there is 'no declared priority date' if: (1) no declaration has been made for the purposes of the Patents Act 1977 s 5(2); or (2) every declaration made has been withdrawn or disregarded before the end of the relevant period: Patents Rules 2007, SI 2007/3291, r 3(2). The relevant period ends: (a) in the case of an application which falls to be treated as an application for a patent under the Patents Act 1977 by virtue of a direction under s 81 (see PARA 678), when that direction is given; (b) in the case of an international application for a patent (UK), when the national phase of the application begins (see PARA 664 et seq); or (c) in any other case, when preparations for the application's publication have been completed by the UK Intellectual Property Office: Patents Rules 2007, SI 2007/3291, r 3(3). References to declarations made for the purposes of the Patents Act 1977 s 5(2) include declarations treated as made for those purposes: Patents Rules 2007, SI 2007/3291, r 3(4).

10 Patents Act 1977 s 5(2)(b). See also note 9.

11 Patents Act 1977 s 5(1).

12 Patents Act 1977 s 5(4).

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312. Relevant applications.

For the purposes of a declaration of priority¹ 'relevant application' means:

- 15 (1) an application for a patent under the Patents Act 1977²;
- 16 (2) an application in or for a convention country³ for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application⁴.

Thus, in a declaration of priority, priority may be claimed from:

- 17 (a) a domestic application for a patent⁵;
- 18 (b) an application for a European patent (UK)⁶;
- 19 (c) an international application for a patent (UK)⁷;
- 20 (d) an application in or for a convention country⁸.

1 I.e a declaration under the Patents Act 1977 s 5(2): see PARA 311.

2 Patents Act 1977 s 5(5)(a).

3 As to convention countries see PARA 652. References to a convention country include references to a country, other than the United Kingdom, which is a member of the World Trade Organisation: Patents Act 1977 s 5(6) (added by SI 1999/1899). As to the meaning of 'United Kingdom' see PARA 303 note 5. As to the World Trade Organisation see **INTERNATIONAL RELATIONS LAW** vol 61 (2010) PARA 461; **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 7.

4 Patents Act 1977 s 5(5)(b). A German design application which protects the aesthetic character of an article is not an application 'in respect of' an invention and priority cannot be claimed from it: *Agfa-Gevaert AG's Application* [1982] RPC 441.

5 I.e an application under the Patents Act 1977 s 14: see PARA 315.

6 As to the meaning of 'European patent (UK)' see PARA 675 note 1. An application for a European patent (UK) is treated for the purposes of the Patents Act 1977 s 5 as an application under the Patents Act 1977: see s 78(1), (2), (3)(a)-(c); and PARA 676.

7 As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1. Such applications are treated for the purposes of the Patents Act 1977 s 5 as applications under the Patents Act 1977: see s 89(1); and PARA 664.

8 See PARA 652.

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313. Effect of disclosure in earlier relevant application.

Where an invention¹ or other matter contained in the application in suit was also disclosed² in two earlier relevant applications³ filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the second of those relevant applications was specified in or in connection with the application in suit⁴, the second of the relevant applications must be disregarded, so far as concerns that invention or matter⁵ unless:

- 21 (1) it was filed in or in respect of the same country as the first relevant application⁶; and
- 22 (2) not later than the date of filing⁷ the second, the first, whether or not so specified, was unconditionally withdrawn, or was abandoned or refused⁸, without:
 - 1
 1. (a) having been made available to the public, whether in the United Kingdom⁹ or elsewhere¹⁰;
 2. (b) leaving any rights outstanding¹¹; and
 3. (c) having served to establish a priority date in relation to another application, wherever made¹².
 - 2

Where a declaration of priority is made in or in connection with the application in suit specifying an earlier relevant application, the application in suit and any patent granted in pursuance of it are not invalidated by reason only of relevant intervening acts¹³, namely acts done in relation to matter disclosed in an earlier relevant application between the dates of that application and the application in suit¹⁴.

1 As to the meaning of 'invention' see PARA 301 note 2.

2 As to what constitutes disclosure of matter see PARA 311 note 8.

3 As to the meaning of 'relevant application' see PARA 312.

4 I.e. in a declaration of priority under the Patents Act 1977 s 5(2): see PARA 311.

5 Patents Act 1977 s 5(3).

6 Patents Act 1977 s 5(3)(a).

7 As to the meaning of 'date of filing' see PARA 316.

8 As to the withdrawal, abandonment and refusal of applications see PARA 332.

9 As to the meaning of 'United Kingdom' see PARA 303 note 5.

10 Patents Act 1977 s 5(3)(b)(i).

11 Patents Act 1977 s 5(3)(b)(ii).

12 Patents Act 1977 s 5(3)(b)(iii). Section 5(3) thus prevents an applicant from extending the 12-month period within which he may make a declaration of priority under s 5(2) (see PARA 311) by filing an application outside that period and then filing a later application within 12 months and claiming priority from that.

13 Patents Act 1977 s 6(1).

14 Patents Act 1977 s 6(2). Any application, or the disclosure to the public of matter contained in any application, which is to be disregarded for the purposes of s 5(3) (see the text and notes 5-12) is, however, to be disregarded for the purposes of s 6: s 6(2). Examples of relevant intervening acts are filing another application for the invention for which the earlier relevant application was made and making information available to the public about that invention or that matter or working that invention: s 6(2).

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314. Meaning of 'supported by'.

The expression 'supported by' in the provisions for ascertaining the priority date of an invention¹ in relation to the grant of a patent is given no statutory definition. The expression does, however, occur in the Patents Act 1977² where a claim is required to be 'supported by' the description. This has been construed³ to mean that the description must contain a disclosure (an 'enabling disclosure') which contains enough to enable something within the claim to be produced⁴. Accordingly an invention will be entitled to the priority date being the date of filing of an earlier application⁵ only if that earlier application not only described the invention but also contained an enabling disclosure⁶.

1 In the Patents Act 1977 s 5(2)(a): see PARA 311.

2 In the Patents Act 1977 s 14(5)(c): see PARA 319 head (c).

3 In the case of both the Patents Act 1977 s 5(2)(a) and s 14(5)(c).

4 *Asahi Kasei Kogyo KK's Application* [1991] RPC 485 at 536, HL, per Lord Oliver of Aylmerton and at 547 per Lord Jauncey of Tullichettle. See also *Toyama Chemical Co Ltd's Application* [1990] RPC 555; *Schering Biotech Corp'n's Application* [1993] RPC 249; *Prendergast's Applications* [2000] RPC 446; *Biogen Inc v Medeva plc* [1997] RPC 1, 38 BMLR 149, HL.

5 As to earlier relevant applications see PARA 311.

6 *Asahi Kasei Kogyo KK's Application* [1991] RPC 485 at 536, HL, per Lord Oliver of Aylmerton and at 547 per Lord Jauncey of Tullichettle.

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(iii) The Application

315. Requirements of the application.

Every application for a patent¹ which is to be proceeded with² must be made in the prescribed form and filed at the UK Intellectual Property Office³ in the prescribed manner⁴, and must be accompanied by the prescribed fee⁵.

The application must contain:

- 23 (1) a request for the grant of a patent⁶;
- 24 (2) a specification⁷; and
- 25 (3) an abstract⁸.

The contents of all documents (including annotations to drawings⁹) contained in an application for a patent must be in English or Welsh¹⁰. References must only be included in the drawing where they are mentioned in either the description or the claims¹¹. Tables of information may only be included in the claims if the comptroller agrees¹². The terminology and any references used must be consistent throughout the application for a patent¹³. Where units of measurement used in the application are not standard international units of measurement, the equivalent standard international units of measurement must be provided, and where no international standard exists, units must be used which are generally accepted in the field¹⁴. Only technical terms, signs and symbols which are generally accepted in the field may be used¹⁵.

Except for applications delivered in electronic form or using electronic communications¹⁶, all documents making up an application must be on A4 matt white paper free from tears, folds or similar damage and its contents must be suitable for reproduction; frames (lines surrounding matter) must not be used¹⁷. In relation to documents other than drawings, the pages of the description and claims must be numbered consecutively in a single series¹⁸, except where a sequence listing is set out at the end of the application, when it must be numbered consecutively in a separate series¹⁹; page numbers must be located at the top or bottom of the page (but not in the margin) in the centre²⁰ and the minimum margins in any document must be 20mm²¹. The request for the grant of a patent, the description, the claims and the abstract must each begin on a new sheet of paper²². The abstract, description and claims must use at least 1.5 line spacing, except where they form part of a translation or a sequence listing²³. The capital letters in any typeface or font used must be more than 2mm high²⁴.

1 Ie under the Patents Act 1977: see PARA 303.

2 As to the initiation of applications for the purpose of acquiring a date of filing see PARA 316.

3 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 Patents Act 1977 s 14(1)(a). For the prescribed form of request for the grant of a patent see the Patents Rules 2007, SI 2007/3291, r 12(1), Patents Form 1. Where the documents filed at the UK Intellectual Property Office to initiate an application for a patent do not include the applicant's name and address, the comptroller must notify the applicant that his name and address are required: r 12(2). Where the applicant has been so notified, he must, before the end of the period of two months beginning with the date of the notification, file his name and address; otherwise the comptroller may refuse his application: r 12(3). As to the extension of time

limits see para 599. As to the comptroller see PARA 577. The title of the invention must be short and indicate the matter to which the invention relates: r 12(6). Where the specification includes drawings, the description must include a list of drawings briefly describing each of them: r 12(7). As to drawings see PARA 320.

5 Where an application for a patent is made, the fee prescribed for these purposes (the 'application fee') must be paid not later than the end of the period prescribed for the purposes of the Patents Act 1977 s 15(10) (c) (see PARA 316): Patents Act 1977 s 14(1A) (added by SI 2004/2357). As to fees see PARA 583. For the purposes of the Patents Act 1977, 'application fee' means the fee prescribed for the purposes of s 14(1A): s 130(1) (definition added by SI 2004/2357).

6 Patents Act 1977 s 14(2)(a). The provisions of s 14(2) do not, however, prevent an application being initiated by documents complying with s 15(1) (see PARA 316): s 14(2).

7 Patents Act 1977 s 14(2)(b). See also note 6. Unless the application is delivered in electronic form or using electronic communications, the specification must be preceded by the title of the invention and must be set out in the following order: (1) description; (2) the claim or claims; and (3) any drawing referred to in the description or any claim: Patents Rules 2007, SI 2007/3291, r 12(4), (5). As to the contents of specifications see PARA 319.

8 Patents Act 1977 s 14(2)(c). See also note 6. As to the abstract see PARA 326.

9 As to drawings see PARA 320.

10 Patents Rules 2007, SI 2007/3291, r 14(1). Where the documents filed at the UK Intellectual Property Office to initiate an application for a patent include something which is or appears to be a description of the invention in a language other than English or Welsh and the applicant has not filed a translation into English or Welsh of that thing, the comptroller must notify the applicant that a translation is required: r 12(8). Where the applicant has been so notified, he must, before the end of the period of two months beginning with the date of the notification, file a translation; otherwise the comptroller may refuse his application: r 12(9). As to the extension of time limits see para 599. See also *Rohde and Schwarz's Application* [1980] RPC 155. A priority document is not one of the documents which make up an application for a patent: *Mitsui Engineering & Shipbuilding Co Ltd's Application* [1984] RPC 471. As to translations see PARA 597.

11 Patents Rules 2007, SI 2007/3291, r 14(4), Sch 2 Pt 4 para 21.

12 Patents Rules 2007, SI 2007/3291, r 14(4), Sch 2 Pt 4 para 22.

13 Patents Rules 2007, SI 2007/3291, r 14(4), Sch 2 Pt 4 para 23.

14 Patents Rules 2007, SI 2007/3291, r 14(4), Sch 2 Pt 4 para 24.

15 Patents Rules 2007, SI 2007/3291, r 14(4), Sch 2 Pt 4 para 25.

16 Patents Rules 2007, SI 2007/3291, r 14(5).

17 Patents Rules 2007, SI 2007/3291, r 14(2), Sch 2 Pt 1 paras 1-3.

18 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 4.

19 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 5.

20 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 6.

21 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 7.

22 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 8.

23 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 9.

24 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 2 para 10.

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316. Initiation of application; date of filing.

The date of filing an application for a patent¹ is to be taken to be the earliest date on which documents filed at the UK Intellectual Property Office² to initiate the application satisfy the following conditions³:

- 26 (1) the documents indicate that a patent is sought⁴;
- 27 (2) the documents identify the person applying for a patent or contain information sufficient to enable that person to be contacted by the UK Intellectual Property Office⁵; and
- 28 (3) the documents contain either: (a) something which is or appears to be a description of the invention for which a patent is sought⁶; or (b) a reference, complying with the relevant requirements of rules⁷, to an earlier relevant application made by the applicant or a predecessor in title of his⁸.

Where documents filed at the UK Intellectual Property Office to initiate an application for a patent satisfy one or more of the conditions specified in heads (1) to (3) above, but do not satisfy all those conditions, the comptroller⁹ must as soon as practicable after the filing of those documents notify the applicant of what else must be filed in order for the application to have a date of filing¹⁰.

Where documents filed at the UK Intellectual Property Office to initiate an application for a patent satisfy all the conditions specified in heads (1) to (3) above, the comptroller must as soon as practicable after the filing of the last of those documents notify the applicant of: (i) the date of filing the application; and (ii) the requirements that must be complied with, and the periods within which they are required by the Patents Act 1977 or rules to be complied with, if the application is not to be treated as having been withdrawn¹¹.

Where an application has a date of filing and within the prescribed period¹² the applicant files at the UK Intellectual Property Office a drawing¹³, or part of the description of the invention for which a patent is sought, and that drawing or that part of the description was missing from the application at the date of filing¹⁴ then, unless the applicant withdraws¹⁵ the drawing or the part of the description (the 'missing part') before the end of the prescribed period¹⁶, the missing part is treated as included in the application¹⁷ and the date of filing the application is the date on which the missing part is filed at the UK Intellectual Property Office¹⁸. However, this does not affect the power of the comptroller¹⁹ to correct an error or mistake²⁰.

Where an application has a date of filing by virtue of the provisions set out above, the application is to be treated as having been withdrawn if any of the following applies²¹:

- 29 (A) the applicant fails to file at the UK Intellectual Property Office, before the end of the prescribed period, one or more claims and the abstract²²;
- 30 (B) where a reference to an earlier relevant application has been filed²³ the applicant fails to file at the UK Intellectual Property Office, before the end of the prescribed period, a description of the invention for which the patent is sought²⁴; or the applicant fails to file at the UK Intellectual Property Office, before the end of the prescribed period, a copy of the application referred to, complying with the relevant requirements of rules²⁵;

- 31 (c) the applicant fails to pay the application fee before the end of the prescribed period²⁶;
- 32 (d) the applicant fails, before the end of the prescribed period, to make a request for a search²⁷ and pay the search fee²⁸.

1 le under the Patents Act 1977: see PARA 303.

2 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 Patents Act 1977 s 15(1) (s 15 substituted by SI 2004/2357).

4 Patents Act 1977 s 15(1)(a) (as substituted: see note 3).

5 Patents Act 1977 s 15(1)(b) (as substituted: see note 3).

6 Patents Act 1977 s 15(1)(c)(i) (as substituted: see note 3). The date of filing will be acquired only by matter which was disclosed in the material initially filed: *Asahi Kasei Kogyo KK's Application* [1991] RPC 485 at 526, HL, per Lord Oliver of Aylmerton and at 546 per Lord Jauncey of Tullichettle. See also *Rohde and Schwarz's Application* [1980] RPC 155.

7 A reference must include: (1) the date of filing of the earlier relevant application; (2) its application number; and (3) the country it was filed in or in respect of: Patents Rules 2007, SI 2007/3291, r 17(1). As to relevant applications see PARA 312.

8 Patents Act 1977 s 15(1)(c)(ii) (as substituted: see note 3). It is immaterial for the purposes of s 15(1)(c)(i) whether the thing is in, or is accompanied by a translation into, a language accepted by the UK Intellectual Property Office in accordance with rules or whether the thing otherwise complies with the other provisions of the Patents Act 1977 and with any relevant rules: s 15(2) (as substituted: see note 3). As to the requirements for applications which are to be proceeded with see PARA 315.

9 As to the comptroller see PARA 577.

10 Patents Act 1977 s 15(3) (as substituted: see note 3).

11 Patents Act 1977 s 15(4) (as substituted: see note 3).

12 The prescribed period is the period beginning with the date of filing of the application for a patent and ending with the date of the preliminary examination: Patents Rules 2007, SI 2007/3291, r 18(1). As to the extension of time limits see para 599. However, where the applicant is notified under the Patents Act 1977 s 15A(9) (see PARA 318) that a drawing or part of the description of the invention has been found to be missing, the prescribed period is the period of two months beginning with the date of the notification: Patents Rules 2007, SI 2007/3291, r 18(2).

13 As to drawings see PARA 320.

14 Patents Act 1977 s 15(5) (as substituted: see note 3).

15 An applicant may only withdraw a missing part by giving written notice to the comptroller: Patents Rules 2007, SI 2007/3291, r 18(3).

16 Patents Act 1977 s 15(6) (as substituted: see note 3).

17 Patents Act 1977 s 15(6)(a) (as substituted: see note 3).

18 Patents Act 1977 s 15(6)(b) (as substituted: see note 3). Section 15(6)(b) does not apply if: (1) on or before the date which is the date of filing the application by virtue of s 15(1) (see the text and notes 1-8) a declaration is made under s 5(2) (see note 8) in or in connection with the application; (2) the applicant makes a request for s 15(6)(b) not to apply; and (3) the request complies with the relevant requirements of rules and is made within the prescribed period: s 15(7) (as substituted: see note 3). The provisions of s 15(7) do not affect the power of the comptroller to correct an error or mistake under s 117(1) (see PARA 354): s 15(8) (as substituted: see note 3).

A request made under head (2) must: (a) be made in writing; (b) include sufficient information to identify where in the priority application the contents of the document filed under s 15(5) (see the text to note 14) were included; and (c) be made before the end of the prescribed period (see note 14): Patents Rules 2007, SI

2007/3291, r 18(4). Any such request is considered never to have been made where: (i) the priority application does not contain every missing part filed under the Patents Act 1977 s 15(5); or (ii) the applicant fails, before the end of the relevant period, to furnish to the comptroller copies of all earlier relevant applications duly certified by the authority with which they were filed, or otherwise verified to the satisfaction of the comptroller: Patents Rules 2007, SI 2007/3291, r 18(5). Head (ii) does not apply in respect of an earlier relevant application where that application or a copy of the application is available to the comptroller (see PARA 311 note 2): r 18(6). For the purposes of head (ii) the relevant period is 16 months beginning with the declared priority date or, if it expires earlier, the period of four months beginning with the date on which the request was made under the Patents Act 1977 s 15(7)(b) (see head (2)): Patents Rules 2007, SI 2007/3291, r 18(7).

19 le under the Patents Act 1977 s 117(1): see PARA 354.

20 Patents Act 1977 s 15(8) (as substituted: see note 3). This provision may avoid the difficulties in *Antiphon AB's Application* [1984] RPC 1 and in *VEB Kombinat Walzlager und Normteile's Application* [1987] RPC 405. The comptroller has power in appropriate circumstances to 'rescind' the grant of a patent to enable a divisional application to be filed: *Re Howmet Research Corpn's Application* [2006] EWHC 725 (Pat), [2006] RPC 657, [2006] All ER (D) 78 (Apr). As to divisional applications see PARA 317.

21 Patents Act 1977 s 15(10) (as substituted: see note 3).

22 Patents Act 1977 s 15(10)(a) (as substituted: see note 3). The period prescribed for the purposes of s 15(10)(a) is the relevant period: Patents Rules 2007, SI 2007/3291, r 22(1). For the purposes of r 22 the relevant period is: (1) where there is no declared priority date, 12 months beginning with the date of filing of the application; or (2) where there is a declared priority date: (a) 12 months beginning with the declared priority date; or (b) if it expires later, the period of two months beginning with the date of filing of the application: r 22(7). As to the extension of time limits see para 599.

The provisions of the Patents Rules 2007, SI 2007/3291, r 22(1)-(3) do not apply to a new application: r 22(4). 'New application' means a new application filed under the Patents Act 1977 s 8(3) (see PARA 362), s 12(6) (see PARA 364) or s 37(4) (see PARA 366) or as mentioned in s 15(9) (see PARA 317): Patents Rules 2007, SI 2007/3291, r 2(1). In relation to a new application: (a) the period prescribed for the purposes of the Patents Act 1977 s 15(10)(a), (b)(i), (c) and (d) is two months beginning with its initiation date or, if it expires later, the relevant period; and (b) the period prescribed for the purposes of s 15(10)(b)(ii) is two months beginning with its initiation date or, if it expires later, the period of four months beginning with the date of filing of the earlier application, and the reference in the Patents Rules 2007, SI 2007/3291, r 22(7) to the date of filing of the application is a reference to the date of filing of the earlier application: r 22(5). But where the new application is filed less than six months before the compliance date, the period prescribed for the purposes of the Patents Act 1977 s 15(10)(a)-(d) is the period ending with its initiation date: Patents Rules 2007, SI 2007/3291, r 22(6). As to the meaning of 'initiation date' see PARA 311 note 5.

23 le as mentioned in the Patents Act 1977 s 15(1)(c)(ii) (see head (3)(b) in the text).

24 Patents Act 1977 s 15(10)(b)(i) (as substituted: see note 3). The period prescribed for the purposes of s 15(10)(b)(i) is the relevant period: Patents Rules 2007, SI 2007/3291, r 22(1). See note 22. This period does not apply to new applications: see note 22.

Where, in relation to an application for a patent: (1) a reference to an earlier relevant application has been filed as mentioned in the Patents Act 1977 s 15(1)(c)(ii) (see the text to note 8); and (2) the description filed under s 15(10)(b)(i) discloses additional matter, that is, matter extending beyond that disclosed in the earlier relevant application, the application is not allowed to proceed unless it is amended so as to exclude the additional matter: s 76(1A) (added by SI 2004/2357). As to the meaning of 'relevant application' see PARA 312. As to extended matter see PARA 353.

25 Patents Act 1977 s 15(10)(b)(ii) (as substituted: see note 3). The period prescribed for the purpose of s 15(10)(b)(ii) is four months beginning with the date of filing of the application: Patents Rules 2007, SI 2007/3291, r 22(3). This period does not apply to new applications: see note 22.

26 Patents Act 1977 s 15(10)(c) (as substituted: see note 3). Subject to the Patents Rules 2007, SI 2007/3291, rr 58(4), 59(3), 68(3) (see PARA 678), the period prescribed for the purposes of the Patents Act 1977 s 15(10)(c) is the relevant period: Patents Rules 2007, SI 2007/3291, r 22(2). See note 22. This period does not apply to new applications: see note 22.

Where an international application for a patent (UK) has begun the national phase (see PARA 664 et seq), the period prescribed for the purposes of the Patents Act 1977 s 15(10)(c), (d) is the period prescribed by the Patents Rules 2007, SI 2007/3291, r 22(2), (7) or, if it expires later, the period of two months beginning with the date on which the national phase begins: r 68(1), (3).

27 le under the Patents Act 1977 s 17 (see PARA 328).

28 Patents Act 1977 s 15(10)(d) (as substituted: see note 3). Subject to the Patents Rules 2007, SI 2007/3291, rr 58(4), 59(3), 68(3) (see PARA 678), the period prescribed for the purposes of the Patents Act 1977 s 15(10)(d) is the relevant period: Patents Rules 2007, SI 2007/3291, r 22(2). See notes 22, 26. This period does not apply to new applications: see note 22.

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317. Divisional applications.

Where, after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application and the conditions relating to filing date¹ are satisfied in relation to the new application², the new application is treated as having, as its date of filing, the date of filing the earlier application³.

1 le the conditions mentioned in the Patents Act 1977 s 15(1)(a)-(c): see PARA 316 heads (1)-(3).

2 An application for a patent which: (1) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and (2) discloses additional matter, that is, matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed, may be filed as mentioned in the Patents Act 1977 s 15(9), but is not allowed to proceed unless it is amended so as to exclude the additional matter: Patents Act 1977 s 76(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 20; and amended by SI 2004/2357). References to an application for a patent, as filed, are references to such an application in the state it was on the date of filing: Patents Act 1977 s 130(4). As to extended matter see PARA 353. See also *Glatt's Application* [1983] RPC 122; *Protoned BV's Application* [1983] FSR 110; and *Van der Lely's Application* [1987] RPC 61, excluding claims in divisional applications to inventions 'not within the contemplation of the invention as described' in the main specification.

3 Patents Act 1977 s 15(9) (substituted by SI 2004/2357). A new application for a patent may be filed as mentioned in s 15(9): (1) before the end of the relevant period; or (2) if earlier, before the earlier application is terminated or withdrawn: Patents Rules 2007, SI 2007/3291, r 19(1). Such an application must include a statement that it is filed as mentioned in the Patents Act 1977 s 15(9): Patents Rules 2007, SI 2007/3291, r 19(2). For these purposes, the relevant period is: (a) where an applicant is notified under the Patents Act 1977 s 18(4) (see PARA 329) that his earlier application complies with the requirements of the Patents Act 1977 and the Patents Rules 2007, SI 2007/3291, two months beginning with the date of that notification; or (b) in any other case, the period ending three months before the compliance date of the earlier application: r 19(3).

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318. Preliminary examination.

The comptroller¹ must refer an application for a patent to an examiner for a preliminary examination if the application has a date of filing², the application has not been withdrawn or treated as withdrawn³ and the application fee⁴ has been paid⁵.

On a preliminary examination of an application the examiner is required to determine whether the application complies with those requirements of the Patents Act 1977 and the rules which are designated by the rules as formal requirements for the purposes of the Act⁶, and determine whether any requirements⁷ remain to be complied with⁸. The examiner must report to the comptroller his determinations⁹.

If on the preliminary examination of an application it is found that any drawing¹⁰ referred to in the application, or part of the description of the invention¹¹ for which the patent is sought, is missing from the application, then the examiner must include this finding in his report to the comptroller¹².

If a report is made to the comptroller that not all the formal requirements have been complied with¹³, the comptroller must specify a period during which the applicant has the opportunity to make observations on the report, and to amend the application so as to comply with those requirements¹⁴. The comptroller may refuse the application if the applicant fails to amend the application before the end of the period specified by the comptroller¹⁵.

1 As to the comptroller see PARA 577.

2 See PARA 316.

3 As to withdrawal see PARA 332.

4 As to the meaning of 'application fee' see PARA 315 note 5.

5 Patents Act 1977 s 15A(1) (s 15A added by SI 2004/2357). As to fees see PARA 583.

6 Patents Act 1977 s 15A(2)(a) (as added: see note 5). On the preliminary examination the examiner must determine whether the application complies with the requirements of the Patents Rules 2007, SI 2007/3291, rr 6-9 (see PARA 311): r 23(1). The examiner must report to the comptroller his determinations and the comptroller must notify the applicant accordingly: r 23(2). Where, on the preliminary examination under the Patents Act 1977 s 15A of an application, the examiner finds that a declaration made for the purposes of s 5(2) (see PARA 311) specifies a date of filing for an earlier relevant application: (1) more than 12 months before the date of filing of the application in suit; or (2) where the comptroller has given permission for a late declaration to be made under s 5(2), more than 14 months before the date of filing of the application in suit, he must report this finding to the comptroller, and the comptroller must notify the applicant accordingly: Patents Rules 2007, SI 2007/3291, r 24(1). Where the comptroller has so notified the applicant, the applicant must, before the end of the period of two months beginning with the date of that notification, provide the comptroller with a corrected date; otherwise the comptroller must disregard the declaration in so far as it relates to the earlier relevant application: r 24(2). 'Corrected date' means a date that would not have been reported by the examiner under r 24(1): r 24(3).

7 Ie under the Patents Act 1977 s 13(2) (see PARA 308) or s 15(10) (see PARA 316).

8 Patents Act 1977 s 15A(2) (as added: see note 5).

9 Patents Act 1977 s 15A(3) (as added: see note 5). If a report is made to the comptroller under s 15A(3): (1) that any requirement of s 13(2) (see PARA 308) or s 15(10) (see PARA 316) has not been complied with; or (2)

that a drawing or part of the description of the invention has been found to be missing, then the comptroller must notify the applicant accordingly: s 15A(9) (as added: see note 5).

10 As to drawings see PARA 320.

11 See PARA 319.

12 Patents Act 1977 s 15A(4) (as added: see note 5).

13 Patents Act 1977 s 15A(5) (as added: see note 5). The requirements of the following provisions of the Patents Rules 2007, SI 2007/3291, are formal requirements: (1) r 12(1) (application for a patent on Patents Form 1) (see PARA 315); (2) r 14(1) (application in English or Welsh) (see PARA 315); (3) r 14(2), (3) (form of documents and drawings) (see PARA 315): r 25(1). Where an application is delivered in electronic form or using electronic communications, only the requirements of r 14(1) are formal requirements: r 25(2). Where an international application for a patent (UK) (see PARA 664) was filed in accordance with the provisions of the patent co-operation treaty (see PARA 653 et seq), the requirements mentioned in r 25(1) are to be treated as complied with to the extent that the application complies with any corresponding provision of that treaty: r 25(3).

14 Patents Act 1977 s 15A(6) (as added: see note 5). The power to amend the application is subject to s 76 (see PARA 352): s 15A(6) (as so added).

15 Patents Act 1977 s 15A(7) (as added: see note 5). Section 15A(7) does not apply if: (1) the applicant makes observations as mentioned in s 15A(6) (see the text to note 14) before the end of the period specified by the comptroller; and (2) as a result of the observations, the comptroller is satisfied that the formal requirements have been complied with: s 15A(8) (as added: see note 5).

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(iv) Specification, Claims and Abstract

319. Contents of specification.

The specification of an application for a patent¹ must contain a description of the invention², a claim or claims, and any drawing referred to in the description or any claim³. The specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art⁴.

The description contained in the specification has to fulfil two main conditions:

- 33 (1) to state in clear and intelligible language what the invention is, so that others may know what the monopoly is that is granted to the proprietor of the patent; and
- 34 (2) to state in clear and intelligible language in what manner the patented invention is to be performed, so that others may learn from the specification how practically to avail themselves of the patented invention when the patent has expired⁵.

The claim or claims contained in the specification must:

- 35 (a) define the matter for which the applicant seeks protection⁶;
- 36 (b) be clear and concise⁷;
- 37 (c) be supported by the description⁸; and
- 38 (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept⁹.

Any drawings which are contained in a specification must satisfy certain requirements in respect of their presentation and execution¹⁰.

1 le under the Patents Act 1977: see PARA 303.

2 As to the meaning of 'invention' see PARA 301 note 2.

3 Patents Act 1977 s 14(2)(b). The specification must be preceded by the title of the invention and must be set out in the following order: (1) description; (2) the claim or claims; and (3) any drawing referred to in the description or any claim: Patents Rules 2007, SI 2007/3291, r 12(4). This does not apply where an application is delivered in electronic form or using electronic communications: r 12(5). The title of the invention must be short and indicate the matter to which the invention relates: r 12(6). As to the presentation and execution of documents, other than drawings, making up the specification see PARA 315. As to failure to file claims see *R (on the application of Penife International Ltd) v HM Comptroller-General of Patents, Trademarks and Designs* [2003] EWHC 3409 (Admin), [2004] RPC 737, [2004] All ER (D) 116 (Mar).

4 Patents Act 1977 s 14(3). There is no requirement, however, to describe every possible way in which the invention may be performed: *Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83 at 136; *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311, 101 BMLR 52, [2008] All ER (D) 152 (Apr). As to the presumed skill of the person to whom the specification is addressed see PARA 492; and as to specifications of applications for inventions which require for their performance the use of biological material see PARA 322.

5 *Edison and Swan United Electric Co v Holland* (1889) 6 RPC 243 at 279. Where the specification includes drawings, the description must include a list of drawings briefly describing each of them: Patents Rules 2007, SI 2007/3291, r 12(7). As a matter of practice, it is generally desirable that the description should contain an

opening statement setting out the essential features of the invention (the 'consistory clause'): see PARA 324 text and note 3.

6 Patents Act 1977 s 14(5)(a). As to reference numerals in a claim see *Philips Electronic and Associated Industries Ltd's Patent* [1987] RPC 244; *Russell Finex Ltd v Telsonic AG* [2004] EWHC 474 (Ch), [2004] RPC 744, [2004] All ER (D) 332 (Mar).

7 Patents Act 1977 s 14(5)(b).

8 Patents Act 1977 s 14(5)(c). This requirement means that the description must be such as fairly to entitle the patentee to a monopoly of the width claimed: *Schering Biotech Corp'n's Application* [1993] RPC 249. See also PARA 314. In applications for inventions claiming a further medical use, the description should include reference to appropriate in vivo or in vitro tests to show that the compounds are effective against the medical conditions cited in the application: *Hoerrmann's Application* [1996] RPC 341; followed in *Consultants Suppliers Ltd's Application* [1996] RPC 348. As to the meaning of 'support' see *Biogen Inc v Medeva plc* [1997] RPC 1 at 46-47, 38 BMLR 149 at 167-168, HL, per Lord Hoffmann.

9 Patents Act 1977 s 14(5)(d). Without prejudice to the generality of s 14(5)(d), where two or more inventions are claimed, whether in a single claim or in separate claims, and there exists between or among those inventions a technical relationship which involves one or more of the same or corresponding special technical features, then those inventions are treated as being so linked as to form a single inventive concept for the purposes of the Patents Act 1977: s 14(6); Patents Rules 2007, SI 2007/3291, r 16(1). For these purposes, 'special technical features' means those technical features which define a contribution which each of the claimed inventions, considered as a whole, make over the prior art: r 16(2). No person may, however, in any proceeding object to a patent or to an amendment of the specification of a patent on the ground that the claims contained in the specification of the patent, either as they stand or as proposed to be amended, as the case may be, relate to more than one invention or to a group of inventions which are not so linked as to form a single inventive concept: Patents Act 1977 s 26.

10 See the Patents Rules 2007, SI 2007/3291, r 14, Sch 2; and PARA 320.

UPDATE

319 Contents of specification

NOTE 4--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] IP & T 496 (Patents Act s 14(3), (5)(c) operated together to spell out enabling disclosure).

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320. Drawings.

Drawings forming part of an application for a patent¹ must be on A4 matt white paper free from tears, folds or similar damage and its contents must be suitable for reproduction². Frames (lines surrounding matter) must not be used³. There must be minimum margins⁴.

Drawings must be executed as follows:

- 39 (1) all drawings must be numbered consecutively in a single series⁵;
- 40 (2) the drawings must begin on a new sheet of paper⁶;
- 41 (3) the pages containing the drawings must be numbered consecutively in a single series⁷;
- 42 (4) drawings must comprise black lines and must not be shaded⁸;
- 43 (5) drawings may include cross-hatching to illustrate the cross-sections of a thing⁹;
- 44 (6) any scale or other reference for making measurement must be represented diagrammatically¹⁰;
- 45 (7) any drawing must be produced in such manner that it would still be clear if it were reduced by linear reduction to two thirds of its original size¹¹;
- 46 (8) a drawing must not be included in the description, the claims, the abstract or the request for the grant of a patent¹²;
- 47 (9) the capital letters in any typeface or font used in any drawing must be more than 3mm high¹³;
- 48 (10) references must only be included in the drawing where they are mentioned in either the description or the claims¹⁴.

1 Ie under the Patents Act 1977 s 14: see PARA 315.

2 Patents Rules 2007, SI 2007/3291, r 14(3), Sch 2 Pt 1 paras 1, 2. This does not apply to an application which is delivered in electronic form or using electronic communications: r 14(5).

3 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 1 para 3.

4 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 11. There must be a margin around any drawing which must be at least: (1) at the top and left side, 20mm; (2) at the right side, 15mm; and (3) at the bottom, 10mm: Sch 2 Pt 3 para 11.

5 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 12.

6 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 13.

7 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 14.

8 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 15.

9 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 16.

10 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 17.

11 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 18.

12 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 19.

- 13 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 3 para 20.
- 14 Patents Rules 2007, SI 2007/3291, Sch 2 Pt 4 para 21.

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321. Selection patents.

A 'selection patent' is a patent for a group of members of a known class of things or processes. Such patents are of special importance in regard to chemical discoveries. In the case of selection patents, the specification may be insufficient unless it states the advantage secured by the selection¹.

¹ *Re I G Farbenindustrie AG's Patents* (1930) 47 RPC 289 at 323; *Shell Refining and Marketing Co Ltd's Patent* [1960] RPC 35 at 52, CA; *Du Pont de Nemours & Co (Witsiepe's Application)* [1982] FSR 303, HL; *Biogen Inc v Medeva plc* [1997] RPC 1, 38 BMLR 149, HL; *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311, 101 BMLR 52, [2008] All ER (D) 152 (Apr). The requirement also applies to non-chemical selection patents, but then attainment of the advantage ought in any event to be a limitation upon the claims. As to the invalidity of selection patents on the grounds of lack of novelty and obviousness see PARAS 441, 480 respectively.

UPDATE

321 Selection patents

NOTE 1--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] IP & T 496.

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322. Biological material.

The specification of an application for a patent¹, or of a patent, for an invention² which requires for its performance the use of or concerns biological material is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art if the following requirements are satisfied³.

The requirements are:

- 49 (1) that on or before the date of filing⁴ of the application, the biological material has been deposited in a depositary institution⁵ and that institution will be able to furnish subsequently a sample of the biological material⁶;
- 50 (2) that before the end of the relevant period⁷: (a) the name of the depositary institution and the accession number⁸ of the deposit are included in the specification; and (b) where the biological material was deposited by a person other than the applicant (the 'depositor'), a statement is filed which identifies the name and address of the depositor, and a statement by the depositor has been filed, which authorises the applicant to refer to the biological material in his application and irrevocably authorises the making available to the public of the biological material⁹;
- 51 (3) that the specification of the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material¹⁰.

Where an application for a patent has been published, any person may request the comptroller¹¹ to issue an authorisation certificate authorising a depositary institution to make available a sample of biological material¹². Where the application has not been published, a person who has been notified that an application has been made¹³ may request the comptroller to issue an authorisation certificate¹⁴. A request¹⁵ must include an undertaking by the person making the request not to make the biological material, or any material derived from it, available to any other person, and not to use the biological material, or any material derived from it, except for experimental purposes relating to the subject matter of the invention¹⁶. Where the comptroller grants the request, he must send copies of the request and the certificate¹⁷ to the applicant for, or the proprietor of, the patent, the depositary institution and the person making the request¹⁸. In certain circumstances¹⁹, a sample may only be made available to an expert²⁰. There are rules in relation to new deposits²¹.

1 le under the Patents Act 1977: see PARA 303. 'Specification' means the specification of an application for a patent: Patents Rules 2007, SI 2007/3291, r 13(1), Sch 1 para 3(5).

2 As to the meaning of 'invention' see PARA 301 note 2.

3 Patents Act 1977 s 125A (added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 30); Patents Rules 2007, SI 2007/3291, r 13(1), Sch 1 para 2(1). As to the validity of biotechnological developments see PARA 434.

4 As to the meaning of 'date of filing' see PARA 316.

5 'Depositary institution' means an institution which: (1) carries out the functions of receiving, accepting and storing biological material and the furnishing of samples of such biological material (whether generally or of a

specific type); and (2) conducts its affairs, in so far as they relate to the carrying out of those functions, in an objective and impartial manner: Patents Rules 2007, SI 2007/3291, Sch 1 para 1.

6 Patents Rules 2007, SI 2007/3291, Sch 1 paras 2(2)(a), 3(1). This is the 'first requirement': Sch 1 para 1. Where a particular strain of micro-organism has been deposited, this will support claims to that strain and to strains derived from it but not claims to the species as a whole: *Chinoïn's Application* [1986] RPC 39.

7 The relevant period is the first to expire of: (1) the period of 16 months (a) where there is no declared priority date, beginning with the date of filing of the application; or (b) where there is a declared priority date, beginning with that date; (2) where the applicant has made a request under the Patents Act 1977 s 16(1) (see PARA 327) to publish the application during the period prescribed for the purposes of that provision, the period ending with the date of the request; or (3) where the applicant was notified under the Patents Rules 2007, SI 2007/3291, r 52(2) (see PARA 581), the period of one month beginning with the date of the notification: Sch 1 para 3(3).

8 'Accession number' means the number given to the deposit by a depositary institution: Patents Rules 2007, SI 2007/3291, Sch 1 para 3(5).

9 Patents Rules 2007, SI 2007/3291, Sch 1 paras 2(2)(a), 3(2). As to the extension of time limits see para 599. This is the 'second requirement': Sch 1 para 1. Where: (1) the application is filed with the European Patent Office and documents have been filed under the provisions of the European Patent Convention (see PARA 668 et seq) corresponding to the second requirement; or (2) the application in suit is an international application for a patent (UK) and documents have been filed in accordance with the Patent Co-operation Treaty under the provisions of the Treaty (see PARA 653 et seq) corresponding to the second requirement, the second requirement is to be treated as having been met: Patents Rules 2007, SI 2007/3291, Sch 1 para 3(4).

10 Patents Rules 2007, SI 2007/3291, Sch 1 para 2(2)(b).

11 As to the comptroller see PARA 577.

12 Patents Rules 2007, SI 2007/3291, Sch 1 paras 1, 4(2). Sch 1 para 4 applies where Sch 1 para 7 (see the text and note 20) does not apply: Sch 1 para 4(1). A request must be made on Patents Form 8: Sch 1 para 4(4). Where the biological material has been deposited at an international depositary authority, the request must be accompanied by the relevant form required by the Budapest Treaty: Patents Rules 2007, SI 2007/3291, Sch 1 para 4(5). 'Budapest Treaty' means the Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure (Budapest, 28 April 1977; TS 5 (1981); Cmnd 8136), as amended on 26 September 1980, and includes references to the regulations made under that Treaty: Patents Rules 2007, SI 2007/3291, Sch 1 para 1.

13 Ie in accordance with the Patents Act 1977 s 118(4): see PARA 581.

14 Patents Rules 2007, SI 2007/3291, Sch 1 para 4(3). See note 12.

15 Ie a request under the Patents Rules 2007, SI 2007/3291, Sch 1 para 4 or 7 (see note 20).

16 Patents Rules 2007, SI 2007/3291, Sch 1 para 5(1). The applicant for, or the proprietor of, a patent may agree to limit the effect of the undertaking in a particular case: Sch 1 para 5(2). The undertaking ceases to have effect: (1) when the application for a patent is terminated or withdrawn (but it will continue to have effect if the application is reinstated or resuscitated); or (2) when the patent ceases to have effect: Sch 1 para 5(3). Where a request is made: (a) by a government department or any person authorised in writing by a government department; and (b) for the purposes of using the patented invention for the services of the Crown, no undertaking is required and any undertaking by the government department or the person so authorised does not have effect: Sch 1 para 5(4). Where a licence under the patent to which the undertaking relates is available as of right or a compulsory licence in respect of the patent to which the undertaking relates has been granted, any undertaking made has no effect to the extent necessary to give effect to any such licence: Sch 1 para 5(5). As to licensing see PARA 378 et seq.

17 The comptroller must also send any form required by the Budapest Treaty (see note 12): Patents Rules 2007, SI 2007/3291, Sch 1 para 4(5).

18 Patents Rules 2007, SI 2007/3291, Sch 1 para 4(6).

19 Ie where (except for Crown use: see note 16): (1) the applicant requests on Patents Form 8A that a sample of the biological material should only be made available to an expert, and that request is made before the preparations for the application's publication have been completed by the UK Intellectual Property Office; and (2) in relation to an international application for a patent (UK), the applicant made a reference to the deposited biological material in accordance with the Patent Co-operation Treaty (see PARA 653 et seq): Patents Rules 2007, SI 2007/3291, Sch 1 para 6(1)-(3). 'Expert' means independent expert: Sch 1 para 1. Where the

condition in head (1) is met, the comptroller, when he publishes the application, must include a notice that the provisions of Sch 1 para 7 apply (see note 20): Sch 1 para 6(4). Nothing in Sch 1 paras 6, 7 affects the rights under the Patents Act 1977 s 55 (see PARA 405) of any government department or any person authorised in writing by a government department: Patents Rules 2007, SI 2007/3291, Sch 1 para 6(6). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

20 Patents Rules 2007, SI 2007/3291, Sch 1 paras 6, 7. Where the conditions in note 19 heads (1) and (2) are met (except in relation to Crown use: see note 16), Sch 1 para 7 applies until the following dates: (1) where the patent is granted, the period ending with the date on which the patent was granted; and (2) where the application is terminated or withdrawn, 20 years beginning with the date of filing: Sch 1 para 6(5). A request for a sample to be made available to an expert must be made on Patents Form 8 and must include details of the expert: Sch 1 para 7(1). Where the biological material has been deposited at an international depository authority, the request must be accompanied by any form required by the Budapest Treaty (see note 12): Patents Rules 2007, SI 2007/3291, Sch 1 para 7(2). The comptroller must send a copy of Patents Form 8 to the applicant for the patent: Sch 1 para 7(3). Before the end of the period of one month beginning with the date on which a copy of Patents Form 8 is sent by the comptroller, the applicant may give notice of his objection to the particular expert, and where he objects the comptroller must determine the matter: Sch 1 para 7(4). Where: (a) the applicant does not object to the sample being made available; or (b) following an objection, the comptroller decides that the sample should be made available to the particular expert, the comptroller must issue a certificate authorising the release of a sample to the expert: Sch 1 para 7(5). A copy of Patents Form 8 (and any form required by the Budapest Treaty) and any certificate issued under the Patents Rules 2007, SI 2007/3291, Sch 1 para 7(5) must be sent to the applicant for the patent, the depository institution where the sample of the biological material is stored, the expert and the person who made the request: Sch 1 para 7(6).

21 The following rule applies where the first, second or third circumstance occurs: Patents Rules 2007, SI 2007/3291, Sch 1 para 8. The first circumstance is that the biological material ceases to be available at the depository institution because it is no longer viable: Sch 1 para 8(2). The second circumstance is that: (1) the depository institution is, for any other reason, unable to supply the biological material; or (2) the place where the biological material is deposited is no longer a depository institution for that type of material (whether temporarily or permanently): Sch 1 para 8(3). The third circumstance is that the biological material is transferred to a different depository institution: Sch 1 para 8(4). The first requirement and the second requirement are treated as having been complied with throughout the relevant period, if and only if: (a) where the first or second circumstance occurs (i) a new deposit of biological material is made at the relevant depository before the end of the relevant period, and (ii) that deposit is accompanied by a statement, signed by the person making the deposit, that the biological material deposited is the same as that originally deposited; and (b) in all circumstances, the applicant or proprietor, before the end of the relevant period, applies to the comptroller to amend the specification of the application for the patent, or the patent, so that it meets the second requirement: Sch 1 para 8(5). The prescribed time limit may not be extended: see PARA 599. The 'relevant period' is the period beginning when the first, second or third circumstance occurs and ending three months after the date on which the depositor is notified by the depository institution that the first, second or third circumstance occurred or, where it expires later, three months after the date on which that circumstance is advertised in the Official Journal (Patents) (see PARA 580): Sch 1 para 8(6). The relevant depository is, where only the first circumstance occurs, the depository institution where the original deposit was made or, in any other case, any depository institution: Sch 1 para 8(7).

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323. Sequence listings.

Where the specification of an application for a patent discloses a nucleotide and/or amino acid sequence, it must include a sequence listing¹. Where an applicant has not provided a sequence listing on filing the application², the comptroller³ may specify a period within which the applicant must provide the sequence listing; and if it is not provided within this period, the comptroller may refuse the application⁴.

Where a sequence listing is provided after the date of filing the application⁵, the listing must be accompanied by a declaration that it does not contain matter extending beyond the sequence disclosed in the application⁶.

The sequence listing must comply with any requirements and standards adopted under the Patent Co-operation Treaty for the presentation of sequence listings in patent applications⁷.

A sequence listing must, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications, even where the application for the patent is not delivered in electronic form or using electronic communications⁸.

A sequence listing may be set out either in the description or at the end of the application⁹.

¹ Patents Rules 2007, SI 2007/3291, rr 2(1), 13(2); Administrative Instructions under the Patent Co-operation Treaty (WIPO, 7 February 2007). As to the Patent Co-operation Treaty see PARA 653 et seq.

² As to the application see PARAS 315-318.

³ As to the comptroller see PARA 577.

⁴ Patents Rules 2007, SI 2007/3291, r 13(3).

⁵ As to the date of filing see PARA 316.

⁶ Patents Rules 2007, SI 2007/3291, r 13(4).

⁷ Patents Rules 2007, SI 2007/3291, r 13(5). See the Regulations under the Patent Co-operation Treaty (WIPO, 1 April 2007) rules 5.2, 13.

⁸ Patents Rules 2007, SI 2007/3291, r 13(6). As to the use of electronic communications see PARA 584.

⁹ Patents Rules 2007, SI 2007/3291, r 13(7). If the sequence listing is set out at the end of the application, r 12(4) (see PARA 315 note 7) does not apply: r 13(7).

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324. Body and claims.

A specification¹ customarily begins, after the title, with a general preamble stating, usually in more detail than in the title, the subject to which the invention relates, indicating upon what old arrangements the invention is an improvement and the respects in which they needed improvement, and otherwise stating the objects of the invention, possibly summarising other proposals for solving the same problems, and setting out the nature of the invention in general terms². This statement usually includes a clause (the 'consistory clause'³), in substantially the same terms as the main claim. Then follows a detailed description of one or more embodiments of the invention, often with a suggestion of alternatives. The whole of this is known as the 'body of the specification'. The specification ends with the claims, delimiting the monopoly granted by the patent. There may be included in the body, usually immediately before the claims, disclaimers of part of the matter covered by the language of the claims.

The preamble to the body and the claims, on the one hand, and the remainder of the body, on the other, have quite different functions⁴. The body, apart from the preamble, is there to instruct those skilled in the art concerned in the carrying out of the invention and must be comprehensible to and not mislead a skilled reader⁵. The claims, since they define the monopoly, will in the event of legal proceedings be scrutinised with as much care as any other document defining a legal right, and require to be as carefully drawn⁶. The preamble, which may determine the manner in which a reader approaches the claims, should be drawn with almost equal care.

1 As to the statutory requirements for specifications see PARA 319.

2 The statement of subject, and the consistory clauses, are insisted upon by the UK Intellectual Property Office and the insertion of references to prior art may also be required. The remainder of the preamble is, in general, optional. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 Ie from the phrase 'my invention consists . . . '.

4 *Electric and Musical Industries Ltd v Lissen Ltd* (1937) 54 RPC 307, CA; approved [1938] 4 All ER 221, 56 RPC 23, HL.

5 As to these requirements of the description see PARA 319.

6 As to the construction of the specification and claims generally see PARA 412 et seq.

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325. Arrangement of claims.

The usual practice is to begin the claims¹ with one to the invention in its broadest aspect, and to follow it with narrower claims, restricted by additional limitations to particular forms of the invention². There may be claims to variants upon the original claim; and claims to a process may be coupled with claims to the product, or to the apparatus used for carrying it out³.

Where the specification includes drawings⁴, or examples of a chemical or like process, it is customary to end with a claim or claims to the invention substantially as described with reference to and as shown in the drawings, or substantially according to the examples. Such claims are permissible⁵.

1 As to the statutory requirements for claims see PARA 319.

2 It is usual in British specifications for these to take the form of a main or independent claim, with subordinate or subsidiary claims, ie claims referring back to the main claim (or to earlier subordinate claims) and adding a limitation to it.

3 See eg *Re L'Air Liquide SA's Application* (1932) 49 RPC 428 (where a claim for apparatus for carrying out a process also claimed was interpreted as a claim for the apparatus per se).

4 As to drawings see PARA 320.

5 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* [1948] 1 All ER 308, 65 RPC 141, HL; *Daikin Kogyo Co Ltd (Shingu's) Application* [1974] RPC 559, CA.

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326. The abstract.

The abstract contained in an application for a patent¹ must commence with a title for the invention² and must contain a concise summary of the matter contained in the specification³. That summary must include:

- 52 (1) an indication of the technical field to which the invention belongs⁴;
- 53 (2) a technical explanation of the invention⁵; and
- 54 (3) the principal use of the invention⁶.

Where the specification contains more than one drawing⁷, the abstract must include an indication of the drawing which should accompany the abstract when it is published⁸. Where it appears to the comptroller⁹ that a drawing included in the specification better characterises the invention he must publish it with the abstract¹⁰. Where a feature of the invention included in the abstract is illustrated in a drawing, the feature must be followed by the reference for that feature used in that drawing¹¹.

The abstract must not contain any statement on the merits or value of the invention or its speculative application¹².

The purpose of the abstract is to give technical information¹³. The comptroller may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does¹⁴.

On publication of the application the abstract does not form part of the state of the art¹⁵.

1 Ie under the Patents Act 1977: see PARA 303.

2 Patents Rules 2007, SI 2007/3291, r 15(1). As to the meaning of 'invention' see PARA 301 note 2.

3 Patents Rules 2007, SI 2007/3291, r 15(2). As to the presentation of the abstract see PARA 315; and as to the specification see PARA 319.

4 Patents Rules 2007, SI 2007/3291, r 15(3)(a).

5 Patents Rules 2007, SI 2007/3291, r 15(3)(b).

6 Patents Rules 2007, SI 2007/3291, r 15(3)(c).

7 As to drawings see PARA 320.

8 Patents Rules 2007, SI 2007/3291, r 15(4). As to publication of the application see PARA 327.

9 As to the comptroller see PARA 577.

10 Patents Rules 2007, SI 2007/3291, r 15(5).

11 Patents Rules 2007, SI 2007/3291, r 15(6).

12 Patents Rules 2007, SI 2007/3291, r 15(7).

13 Patents Act 1977 s 14(7).

14 Patents Act 1977 s 14(7).

15 Patents Act 1977 s 14(7). As to the state of the art see s 2(3); and PARA 435.

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(v) Publication, Examination and Search

327. Publication of the application.

An application for a patent¹ which has a date of filing² and which has not been withdrawn or refused³ before preparations for its publication have been completed by the UK Intellectual Property Office⁴ must be published by the comptroller⁵ as soon as possible after the end of the period of 18 months calculated from the declared priority date⁶ or, where there is no declared priority date, from the date of filing⁷. The application is published as filed, including not only the original claims but also any amendments of those claims and any new claims subsisting immediately before the completion of the preparations for publication⁸. The comptroller may, however, omit from the specification⁹ of a published application any matter which in his opinion disparages any person in a way likely to damage him¹⁰, or the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour¹¹.

The comptroller must in any event advertise the fact and date of publication of an application in the Official Journal (Patents)¹².

The publication of the application is subject to the protection of national security¹³ and to any application by the inventor to waive his right to have his name or address mentioned¹⁴.

1 le under the Patents Act 1977: see PARA 303.

2 As to the meaning of 'date of filing' see PARA 316.

3 As to the withdrawal and refusal of applications see PARA 332.

4 The comptroller must determine on a case-by-case basis when the preparations for publication have been completed: see *Intera Corpn's Application* [1986] RPC 459, CA (where it was held that an earlier rule giving the comptroller power to determine when the preparations had been completed was ultra vires). It is the practice of the UK Intellectual Property Office to send a letter stating that preparations are near completion but that they will not be completed before one week from the date of the letter and that no further notice will be given: see Official Journal (Patents), 9 April 1986. The current practice concerning the physical aspects of preparation for publication is explained in *Peabody International's Application* [1986] RPC 521. Once the preparations have been completed, the UK Intellectual Property Office has no discretion but must publish the application: see *Intera Corpn's Application* [1986] RPC 459, CA. The European Patent Office does, however, have such a discretion: see Case J-05/81 *Hormann/Publication of a European patent application* [1979-1985] EPOR 83, Legal Board of Appeal.

The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

5 As to the comptroller see PARA 577.

6 As to the meaning of 'declared priority date' see PARA 311 note 9.

7 Patents Act 1977 s 16(1); Patents Rules 2007, SI 2007/3291, r 26(1). If so requested by the applicant, the comptroller may publish the application within the appropriate period: Patents Act 1977 s 16(1). It should be noted that, if the full 12 months' priority is claimed under s 5(2) (see PARA 311), publication will be only six months after filing. As to claims for infringement in respect of published applications see PARA 548.

References in the Patents Act 1977 to an application for a patent being published are references to its being published under s 16 (s 130(5)); and 'published' means made available to the public, whether in the United Kingdom or elsewhere, and a document is to be taken to be published under any provision of the Patents Act

1977 if it can be inspected as of right at any place in the United Kingdom by members of the public whether on payment of a fee or not; and 'republished' is to be construed accordingly (s 130(1)). As to the meaning of 'United Kingdom' see PARA 303 note 5.

8 Patents Act 1977 s 16(1). As to the meaning of 'application as filed' see PARA 317 note 2. As to amendment before grant see PARA 330; and as to inspection of published applications see PARA 581.

9 As to the contents of specifications see PARA 319.

10 Patents Act 1977 s 16(2)(a).

11 Patents Act 1977 s 16(2)(b).

12 Patents Act 1977 s 16(1). As to the Journal see PARA 580.

13 In subject to the Patents Act 1977 s 22 (see PARA 335): s 16(1).

14 Patents Act 1977 s 16(1) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 6); Patents Rules 2007, SI 2007/3291, r 26(2).

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328. Search.

The comptroller¹ must refer an application for a patent² to an examiner³ for a search if, and only if⁴:

- 55 (1) the comptroller has referred the application to an examiner for a preliminary examination⁵;
- 56 (2) the application has not been withdrawn or treated as withdrawn⁶;
- 57 (3) before the end of the prescribed period⁷: (a) the applicant makes a request to the UK Intellectual Property Office in the prescribed form⁸ for a search; and (b) the fee prescribed for the search (the 'search fee')⁹ is paid¹⁰;
- 58 (4) the application includes: (a) a description of the invention for which a patent is sought; and (b) one or more claims¹¹; and
- 59 (5) the description and each of the claims comply with the requirements of rules as to language¹².

On a search, the examiner must make such investigation as in his opinion is reasonably practicable and necessary for him to identify the documents which he thinks will be needed to decide, on a substantive examination¹³, whether the invention for which a patent is sought is new¹⁴ and involves an inventive step¹⁵.

On any such search the examiner must determine whether or not the search would serve any useful purpose on the application as for the time being constituted and: (i) if he determines that it would serve such a purpose in relation to the whole or part of the application, he must proceed to conduct the search so far as it would serve such a purpose and must report on the results of the search to the comptroller; and (ii) if he determines that the search would not serve such a purpose in relation to the whole or part of the application, he must report accordingly to the comptroller; and in either event the applicant must be informed of the examiner's report¹⁶.

If it appears to the examiner, either before or on conducting a search, that an application relates to two or more inventions, but that they are not so linked as to form a single inventive concept¹⁷, he must initially only conduct a search in relation to the first invention specified in the claims of the application, but may proceed to conduct a search in relation to another invention so specified if the applicant pays the search fee in respect of the application so far as it relates to that other invention¹⁸.

After a search has been requested for an application, the comptroller may at any time refer the application to an examiner for a supplementary search, and the above provisions¹⁹ apply in relation to a supplementary search as they apply in relation to any other search²⁰.

A reference for a supplementary search in consequence of an amendment of the application made by the applicant²¹, or a correction of the application, or of a document filed in connection with the application²², may be made only on payment of the prescribed fee²³, unless the comptroller directs otherwise²⁴.

1 As to the comptroller see PARA 577.

2 ie under the Patents Act 1977: see PARA 303.

3 Functions of an examiner of the UK Intellectual Property Office under the Patents Act 1977 s 17 may be contracted out: see the Contracting Out (Functions in Relation to Applications for Patents) Order 2002, SI 2002/3052.

The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 Patents Act 1977 s 17(1) (substituted by SI 2004/2357).

5 Patents Act 1977 s 17(1)(a) (as substituted: see note 4). A preliminary examination is carried out under s 15A(1) (see PARA 318).

6 Patents Act 1977 s 17(1)(b) (as substituted: see note 4). As to the withdrawal of applications see PARA 332.

7 Except for new applications, and subject to the Patents Rules 2007, SI 2007/3291, r 58(4) (see PARA 678), r 59(3) (see PARA 678) and r 68(3) (see PARA 316), the period prescribed for the purposes of the Patents Act 1977 s 17(1) is the relevant period: Patents Rules 2007, SI 2007/3291, r 22(2), (4). The relevant period is: (1) where there is no declared priority date, 12 months beginning with the date of filing of the application; or (2) where there is a declared priority date (a) 12 months beginning with the declared priority date; or (b) if it expires later, the period of two months beginning with the date of filing of the application: r 22(7). In relation to a new application the prescribed period is two months beginning with its initiation date or, if it expires later, the relevant period: r 22(5)(a). However, where the new application is filed less than six months before the compliance date, the prescribed period is the period ending with its initiation date: r 22(6). As to the extension of time limits see para 599. As to the meaning of 'date of filing' see PARA 316. As to the meaning of 'declared priority date' see PARA 311 note 9. As to the meaning of 'initiation date' see PARA 311 note 5. Where an international application for a patent (UK) has begun the national phase (see PARA 664 et seq), the period prescribed for the purposes of the Patents Act 1977 s 17(1) is the period prescribed by the Patents Rules 2007, SI 2007/3291, r 22(2), (7) or, if it expires later, the period of two months beginning with the date on which the national phase begins: r 68(1), (3).

8 A request for a search must be made on Patents Form 9A: Patents Rules 2007, SI 2007/3291, r 27(1).

9 On request for a search under the Patents Act 1977 s 17(1) in accordance with the Patents Rules 2007, SI 2007/3291, r 27: (1) in respect of an international application for a patent (UK), which has already been the subject of a search by the International Searching Authority the fee payable is £80; and (2) in respect of any other application the fee payable is £100: Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1.

10 Patents Act 1977 s 17(1)(c) (as substituted: see note 4).

11 Patents Act 1977 s 17(1)(d) (as substituted: see note 4).

12 Patents Act 1977 s 17(1)(e) (as substituted: see note 4). As to translations see PARA 597. The filing of a translation of a priority document is not a formal requirement; accordingly the comptroller is not under an obligation to inform an applicant of his failure to file such a translation: *Mitsui Engineering & Shipbuilding Co Ltd's Application* [1984] RPC 471.

13 Ie under the Patents Act 1977 s 18 (see PARA 329).

14 As to novelty see PARA 435 et seq.

15 Patents Act 1977 s 17(4). As to inventive step see PARA 452 et seq.

16 Patents Act 1977 s 17(5). The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report: Patents Rules 2007, SI 2007/3291, r 27(2).

17 As to inventions which form a single inventive concept see PARA 319 note 9.

18 Patents Act 1977 s 17(6). Where an examiner conducts a search in relation to the first only of two or more inventions, in accordance with s 17(6), he must report this fact to the comptroller, and the comptroller must notify the applicant accordingly: Patents Rules 2007, SI 2007/3291, r 27(3). The applicant must pay any search fee in relation to those inventions (other than the first) on or before the relevant date: r 27(4). The relevant date is the first day of the three month period ending with the compliance date of the application: r 27(5). The fee for a search under the Patents Act 1977 s 17(6) must be accompanied by Patents Form 9A: Patents Rules 2007, SI 2007/3291, r 27(6). The fee payable on request of a further search under the Patents Act 1977 s 17(6) is £100: Patents (Fees) Rules 2007, SI 2007/3292, Sch 1.

19 Ie the Patents Act 1977 s 17(4), (5) (see the text and notes 13-16).

- 20 Patents Act 1977 s 17(7) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 3).
- 21 le under the Patents Act 1977 s 18(3) (see PARA 329) or s 19(1) (see PARA 330).
- 22 le under the Patents Act 1977 s 117 (see PARA 354).
- 23 The fee payable for a supplementary search under the Patents Act 1977 s 17(8) is £100: Patents (Fees) Rules 2007, SI 2007/3292, Sch 1.
- 24 Patents Act 1977 s 17(8) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 3).

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329. Substantive examination and grant.

Where an applicant wishes to proceed with an application for a patent¹ to grant and the conditions for the application to be referred for a search² are satisfied, the applicant must make a request to the UK Intellectual Property Office³ in the prescribed form for a substantive examination⁴ and pay the prescribed fee⁵. The request must be made and the fee paid either at the time of the request for a preliminary examination or within six months of the date of publication of the application⁶. The comptroller⁷ must then refer the application to an examiner for a substantive examination⁸.

If the examiner forms the view that a supplementary search⁹ is required for which a fee is payable¹⁰, he must inform the comptroller, who may decide that the substantive examination should not proceed until the fee is paid; and, if he so decides, then, unless within such period as he may allow¹¹ the fee is paid or the application is amended so as to render the supplementary search unnecessary¹², he may refuse the application¹³.

On a substantive examination the examiner must investigate, to such extent as he considers necessary in view of any preliminary examination and search which have been carried out, whether the application complies with the statutory requirements¹⁴ and must determine that question and report his determination to the comptroller¹⁵. If the examiner reports that any of those requirements are not complied with, the comptroller must give the applicant an opportunity, within a specified period, to make observations on the report and to amend the application so as to comply with those requirements¹⁶. If the applicant fails to satisfy the comptroller that those requirements are complied with or to amend the application so that it does comply, the comptroller may refuse the application¹⁷.

If the examiner reports that the application, whether as originally filed or as amended¹⁸, complies with those requirements at any time before the end of the prescribed period¹⁹, the comptroller must so notify the applicant and, on payment within the prescribed period of any fee prescribed for grant, may grant him a patent²⁰. However, where two or more applications for the same invention having the same priority date have been filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications²¹.

1 le under the Patents Act 1977: see PARA 303.

2 le under the Patents Act 1977 s 17(1): see PARA 328 heads (1) to (5).

3 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 Patents Act 1977 s 18(1)(a). A request for a substantive examination of an application must be made on Patents Form 10: Patents Rules 2007, SI 2007/3291, r 28(1).

5 Patents Act 1977 s 18(1)(b). The fee payable on request for a substantive examination of an application in accordance with the Patents Rules 2007, SI 2007/3291, r 18 is £70: Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1.

6 Patents Act 1977 s 18(1) (amended by SI 2004/2357); Patents Rules 2007, SI 2007/3291, r 28(2). Rule 28(2) is subject to the provisions of r 60 (see PARA 678) and r 68(4) (see PARA 329 note 6) and r 28(3), (4): r 28(2). As to the publication of the application see the Patents Act 1977 s 16; and PARA 327. Where an application is subject to directions under s 22(1) or (2) (non-disclosure of information on grounds of security or

safety: see PARA 335), the request must be made and the fee paid within two years of the declared priority date or, when there is no declared priority date, within two years of the date of filing the application: Patents Rules 2007, SI 2007/3291, r 28(3), (7). As to the extension of time limits see para 599. As to the meaning of 'declared priority date' see PARA 311 note 9; and as to the meaning of 'date of filing' see PARA 316.

Where a new application is filed under the Patents Act 1977 s 8(3) (see PARA 362), s 12(6) (see PARA 364), s 15(9) (see PARA 317) or s 37(4) (see PARA 366) then the period prescribed for the purposes of s 18(1) is: (1) two months beginning with its initiation date; or (2) if it expires later, two years of the declared priority date or, when there is no declared priority date, within two years of the date of filing the application, and the reference to the date of filing of the application is a reference to the date of filing of the earlier application: Patents Rules 2007, SI 2007/3291, r 28(5), (7). But where the new application is filed less than six months before the compliance date, the period prescribed for the purposes of the Patents Act 1977 s 18(1) is the period ending with its initiation date: Patents Rules 2007, SI 2007/3291, r 28(6). As to the meaning of 'initiation date' see PARA 311 note 5. As to the prescribed period following a direction under the Patents Act 1977 s 81 (see PARA 678) see the Patents Rules 2007, SI 2007/3291, r 60; and PARA 678. Where an international application for a patent (UK) has begun the national phase (see PARA 664 et seq), the period prescribed for the purposes of the Patents Act 1977 s 18(1) is 33 months beginning with: (a) where there is no declared priority date, the date of filing of the application or, where there is a declared priority date, that date; or (b) if it expires later, the period of two months beginning with the date on which the national phase begins: Patents Rules 2007, SI 2007/3291, r 68(4).

7 As to the comptroller see PARA 577.

8 Patents Act 1977 s 18(1).

9 Ie under the Patents Act 1977 s 17: see PARA 328.

10 As to when an additional fee is payable see PARA 328.

11 There is no prescribed period.

12 Eg by deleting all references and claims to more than one invention.

13 Patents Act 1977 s 18(1A) (added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 4).

14 Ie the requirements under the Patents Act 1977 and the Patents Rules 2007, SI 2007/3291. In particular, the examiner will inquire into whether the invention is new (see PARA 435), involves an inventive step (see PARA 452 et seq) and is adequately described in the specification (see PARA 319).

15 Patents Act 1977 s 18(2).

16 Patents Act 1977 s 18(3). Whenever the examiner reports to the comptroller under either s 18(3) or s 18(4) (see the text to notes 18-20) on whether the application complies with the requirements of the Patents Act 1977 and the Patents Rules 2007, SI 2007/3291, the comptroller must send a copy of that report to the applicant: r 29(1). The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report: r 29(2). Where the applicant fails to respond within the period specified in the examiner's report, the comptroller has the power to extend the specified period but will do so only on adequate grounds put forward by the applicant: *Jaskowski's Application* [1981] RPC 197.

17 Patents Act 1977 s 18(3). As to appeals against refusal to grant a patent see PARA 639. Where an appeal is pending, the period for compliance may be extended: see s 20(2); and PARA 332. The application may be rejected whenever it appears that the requirements of the Act have not and cannot be met: *Re Rohde and Schwarz's Application* [1980] RPC 155.

18 Ie as amended in pursuance of the Patents Act 1977 s 15A (see PARA 318), s 18 or s 19 (see PARA 330).

19 For these purposes and for the purposes of the Patents Act 1977 s 20(1) (see PARA 332), the period prescribed is the compliance period: Patents Rules 2007, SI 2007/3291, r 30(1). The compliance period is: (1) four years and six months beginning with (a) where there is no declared priority date, the date of filing of the application; or (b) where there is a declared priority date, that date; or (2) if it expires later, the period of 12 months beginning with the date on which the first substantive examination report is sent to the applicant: r 30(2). Where a new application is filed the compliance period is: (i) where it is filed under the Patents Act 1977 s 8(3), s 12(6) or s 37(4), the period specified in the Patents Rules 2007, SI 2007/3291, r 30(2) in relation to the earlier application or, if it expires later, the period of 18 months beginning with the initiation date; and (ii) where it is filed as mentioned in the Patents Act 1977 s 15(9) (see PARA 316), the period specified in the Patents Rules 2007, SI 2007/3291, r 30(2) in relation to the earlier application: r 30(3). Where the first observations report (see PARA 331) is sent to the applicant during the last three months of the period specified in r 30(2) or r 30(3), the compliance period is three months beginning with the date on which that report is sent: r 30(4). As to the extension of time limits see para 599.

20 Patents Act 1977 s 18(4) (amended by SI 2004/2357). The grant of a patent is subject to the provisions of the Patents Act 1977 s 19 (amendment of application before grant: see PARA 330) and s 22 (directions as to non-disclosure precluding grant: see PARA 335): s 18(4).

21 Patents Act 1977 s 18(5). This provision places a mandatory requirement on the comptroller to refuse a second grant unless the situation giving rise to the objection under the Patents Act 1977 s 18(5) is overcome: *International Business Machines Corp'n (Barclay & Bigar's) Application* [1983] RPC 283.

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330. Amendment of applications before grant.

In addition to the two occasions when an application for a patent¹ may be amended to meet an official objection², the applicant may amend the application of his own volition, subject to certain conditions³, at any time before the patent is granted⁴.

The conditions are:

- 60 (1) the applicant may amend his application only within the period beginning with the date on which the applicant is informed of the examiner's report⁵ and ending with the date on which the comptroller⁶ sends him the first substantive examination report⁷;
- 61 (2) after the end of this period, the applicant may:
 - 3 4. (a) where the first substantive examination report states that his application complies with the statutory requirements, amend his application once before the end of the period of two months beginning with the date on which that report was sent⁸; or
 - 5. (b) where the first substantive examination report states that his application does not comply with the statutory requirements, amend his application once at the same time as he makes his first observations on, or amendments to, his application⁹ and, if the first substantive examination report is sent before preparations for the application's publication have been completed by the UK Intellectual Property Office, amend his application prior to any further amendment he may make to his application¹⁰;
- 4 62 (3) the conditions in heads (1) and (2) do not apply where the comptroller consents to the amendment or to an amendment of a request for the grant of a patent¹¹;
- 63 (4) where the comptroller's consent is required, or the applicant wishes to amend the request for the grant of a patent, the applicant must include the reasons for the amendment¹².

Any amendment made under the above provisions is subject to the general restriction that an application may not be amended so as to include added matter¹³.

In addition to amendments made by the applicant, the comptroller may, without an application being made to him for the purpose, amend the specification¹⁴ and abstract¹⁵ contained in an application for a patent so as to acknowledge a registered trade mark¹⁶.

1 le under the Patents Act 1977: see PARA 303.

2 le under the Patents Act 1977 s 15A(6) (see PARA 318) and s 18(3) (see PARA 329). No fee is required for such amendments.

3 An applicant may of his own volition amend his application in accordance with the Patents Rules 2007, SI 2007/3291, r 31 (see the text and notes 4-12).

4 Patents Act 1977 s 19(1); Patents Rules 2007, SI 2007/3291, r 31(2). A request to amend an application for a patent under s 19(1) must be made in writing: r 31(1). The claims, as amended, must comply with the

requirements of the Patents Act 1977 s 14 (see PARA 315). It is important that the amended claims be supported by the description because the patent, when granted, cannot be attacked on this ground: *Genentech Inc's Patent* [1989] RPC 147, CA; *Schering Biotech Corp'n's Application* [1993] RPC 249.

5 le under the Patents Act 1977 s 17(5): see PARA 328.

6 As to the comptroller see PARA 577.

7 Patents Rules 2007, SI 2007/3291, r 31(3).

8 Patents Rules 2007, SI 2007/3291, r 31(4)(a).

9 le under the Patents Act 1977 s 18(3) (see PARA 329).

10 Patents Rules 2007, SI 2007/3291, r 31(4)(b). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

11 Patents Rules 2007, SI 2007/3291, r 31(5).

12 Patents Rules 2007, SI 2007/3291, r 31(6).

13 See the Patents Act 1977 s 76(2); and PARA 352. See also *Flexible Directional Indicators Ltd's Application* [1994] RPC 207.

14 As to the specification see PARA 319.

15 As to abstracts see PARA 326.

16 Patents Act 1977 s 19(2). For these purposes, the reference to a registered trade mark is to be construed as a reference to a registered trade mark within the meaning of the Trade Marks Act 1994 (see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 127): s 106(1), Sch 4 para 1(1), (2).

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(vi) Third Party Observations and Withdrawal

331. Observations by third persons on patentability.

Where an application for a patent¹ has been published² but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller³ on the question whether the invention is a patentable invention, stating reasons for the observations; and the comptroller must duly consider the observations⁴.

The comptroller must send to the applicant a copy of any observations on patentability he receives⁵ except for those which, in the opinion of the comptroller, would disparage any person in a way likely to damage such person, or be generally expected to encourage offensive, immoral or anti-social behaviour⁶. The comptroller may, if he thinks fit, send to the applicant a copy of any document referred to in the observations⁷. The comptroller must send to an examiner⁸ any observations on patentability⁹.

A person does not become a party to any proceedings¹⁰ before the comptroller by reason only that he has made observations under the above provisions¹¹.

1 Ie under the Patents Act 1977: see PARA 303.

2 Ie under the Patents Act 1977 s 16: see PARA 327.

3 As to the comptroller see PARA 577.

4 Patents Act 1977 s 21(1). As to the meaning of 'patentable invention' see PARA 430 note 2.

5 Patents Rules 2007, SI 2007/3291, r 33(1).

6 Patents Rules 2007, SI 2007/3291, r 33(2).

7 Patents Rules 2007, SI 2007/3291, r 33(3).

8 See PARA 329.

9 Patents Rules 2007, SI 2007/3291, r 33(4). This does not apply where the observations are received after the examiner has reported under the Patents Act 1977 s 18(4) (see PARA 329) that an application complies with the requirements of the Patents Act 1977 and the Patents Rules 2007, SI 2007/3291: r 33(5).

10 Ie any proceedings under the Patents Act 1977.

11 Patents Act 1977 s 21(2).

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332. Withdrawal and failure of application.

An application for a patent¹ may be withdrawn at any time before the patent is granted²; and any withdrawal of such an application may not be revoked³.

An application is deemed to have been withdrawn in three instances:

- 64 (1) where an initial application⁴ has a date of filing⁵, it is deemed to have been withdrawn unless the applicant files the necessary documents to complete the application, pays the fee and requests a preliminary examination and search within the relevant prescribed period⁶;
- 65 (2) where no request for a substantive examination⁷ is made within six months of publication of the application⁸, or the prescribed fee⁹ for the examination is not paid within that period, the application is deemed to have been withdrawn¹⁰;
- 66 (3) where the applicant fails to supply the UK Intellectual Property Office¹¹ with the necessary information as to the identity of the inventor within the prescribed period¹², the application will be deemed to have been withdrawn¹³.

If it is not determined that an application for a patent complies before the end of the prescribed period¹⁴ with all the statutory requirements¹⁵, the application is treated as having been refused by the comptroller at the end of that period¹⁶. If at the end of the prescribed period an appeal to the Patents Court¹⁷ is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period:

- 67 (a) where such an appeal is pending, or is brought within the said time or before the expiration of any extension of that time granted, in the case of a first extension, on an application made within that time or, in the case of a subsequent extension, on an application made before the expiration of the last previous extension, is extended until such date at the court may determine¹⁸;
- 68 (b) where no such appeal is pending or is so brought, continues until the end of the said time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted¹⁹.

1 le under the Patents Act 1977: see PARA 303.

2 As to grant see PARA 338.

3 Patents Act 1977 s 14(9). This provision does not affect the power of the comptroller under s 117(1) (see PARA 354) to correct an error or mistake in a withdrawal of an application for a patent: s 14(10) (added by SI 2004/2357). As to the comptroller see PARA 577.

4 As to the initiation of applications see PARA 316.

5 As to the meaning of 'date of filing' see PARA 316.

6 See the Patents Act 1977 s 15(10) (substituted by SI 2004/2357); and PARA 318.

7 le under the Patents Act 1977 s 18(1): see PARA 329.

8 As to publication see PARA 327.

- 9 As to the prescribed fee see PARA 328 note 9. As to fees generally see PARA 583.
- 10 Patents Act 1977 s 18(1); Patents Rules 2007, SI 2007/3291, r 28(2).
- 11 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.
- 12 As to mention of the inventor see PARA 308.
- 13 Patents Act 1977 s 13(2).
- 14 As to the meaning of 'prescribed period' see PARA 329 note 19. As to the effect on the prescribed period when a third party makes observations under the Patents Act 1977 s 21 see the Patents Rules 2007, SI 2007/3291, r 30(4); and PARA 329 note 19. As to the meaning of 'declared priority date' see PARA 311 note 9.
- 15 Ie the requirements of the Patents Act 1977 and the Patents Rules 2007, SI 2007/3291.
- 16 Patents Act 1977 s 20(1). Section 97 (appeals from the controller: see PARA 639) applies accordingly: s 20(1).
- 17 As to the Patents Court see PARA 637 et seq.
- 18 Patents Act 1977 s 20(2)(a).
- 19 Patents Act 1977 s 20(2)(b).

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333. Effect of resuscitating a withdrawn application.

Where the comptroller¹ is requested to correct an error or mistake in a withdrawal of an application for a patent² and an application has been resuscitated in accordance with that request, the effect of that resuscitation is as follows³:

- 69 (1) anything done under or in relation to the application during the period between the application being withdrawn and its resuscitation is treated as valid⁴;
- 70 (2) if the comptroller has published notice of the request⁵, anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the application had not been withdrawn is treated as an infringement of those rights if it was a continuation or repetition of an earlier act infringing those rights⁶;
- 71 (3) if the comptroller has published notice of the request⁷ and, after the withdrawal of the application and before publication of the notice, a person: (a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the withdrawal had not taken place; or (b) made in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the resuscitation of the application and the grant of the patent; but this right does not extend to granting a licence to another person to do the act⁸;
- 72 (4) if the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by head (3) above may: (a) authorise the doing of that act by any partners of his for the time being in that business; and (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made⁹.

The above provisions apply in relation to the use of a patented invention for the services of the Crown¹⁰ as they apply in relation to infringement of the rights conferred by publication of the application for a patent or, as the case may be, infringement of the patent¹¹.

1 As to the comptroller see PARA 577.

2 See PARA 332.

3 Patents Act 1977 s 117A(1) (s 117A added by SI 2004/2357).

4 Patents Act 1977 s 117A(2) (as added: see note 3).

5 I.e. as mentioned in the Patents Act 1977 s 117(3) (see PARA 354).

6 Patents Act 1977 s 117A(3) (as added: see note 3).

7 See note 5.

8 Patents Act 1977 s 117A(4) (as added: see note 3). As to licences see PARA 378 et seq. Where a product is disposed of to another in exercise of a right conferred by s 117A(4) or s 117A(5), that other and any person

claiming through him may deal with the product in the same way as if it had been disposed of by the applicant:
s 117A(6) (as added: see note 3).

9 Patents Act 1977 s 117A(5) (as added: see note 3). See note 8. As to ownership and devolution see PARA 360 et seq.

10 See PARA 404 et seq.

11 Patents Act 1977 s 117A(7) (added by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 23).

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334. Reinstatement of applications.

Where an application for a patent¹ is refused, or is treated as having been refused or withdrawn², as a direct consequence of a failure by the applicant to comply with a statutory requirement³ within a period which is prescribed⁴ or specified by the comptroller⁵, then the comptroller may reinstate the application if, and only if:

- 73 (1) the applicant requests him to do so⁶;
- 74 (2) the request complies with the relevant requirements of rules⁷; and
- 75 (3) he is satisfied that the failure to comply mentioned above was unintentional⁸.

The comptroller must not reinstate the application if an extension remains available⁹ for the period referred to above¹⁰, or that period is set out or specified in relation to any proceedings before the comptroller¹¹, or for the purposes of the declaration of priority date¹² or for the purposes of a request for reinstatement¹³ or extension of time limit¹⁴.

Where the application was made by two or more persons jointly, a request for reinstatement may, with the leave of the comptroller, be made by one or more of those persons without joining the others¹⁵.

If the application has been published¹⁶, then the comptroller must publish notice of a request for reinstatement in the prescribed manner¹⁷.

The reinstatement of an application must be by order¹⁸. If an application is reinstated the applicant must comply with the requirement he failed to comply with earlier¹⁹ within the further period specified by the comptroller in the order reinstating the application²⁰. If the applicant fails so to comply, the application is treated as having been withdrawn on the expiry of the period specified²¹.

The effect of reinstatement of an application for a patent is as follows²²:

- 76 (a) anything done under or in relation to the application during the period between termination and reinstatement is to be treated as valid²³;
- 77 (b) if the application has been published²⁴ before its termination anything done during that period which would have constituted an infringement of the rights conferred by publication of the application if the termination had not occurred is to be treated as an infringement of those rights: (i) if done at a time when it was possible for the period referred to above²⁵ to be extended; or (ii) if it was a continuation or repetition of an earlier act infringing those rights²⁶;
- 78 (c) if the application has been published²⁷ before its termination and, after the termination and before publication of notice of the request for its reinstatement, a person: (i) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place; or (ii) made in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the reinstatement of the application and the grant of the patent; but this right does not extend to granting a licence to another person to do the act²⁸.

- 1 le under the Patents Act 1977: see PARA 303.
- 2 See PARA 332.
- 3 le a requirement of the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.
- 4 le a period set out in the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.
- 5 Patents Act 1977 s 20A(1) (ss 20A, 20B added by SI 2004/2357). As to the comptroller see PARA 577.
- 6 Patents Act 1977 s 20A(2)(a) (as added: see note 5).
- 7 Patents Act 1977 s 20A(2)(b) (as added: see note 5). A request under s 20A for the reinstatement of an application must be made before the end of the relevant period: Patents Rules 2007, SI 2007/3291, r 32(1). The prescribed time limit may not be extended: see PARA 599. For this purpose the relevant period is: (1) two months beginning with the date on which the removal of the cause of non-compliance occurred; or (2) if it expires earlier, the period of 12 months beginning with the date on which the application was terminated: r 32(2). The request must be made on Patents Form 14: r 32(3). The applicant must file evidence in support of that request: r 32(5). Where that evidence does not accompany the request, the comptroller must specify a period within which the evidence must be filed: r 32(6). Where, on consideration of that evidence, the comptroller is not satisfied that a case for an order under the Patents Act 1977 s 20A has been made out, he must notify the applicant accordingly: Patents Rules 2007, SI 2007/3291, r 32(7). The applicant may, before the end of the period of one month beginning with the date of that notification, request to be heard by the comptroller: r 32(8). Where the applicant requests a hearing, the comptroller must give him an opportunity to be heard, after which the comptroller must determine whether the request under the Patents Act 1977 s 20A is to be allowed or refused: Patents Rules 2007, SI 2007/3291, r 32(9). Where the comptroller reinstates the application after a notice was published, he must advertise in the journal the fact that he has reinstated the application: r 32(10). In determining the date on which the removal of the cause of non-compliance occurred, the comptroller must have regard to any relevant principles applicable under the European Patent Convention (see PARA 668 et seq): Patents Rules 2007, SI 2007/3291, r 32(11).
- 8 Patents Act 1977 s 20A(2)(c) (as added: see note 5).
- 9 le under the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.
- 10 Patents Act 1977 s 20A(3)(a) (as added: see note 5).
- 11 As to proceedings before the comptroller see PARA 517 et seq.
- 12 le under the Patents Act 1977 s 5(2A)(b) (see PARA 311).
- 13 le under the Patents Act 1977 s 20A.
- 14 Patents Act 1977 s 20A(3)(b) (as added: see note 5). A request for extension is made under s 117B (see PARA 599).
- 15 Patents Act 1977 s 20A(4) (as added: see note 5).
- 16 le under the Patents Act 1977 s 16 (see PARA 327).
- 17 Patents Act 1977 s 20A(5) (as added: see note 5). Where the comptroller is required to publish a notice under s 20A(5), it must be published in the Official Journal (Patents) (see PARA 580): Patents Rules 2007, SI 2007/3291, r 32(4).
- 18 Patents Act 1977 s 20A(6) (as added: see note 5).
- 19 le the requirement referred to in the Patents Act 1977 s 20A(1) (see the text to note 3).
- 20 Patents Act 1977 s 20A(7) (as added: see note 5). The further period specified under s 20A(7) must not be less than two months: s 20A(8) (as added: see note 5).
- 21 Patents Act 1977 s 20A(9) (as added: see note 5).
- 22 Patents Act 1977 s 20B(1) (as added: see note 5). The provisions of s 20B(1)-(6) (see the text and notes 23-28) apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to infringement of the rights conferred by publication of the application for a patent or, as the case may be, infringement of the patent: s 20B(6A) (added by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 7). As to Crown use see PARA 404 et seq.

23 Patents Act 1977 s 20B(2) (as added: see note 5). 'Termination', in relation to an application, means: (1) the refusal of the application; or (2) the application being treated as having been refused or withdrawn: s 20B(7) (as added: see note 5).

24 Ie under the Patents Act 1977 s 16 (see PARA 327).

25 Ie the period referred to in the Patents Act 1977 s 20A(1) (see the text to notes 1-5).

26 Patents Act 1977 s 20B(3) (as added: see note 5).

27 See note 24.

28 Patents Act 1977 s 20B(4) (as added: see note 5). As to licences see PARA 378 et seq. If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by s 20B(4) may: (1) authorise the doing of that act by any partners of his for the time being in that business; and (2) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made: s 20B(5) (as added: see note 5). As to ownership, devolution and assignment see PARA 360 et seq.

Where a product is disposed of to another in exercise of a right conferred by s 20B(4) or s 20B(5), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant: s 20B(6) (as added: see note 5).

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(vii) Secrecy Directions and Restrictions on Filing Abroad

335. Secrecy for purposes of national security and public safety.

Where an application for a patent¹ is filed in the UK Intellectual Property Office² and it appears to the comptroller³ that the application contains information of a description notified to him by the Secretary of State⁴ as being information the publication of which might be prejudicial to the national security, the comptroller may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons⁵.

Similarly, if it appears to the comptroller that any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of the statutory provisions⁶ relating to publication of the application⁷.

The comptroller must notify the Secretary of State of any application in respect of which he has given directions and of the directions⁸, and the Secretary of State must then consider whether the publication of the application⁹ or the publication or communication of the information in question would be prejudicial to the national security or the safety of the public¹⁰. If he determines that the publication of the application or the publication or communication of that information would be prejudicial to the safety of the public, he must notify the comptroller who must continue his directions¹¹ until they are revoked¹².

If the Secretary of State determines that the publication of the application or the publication or communication of the information in question would be prejudicial to the national security or the safety of the public, he must reconsider the question during the period of nine months from the date of filing the application and at least once in every subsequent period of 12 months¹³. For the purposes of deciding the question, he may at any time after the expiry of the prescribed period¹⁴ inspect the application and any documents sent to the comptroller in connection with it¹⁵. However, where the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use, he may at any time inspect the application and any documents sent to the comptroller in connection with it or authorise a government body with responsibility for the production of atomic energy or for research into matters connected with its production or use¹⁶, or a person appointed by such a government body, to inspect the application and any documents sent to the comptroller in connection with it¹⁷.

If on consideration of an application at any time it appears to the Secretary of State that the publication of the application or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to the national security or the safety of the public, he must give notice to the comptroller to that effect¹⁸. On receipt of such a notice the comptroller must revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorised to be done in connection with the application, whether or not that time has previously expired¹⁹.

- 1 le under the Patents Act 1977 (see PARA 303) or any treaty or international convention to which the United Kingdom is a party: see the Patents Act 1977 s 22(1). See PARA 652 et seq. As to the meaning of 'United Kingdom' see PARA 303 note 5.
- 2 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.
- 3 As to the comptroller see PARA 577.
- 4 As to the Secretary of State see PARA 575.
- 5 Patents Act 1977 s 22(1) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 8(1), (3)). As to the effect of such directions see PARA 336.
- 6 le the period prescribed for the purposes of the Patents Act 1977 s 16: see PARA 327. As to the period so prescribed see the Patents Rules 2007, SI 2007/3291, r 26; and PARA 327.
- 7 Patents Act 1977 s 22(2). As to the effect of such directions see PARA 336.
- 8 Patents Act 1977 s 22(5).
- 9 As to publication of applications see PARA 327.
- 10 Patents Act 1977 s 22(5)(a) (amended by the Patents Act 2004 Sch 2 paras 1(1), 8(1), (3)).
- 11 le under the Patents Act 1977 s 22(2): see the text and notes 6-7.
- 12 Patents Act 1977 s 22(5)(b).
- 13 Patents Act 1977 s 22(5)(c) (amended by the Patents Act 2004 Sch 2 paras 1(1), 8(1), (3)).
- 14 See note 6.
- 15 Patents Act 1977 s 22(6)(b).
- 16 See **FUEL AND ENERGY** vol 19(3) (2007 Reissue) PARA 1363 et seq.
- 17 Patents Act 1977 s 22(6)(a) (amended by the Patents Act 2004 Sch 2 paras 1(1), 8(1), (4)). Where a government body or person appointed by a government body carries out an inspection which it is authorised to carry out, the body or the person must report on the inspection to the Secretary of State as soon as practicable: Patents Act 1977 s 22(6) (amended by the Patents Act 2004 Sch 2 paras 1(1), 8(1), (4)).
- 18 Patents Act 1977 s 22(5)(d) (amended by the Patents Act 2004 Sch 2 paras 1(1), 8(1), (3)).
- 19 Patents Act 1977 s 22(5)(e).

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336. Effect of directions as to secrecy.

While directions as to secrecy¹ are in force in respect of an application for a patent², the application may proceed to the stage where it is in order for the grant of a patent³. However, the application must not be published, the information to which the directions apply must not be communicated contrary to the directions, and no patent will be granted pursuant to the application⁴. If the application is an application for a European patent⁵, it must not be sent to the European Patent Office⁶. Similarly, if the application is an international application for a patent⁷, a copy of it must not be sent to the International Bureau⁸ or to any international searching authority appointed under the Patent Co-operation Treaty⁹.

Where directions as to secrecy remain in force in respect of an application after the expiry of the prescribed period¹⁰ and the application is brought in order for the grant of a patent, then:

- 79 (1) any working of the invention by or with the written authorisation of or to the order of a government department while the directions are in force is subject to the provisions applicable to Crown use of patented inventions¹¹, subject to certain modifications¹²; and
- 80 (2) if it appears to the Secretary of State¹³ that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Secretary of State, with Treasury consent, may make such payment, if any, by way of compensation to the applicant as appears to the Secretary of State and the Treasury to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it was designed and any other relevant circumstances¹⁴.

Where a patent is granted pursuant to an application in respect of which directions as to secrecy have been given, no renewal fees¹⁵ are payable in respect of any period during which the directions were in force¹⁶.

Any person who fails to comply with any directions is guilty of an offence¹⁷.

1 le directions given under the Patents Act 1977 s 22(1), (2): see PARA 335.

2 le under the Patents Act 1977: see PARA 303.

3 Patents Act 1977 s 22(3)(a). As to application procedures see PARA 315 et seq.

4 Patents Act 1977 s 22(3)(a). As to the publication of applications see PARA 327.

5 As to the meaning of 'European patent' see PARA 668 note 5. As to applications for European patents see PARA 669.

6 Patents Act 1977 s 22(3)(b). The comptroller may nevertheless send to the European Patent Office any information which the European Patent Convention requires him to send: Patents Act 1977 s 22(4). As to the European Patent Convention and the European Patent Office see PARA 668 et seq.

7 As to the meaning of 'international application for a patent' see PARA 654 note 1.

8 As to the International Bureau see PARA 654.

9 Patents Act 1977 s 22(3)(c). As to international searches under the Patent Co-operation Treaty see PARA 656.

10 Ie the period prescribed for the purposes of the Patents Act 1977 s 16: see PARA 327.

11 Ie the Patents Act 1977 ss 55-59: see PARAS 404-411.

12 Patents Act 1977 s 22(7)(a). Sections 55-59 apply as if: (1) the working were use made by virtue of s 55; (2) the application had been published within the prescribed period; and (3) a patent had been granted at the time the application was brought in order for grant on the terms of the application as it stood at that time: s 22(7)(a).

13 As to the Secretary of State see PARA 575.

14 Patents Act 1977 s 22(7)(b). As to the Treasury see **CONSTITUTIONAL LAW AND HUMAN RIGHTS** vol 8(2) (Reissue) PARAS 512-517.

15 As to renewal fees see PARA 340.

16 Patents Act 1977 s 22(8).

17 Patents Act 1977 s 22(9). A person guilty of such an offence is liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or to both, or on summary conviction to a fine not exceeding the prescribed sum: s 22(9) (amended by the Magistrates' Courts Act 1980 s 32(2)).

'Prescribed sum' means £5,000 or such sum as is for the time being substituted in this definition by order under the Magistrates' Courts Act 1980 s 143(1): see s 32(9) (amended by the Criminal Justice Act 1991 s 17(2)); and **SENTENCING AND DISPOSITION OF OFFENDERS** vol 92 (2010) PARA 141.

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337. Restrictions on making applications abroad.

If an application for a patent¹: (1) contains information which relates to military technology or for any other reason publication of the information might be prejudicial to national security; or (2) contains information the publication of which might be prejudicial to the safety of the public, then the following restrictions apply².

No person resident in the United Kingdom³ may file or cause to be filed outside the United Kingdom an application for a patent for an invention which contains such information without written authority granted by the comptroller⁴ unless:

- 81 (a) an application for a patent for the same invention has been filed in the UK Intellectual Property Office⁵ not less than six weeks before the application outside the United Kingdom⁶; and
- 82 (b) either no directions as to secrecy have been given⁷ in relation to the application in the United Kingdom or all such directions have been revoked⁸.

The above provisions do not, however, apply to an application for a patent for an invention for which an application for a patent has first been filed in a country outside the United Kingdom by a person resident outside the United Kingdom⁹.

A person who files or causes to be filed an application for the grant of a patent in contravention of these provisions is guilty of an offence¹⁰ if he knows that, or is reckless as to whether, filing the application, or causing it to be filed, would be a contravention¹¹.

1 Ie under the Patents Act 1977: see PARA 303. For these purposes, any reference to any application for a patent includes a reference to an application for other protection for an invention (s 23(4)(a)); and any reference to either kind of application is a reference to an application under the Patents Act 1977, under the law of any country other than the United Kingdom or under any treaty or international convention to which the United Kingdom is a party (s 23(4)(b)). As to treaties and conventions see PARA 652 et seq.

2 Patents Act 1977 s 23(1A) (added by the Patents Act 2004 s 7(2)).

3 As to the meaning of 'United Kingdom' see PARA 303 note 5.

4 Patents Act 1977 s 23(1) (amended by the Patents Act 2004 s 7(1)). As to the comptroller see PARA 577.

5 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 Patents Act 1977 s 23(1)(a).

7 Ie under the Patents Act 1977 s 22(1), (2): see PARA 335.

8 Patents Act 1977 s 23(1)(b). As to the revocation of directions see PARA 335.

9 Patents Act 1977 s 23(2).

10 Patents Act 1977 s 23(3). A person guilty of such an offence is liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or to both, or on summary conviction to a fine not exceeding the prescribed sum: s 23(3) (amended by the Magistrates' Courts Act 1980 s 32(2)). As to the prescribed sum see PARA 336 note 17.

- 11 Patents Act 1977 s 23(3A) (added by the Patents Act 2004 s 7(3)).

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(2) GRANT AND TERM

338. Procedure upon grant.

As soon as practicable after a patent¹ has been granted², the comptroller³ must publish in the Official Journal (Patents)⁴ a notice that the patent has been granted⁵.

The patent is treated as having been granted on, and takes effect from, the date of publication of the notice⁶. As soon as practicable after he publishes the notice, the comptroller must send the proprietor of the patent a certificate in the prescribed form⁷ that the patent has been granted to him⁸. At the same time as he publishes the notice of grant, the comptroller must publish the specification⁹ of the patent, the names of the proprietor and, if different, the inventor¹⁰, and any other matters constituting or relating to the patent which in the controller's opinion it is desirable to publish¹¹. The effect of grant is to put an end to all pre-grant procedures such as dividing out¹² and pre-grant amendment¹³.

1 Ie under the Patents Act 1977: see PARA 303.

2 As to grant see PARA 329.

3 As to the comptroller see PARA 577.

4 As to the Journal see PARA 580.

5 Patents Act 1977 s 24(1).

6 Patents Act 1977 s 25(1). The power to begin an action for infringement arises upon grant: see PARA 521.

7 The certificate of grant of a patent must be in a form which includes: (1) the name of the proprietor; (2) the date of filing of the application; and (3) the number of the patent: Patents Rules 2007, SI 2007/3291, r 34.

8 Patents Act 1977 s 24(2).

9 As to the specification see PARA 319.

10 This provision does not require the comptroller to identify as inventor a person who has waived his right to be mentioned as inventor in any patent granted for the invention (see PARA 308): Patents Act 1977 s 24(4) (added by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 9). As to the meaning of 'inventor' see PARA 301 note 3.

11 Patents Act 1977 s 24(3).

12 See *ITT Industries Inc's Application* [1984] RPC 23.

13 See *Ogawa Chemical Industries Ltd's Applications* [1986] RPC 63.

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339. Term of patents.

The term of a patent¹ is, subject to lapse for non-payment of renewal fees², 20 years beginning with the date of filing³ the application or with such other date as may be prescribed⁴. The term may, however, be shortened by revocation⁵ or surrender⁶ of the patent.

1 le under the Patents Act 1977: see PARA 303.

2 As to renewal fees see PARA 340.

3 As to the meaning of 'date of filing' see PARA 316.

4 Patents Act 1977 s 25(1). A rule prescribing any such other date may not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament: s 25(2). At the date at which this volume states the law no such rule had been made. As to the making of rules generally see PARA 576.

5 As to the revocation of patents see PARA 564 et seq.

6 As to the surrender of patents see PARA 359.

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340. Renewal fees.

There is a prescribed period for the payment of a renewal fee¹ in respect of the first renewal date² of a patent. The first renewal date is the fourth anniversary of the date of filing³, and the renewal period is three months ending with the last day of the month in which that renewal date falls⁴.

Where a patent is granted⁵ during the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary: (1) the first renewal date is the last day of the period of three months beginning with the date on which the patent was granted; and (2) the renewal period begins with the date on which the patent was granted and ends with the last day of the month in which that renewal date falls⁶.

Where the grant of a patent is mentioned in the European Patent Bulletin⁷ during the period of three months ending with the fourth anniversary of the date of filing, or at any time after that anniversary⁸:

- 83 (a) the first renewal date is the later of: (i) the last day of the period of three months beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin ('case A'); or (ii) the next anniversary of the date of filing to fall after the date on which the grant of the patent was so mentioned ('case B')⁹; and
- 84 (b) the renewal period is: (i) in case A, the period beginning with the date on which the grant of the patent was mentioned in the European Patent Bulletin and ending with the last day of the month in which the first renewal date falls; or (ii) in case B, three months ending with the last day of the month in which the first renewal date falls¹⁰.

The period for the payment of a renewal fee in respect of renewal dates subsequent to the first renewal date is three months ending with the last day of the month in which the renewal date falls¹¹. The second renewal date is the next anniversary of the date of filing to fall after the first renewal date; and each subsequent renewal date is the anniversary of the previous renewal date¹².

If the renewal fee is not paid before the end of the renewal period, the patent ceases to have effect at the end of the renewal date¹³. The prescribed form must be filed before the end of the renewal period¹⁴. On receipt of the renewal fee the comptroller¹⁵ must issue a certificate of payment¹⁶.

If, however, during the period ending with the sixth month after the month in which the prescribed period ends the renewal fee and any prescribed additional fee¹⁷ are paid, the patent is treated as if it had never expired¹⁸. Accordingly:

- 85 (A) anything done under or in relation to the patent during that further period is valid¹⁹;
- 86 (B) an act which would constitute an infringement of the patent if it had not expired constitutes such an infringement²⁰; and
- 87 (C) an act which would constitute the use of the patented invention²¹ for the services of the Crown²² if the patent had not expired constitutes such use²³.

Where the prescribed period for payment of a renewal fee has expired, the comptroller must send to the proprietor of the patent, not later than six weeks after the last date for payment and if the fee remains unpaid, a renewal notice reminding him that payment is overdue and of the consequences of non-payment²⁴.

No renewal fees are payable in respect of any period during which directions as to secrecy are in force in respect of a patent²⁵. Renewal fees in respect of patents which are subject to licences of right²⁶ are half those otherwise payable²⁷. Where a patent has lapsed through failure to pay any renewal fee, an application for restoration may be made²⁸.

1 'Renewal fee' means the fee prescribed in respect of a renewal date: Patents Rules 2007, SI 2007/3291, r 36(1). As to renewal fees see the Patents (Fees) Rules 2007, SI 2007/3292, r 4(1), Sch 2 Pt 1; and as to fees generally see PARA 583.

2 'Renewal date' has the meaning given in the Patents Rules 2007, SI 2007/3291, r 37(2)-(4) (see the text and notes 3-10) or r 38 (see the text and notes 11-12): r 36(1).

3 Patents Rules 2007, SI 2007/3291, r 37(2)(a). As to the meaning of 'date of filing' see PARA 316.

4 Patents Rules 2007, SI 2007/3291, rr 36(1), 37(2)(b). The prescribed time limit may not be extended: see PARA 599.

5 le under the Patents Act 1977: see PARA 303.

6 Patents Rules 2007, SI 2007/3291, r 37(3). The fee to be paid to keep a patent in force after the first renewal date is the sum of the following amounts: (1) the amount specified in relation to the relevant anniversary; and (2) the amounts specified in relation to all previous anniversaries: Patents (Fees) Rules 2007, SI 2007/3292, r 4(2). The relevant anniversary is the last anniversary to fall on or before the first renewal date: r 4(4).

7 See PARA 675 note 3.

8 Patents Rules 2007, SI 2007/3291, r 37(4). The fee to be paid to keep a patent in force after the first renewal date is the amount specified in relation to the relevant anniversary: Patents (Fees) Rules 2007, SI 2007/3292, r 4(3). As to the relevant anniversary see note 6.

9 Patents Rules 2007, SI 2007/3291, r 37(4)(a).

10 Patents Rules 2007, SI 2007/3291, r 37(4)(b).

11 Patents Rules 2007, SI 2007/3291, r 38(1), (2). The prescribed time limit may not be extended: see PARA 599.

12 Patents Rules 2007, SI 2007/3291, r 38(3).

13 Patents Act 1977 s 25(3) (substituted by the Patents Act 2004 s 8(1)); Patents Rules 2007, SI 2007/3291, r 36(2).

14 Patents Form 12 must be filed before the end of the renewal period: Patents Rules 2007, SI 2007/3291, r 36(3). However, where payment is made under the Patents Act 1977 s 25(4) (see the text and notes 18-23) or s 28(3) (see PARA 356), Patents Form 12 must accompany the renewal fee and the prescribed additional fee: Patents Rules 2007, SI 2007/3291, r 36(4).

15 As to the comptroller see PARA 577.

16 Patents Rules 2007, SI 2007/3291, r 36(5).

17 For additional fees see the Patents (Fees) Rules 2007, SI 2007/3292, r 5, Sch 2.

18 Patents Act 1977 s 25(4) (amended by the Patents Act 2004 s 8(2)).

19 Patents Act 1977 s 25(4)(a).

20 Patents Act 1977 s 25(4)(b). As to acts which constitute infringement see PARA 500 et seq.

- 21 As to the meaning of 'patented invention' see PARA 371 note 27.
- 22 As to the meaning of 'services of the Crown' see PARA 405 note 3.
- 23 Patents Act 1977 s 25(4)(c). As to Crown use see PARA 404 et seq.
- 24 Patents Act 1977 s 25(5); Patents Rules 2007, SI 2007/3291, r 39(1), (2), (4). The comptroller must send the renewal notice to the address specified by the proprietor on payment of the last renewal fee, or to another address that has since been notified to the comptroller for that purpose by the proprietor or, where such an address has not been so specified or notified, the address for service entered in the register: r 39(3).
- 25 See the Patents Act 1977 s 22(8); and PARA 336.
- 26 As to licences of right see PARA 392.
- 27 See the Patents Act 1977 s 46(3)(d); and PARA 392.
- 28 See the Patents Act 1977 s 28; and PARA 355.

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(3) SUPPLEMENTARY PROTECTION CERTIFICATES

341. Supplementary protection for medicinal products.

Any product¹ protected by a patent in the territory of a member state and subject, prior to being placed on the market as a medicinal product, to an administrative authorisation procedure² may be³ the subject of a supplementary protection certificate⁴.

A certificate must be granted if, in the member state in which the application for a supplementary protection certificate is submitted and at the date of that application:

- 88 (1) the product is protected by a basic patent⁵ in force;
- 89 (2) a valid authorisation to place the product on the market as a medicinal product has been granted⁶;
- 90 (3) the product has not already been the subject of a supplementary protection certificate;
- 91 (4) the authorisation referred to in head (2) above is the first authorisation to place the product on the market as a medicinal product⁷.

Within the limits of the protection conferred by the basic patent, the protection conferred by a supplementary protection certificate extends only to the product covered by the authorisation to place the corresponding medicinal product on the market and for any use of the product as a medicinal product that has been authorised before the expiry of the certificate⁸. Subject thereto, the certificate confers the same rights as conferred by the basic patent and is subject to the same limitations and the same obligations⁹.

The certificate must be granted to the holder of the basic patent or his successors in title¹⁰.

Certain provisions of the Patents Act 1977 are applied with modifications to supplementary protection certificates¹¹.

1 For these purposes, 'product' means the active ingredient or combination of active ingredients of a medicinal product; and 'medicinal product' means any substance or combination of substances presented for treating or preventing disease in human beings or animals and any substance or combination of substances which may be administered to human beings or animals with a view to making a medical diagnosis or to restoring, correcting or modifying physiological functions in humans or in animals: EC Council Regulation 1768/92 concerning the creation of a supplementary protection certificate for medicinal products (OJ L182, 2.7.92, p 1) art 1(a), (b). An excipient which allows a slow-release form of a drug is not an active ingredient: C-431/04 *Re Massachusetts Institute of Technology* [2006] RPC 872, [2007] IP & T 44, [2006] All ER (D) 60 (May), ECJ. Products differing only in their impurity levels are different 'products' for the purposes of a supplementary protection certificate: C-258/99 *BASF AG v Bureau voor de Industriële Eigendom (BIE)* [2001] ECR I-3643, [2002] RPC 9, [2001] All ER (D) 138 (May).

2 I.e. as laid down in EC Council Directive 65/65 on the approximation of provisions laid down by law, regulation or administrative action relating to proprietary medicinal products (OJ L22, 9.12.65, p 369) or EC Council Directive 81/851 on the approximation of the laws of the member states relating to veterinary medicinal products (OJ L317, 6.11.81, p 1). Where the submission of samples of a medicinal product to the competent authority with a view to obtaining a marketing authorisation gives rise to a patent infringement, Community law does not preclude a prohibition on obtaining authorisation beyond the maximum period authorised by EC Council Directive 65/65 (OJ L22, 9.12.65, p 369) where that period corresponds to the actual average duration of obtaining such authorisation in the member state concerned: Case C-316/95 *Generics BV v Smith Kline & French Laboratories Ltd* [1997] RPC 801, 41 BMLR 116, ECJ.

3 lie under the terms and conditions provided for in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1).

4 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) arts 1(d), 2. The supplementary protection scheme under the Regulation is not for the general protection of the fruits of research; the scheme compensates for the lost time in the exploitation of patented inventions: *Re Aktiebolaget Draco* [1996] RPC 417, 32 BMLR 37.

5 For these purposes, 'basic patent' means a patent which protects a product as such, a process to obtain a product or an application of a product, and which is designated by its holder for the purpose of the procedure for grant of a supplementary protection certificate: EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 1(c), (d). To determine whether a product is protected by a basic patent, reference must be made to the national law governing the patent: *C-392/97 Re Farmitalia Carlo Erba Srl* [1999] ECR I-5553, [2000] 2 CMLR 253, [2000] RPC 580, ECJ; *Takeda Chemical Industries Ltd's SPC Applications* [2004] RPC 1. Where a medicinal product is covered by several basic patents, EC Council Regulation 1768/92 does not preclude the grant of a supplementary protection certificate to each holder of a basic patent, but only one supplementary protection certificate can be granted for each basic patent: *Case C-181/95 Biogen v Smithkline Beecham Biologicals SA* [1997] RPC 833, ECJ.

6 lie in accordance with EC Council Directive 65/65 (OJ L22, 9.12.65, p 369) or EC Council Directive 81/851 (OJ L317, 6.11.81, p 1), as appropriate.

7 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) arts 1(d), 3. See *Chiron Corp'n's and Novo Nordisk A/S's Supplementary Protection Certificate Application* [2005] RPC 587 (the grant of a supplementary protection certificate for a product to one holder of a basic patent before an application is lodged in relation to the same product by a different holder of a different basic patent on the basis of a common marketing authorisation does not provide a ground for rejecting the later application under EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 3). *Case C-31/03 Pharmacia Italia SpA v Deutsches Patentamt* [2005] RPC 640, ECJ (authorisation as a veterinary product was held by the ECJ to be the first market authorisation for a supplementary protection certificate application made on the basis of a medicinal product for human use). See also *Takeda Chemical Industries Supplementary Protection Certificate Application (No 2)* [2004] RPC 20.

8 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 4. A supplementary protection certificate is capable of covering a medicinal product in any of its derived forms enjoying the protection of the basic patent: *Case C-392/97 Re Farmitalia Carlo Erba Srl's Supplementary Protection Certificate Application* [1999] ECR I-5553, [2000] 2 CMLR 253, [2000] RPC 580, ECJ.

9 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 5. See *Research Corp's Supplementary Protection Certificate* [1994] RPC 667.

10 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 6.

11 See the Patents Act 1977 s 128B(1), Sch 4A paras 1, 2, 3, 4 (s 128B, Sch 4A added by SI 2007/3293).

UPDATE

341-345 Supplementary protection certificates

Regulation 1768/92 replaced: European Parliament and EC Council Regulation 469/2009 (OJ L152, 16.6.2009, p 1).

341 Supplementary protection for medicinal products

NOTE 1--See *Medeva BV v Comptroller General of Patents* [2010] EWHC 68 (Pat), (2010) 112 BMLR 126 (separate antigens in combined vaccine could not be protected under supplementary protection certificate where relevant medicinal product was entire vaccine).

NOTE 7--See also *Neurim Pharmaceuticals (1991) Ltd v Comptroller-General of Patents* [2010] EWHC 976 (Pat), [2010] All ER (D) 37 (May).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/2. GRANT AND DURATION OF PATENT/(3) SUPPLEMENTARY PROTECTION CERTIFICATES/342. Application for supplementary protection certificate.

342. Application for supplementary protection certificate.

The application for a supplementary protection certificate must be made in the prescribed form¹ and filed at the UK Intellectual Property Office² accompanied by the prescribed fee³ within six months of the date on which the authorisation⁴ to place the product⁵ on the market as a medicinal product⁶ was granted⁷. Where, however, that authorisation is granted before the basic patent⁸ is granted, the application for a certificate must be lodged within six months of the date on which the patent is granted⁹. The application for an extension of the duration¹⁰ may be made when lodging the application for a certificate or when the application for the certificate is pending and the appropriate requirements¹¹ are fulfilled¹². The application for an extension of the duration of a certificate already granted must be lodged not later than two years before the expiry of the certificate¹³.

The application for a certificate must contain:

- 92 (1) a request for the grant of a certificate, stating in particular:
5
 6. (a) the name and address of the applicant;
 7. (b) if he has appointed a representative, the name and address of the representative;
 8. (c) the number of the basic patent and the title of the invention;
 9. (d) the number and date of the first authorisation to place the product on the market¹⁴ and, if this authorisation is not the first authorisation for placing the product on the market in the European Union, the number and date of that authorisation;
- 6
- 93 (2) a copy of the authorisation to place the product on the market, in which the product is identified, containing in particular the number and date of the authorisation and the summary of the product characteristics¹⁵;
- 94 (3) if the authorisation referred to in head (2) above is not the first authorisation for placing the product on the market as a medicinal product in the European Union, information regarding the identity of the product thus authorised and the legal provision under which the authorisation procedure took place, together with a copy of the notice publishing the authorisation in the appropriate official publication¹⁶.

The application for a certificate must be lodged with the competent industrial property office of the member state which granted the basic patent or on whose behalf it was granted and in which the authorisation¹⁷ to place the product on the market was obtained, unless the member state designates another authority for the purpose¹⁸. Notification of the application for a certificate must be published by the appropriate authority¹⁹; and the notification must contain at least the following information:

- 95 (i) the name and address of the applicant;
- 96 (ii) the number of the basic patent;
- 97 (iii) the title of the invention;
- 98 (iv) the number and date of the authorisation to place the product on the market²⁰ and the product identified in that authorisation;

- 99 (v) where relevant, the number and date of the first authorisation to place the product on the market in the European Union²¹.

1 An application for a supplementary protection certificate must be made on Patents Form SP1: Patents Rules 2007, SI 2007/3291, r 116(1)(a).

2 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579. See further text and note 13.

3 Member states may provide that a fee is to be payable upon application for a certificate: EC Council Regulation 1768/92 concerning the creation of a supplementary protection certificate for medicinal products (OJ L182, 2.7.92, p 1) art 8(2).

A supplementary protection certificate does not take effect unless: (1) the prescribed fee is paid before the end of the prescribed period; or (2) the prescribed fee and any prescribed additional fee are paid before the end of the period of six months beginning immediately after the prescribed period: Patents Act 1977 s 128B(1), Sch 4A para 5 (s 12B, Sch 4A added by SI 2007/3293). The prescribed period is: (a) three months ending with the start date; or (b) where the certificate is granted after the beginning of that period, three months beginning with the date the supplementary protection certificate is granted: Patents Rules 2007, SI 2007/3291, r 116(2). The prescribed time limit may not be extended: see PARA 599.

The prescribed fee payable for a supplementary protection certificate to take effect is set in accordance with the following: Patents (Fees) Rules 2007, SI 2007/3292, r 6(1). Where the certificate expires during the period of one year beginning with: (i) the start date, the fee is £600; (ii) the first anniversary of the start date, the fee is £1,300; (iii) the second anniversary of the start date, the fee is £2,100; (iv) the third anniversary of the start date, the fee is £3,000; or (v) the fourth anniversary of the start date, the fee is £4,000: r 6(2). The additional fee prescribed for the purposes of head (2) above is half the prescribed fee: r 6(4). 'Start date' is the first day following the day on which the basic patent expires: r 6(5). As to the meaning of 'basic patent' see PARA 341 note 5. The period in r 6(2) must be calculated without reference to any extension of the duration of a supplementary protection certificate under EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 13(3) (see PARA 345): Patents (Fees) Rules 2007, SI 2007/3292, r 6(3).

4 I.e. the authorisation referred to in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 3(b): see PARA 341 head (2).

5 As to the meaning of 'product' see PARA 341 note 1.

6 As to the meaning of 'medicinal product' see PARA 341 note 1.

7 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) arts 1(d), 7(1); Patents Act 1977 ss 14(1), 128B, Sch 4A para 1(1), (2) (as added: see note 3).

8 As to the meaning of 'basic patent' see PARA 341 note 5.

9 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 7(2).

10 'Application for an extension of the duration' means an application for an extension of the duration of the certificate pursuant to EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 13(3) and of EC Regulation 1901/2006 of the European Parliament and of the Council on medicinal products for paediatric use (OJ L378, 27.12.2006, p 1) art 36: EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 1(e).

11 I.e. of EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 8(1)(d) or 8(1a): see the text and note 16.

12 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 7(3).

13 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 7(4). Notwithstanding art 7(4), for five years following the entry into force of EC Regulation 1901/2006 (OJ L378, 27.12.2006, p 1) (ie 25 February 2007: see art 57) the application for an extension of the duration of a certificate already granted must be lodged not later than six months before the expiry of the certificate: EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 7(5).

14 See note 3.

15 I.e. listed in EC Council Directive 65/65 on the approximation of provisions laid down by law, regulation or administrative action relating to proprietary medicinal products (OJ L22, 9.12.65, p 369) art 4a or EC Council Directive 81/851 on the approximation of the laws of the member states relating to veterinary medicinal products (OJ L317, 6.11.81, p 1) art 5a.

16 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 8(1)(a)-(c). Where the application for a certificate includes a request for an extension of the duration, the application must contain: (1) a copy of the statement indicating compliance with an agreed completed paediatric investigation plan as referred to in EC Regulation 1901/2006 (OJ L378, 27.12.2006, p 1) art 36(1); (2) where necessary, in addition to the copy of the authorisations to place the product on the market as referred to in head (2) in the text, proof that it has authorisations to place the product on the market of all other member states, as referred to in EC Regulation 1901/2006 (OJ L378, 27.12.2006, p 1) art 36(3); EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 8(1)(d). Where an application for a certificate is pending, an application for an extended duration in accordance with art 7(3) (see the text to note 12) must include the particulars referred to in art 8(1)(d) and a reference to the application for a certificate already filed: art 8(1a). The application for an extension of the duration of a certificate already granted must contain the particulars referred to in art 8(1)(d) and a copy of the certificate already granted: art 8(1b). An application for an extension of the duration of a supplementary protection certificate under art 8 must be made on Patents Form SP4: Patents Rules 2007, SI 2007/3291, r 116(1)(b). As to the fee payable see the Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1.

17 See note 3.

18 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 9(1). The competent industrial property office for the purposes of lodging an application for a supplementary protection certificate in the United Kingdom is the UK Intellectual Property Office: see the Patents Act 1977 s 14(1)(a), Sch 4A para 1(2) (as added: see note 3). As to the meaning of 'United Kingdom' see PARA 303 note 5.

19 Is the authority referred to in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 9(1): see the text and note 18.

20 See note 3.

21 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 9(2). The comptroller (see PARA 577) must send a notice to the applicant for the certificate: (1) before the beginning of the period of two months immediately preceding the start date; or (2) where the certificate is granted as mentioned in the Patents Rules 2007, SI 2007/3291, r 116(2)(b) (see note 3 head (b)), on the date the certificate is granted: r 116(3). The notice must notify the applicant for the certificate of: (a) the fact that payment is required for the certificate to take effect; (b) the prescribed fee due; (c) the date before which payment must be made; and (d) the start date: r 116(4). The prescribed fee must be accompanied by Patents Form SP2; and once the certificate has taken effect no further fee may be paid to extend the term of the certificate unless an application for an extension of the duration of the certificate is made under EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1): Patents Rules 2007, SI 2007/3291, r 16(5). Where the prescribed fee is not paid before the end of the period prescribed for the purposes of the Patents Act 1977 Sch 4A para 5 (see note 3), the comptroller, before the end of the period of six weeks beginning immediately after the end of that prescribed period, and if the fee remains unpaid, must send a notice to the applicant for the certificate: Patents Rules 2007, SI 2007/3291, r 16(6). The notice must remind the applicant for the certificate that payment is overdue and of the consequences of non-payment: r 16(7). The comptroller must send the notices under this rule to the applicant's address for service, and the address to which a renewal notice would be sent to the proprietor of the basic patent under r 39(3) (see PARA 340): r 116(8). As to the comptroller see PARA 577.

UPDATE

341-345 Supplementary protection certificates

Regulation 1768/92 replaced: European Parliament and EC Council Regulation 469/2009 (OJ L152, 16.6.2009, p 1).

342 Application for supplementary protection certificate

NOTE 16--As to the rectification of deficiencies after the date of the application see *El du Pont Nemours & Co v United Kingdom Intellectual Property Office* [2009] EWCA Civ 966, (2009) 111 BMLR 15; and PARA 343.

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343. Grant of supplementary protection certificate or rejection of application.

Where the application for a supplementary protection certificate and the product¹ to which it relates meets the prescribed conditions², the relevant authority³ must grant the certificate⁴; but that authority must⁵ reject the application for a certificate if the application or the product to which it relates does not meet the prescribed conditions⁶. Where the application for a certificate does not meet the conditions relating to the content of such an application⁷, the relevant authority must ask the applicant to rectify the irregularity, or to settle the fee, within a stated time⁸. If the irregularity is not so rectified or the fee is not so settled within the stated time, the relevant authority must reject the application⁹.

Member states may provide that the authority is to grant certificates without verifying that certain of the conditions¹⁰ for obtaining a certificate are met¹¹.

Notification of the fact that a certificate has been granted must be published by the relevant authority; and the notification must contain at least the following information:

- 100 (1) the name and address of the holder of the certificate;
- 101 (2) the number of the basic patent¹²;
- 102 (3) the title of the invention;
- 103 (4) the number and date of the authorisation to place the product on the market¹³ and the product identified in that authorisation;
- 104 (5) where relevant, the number and date of the first authorisation to place the product on the market in the European Community;
- 105 (6) the duration of the certificate¹⁴.

Notification of the fact that the application for a certificate has been rejected must be published by the relevant authority; and the notification must contain at least the like information¹⁵ as on the notification of the application for a certificate¹⁶.

Member states may require that the certificate be subject to the payment of annual fees¹⁷.

1 As to the meaning of 'product' see PARA 341 note 1.

2 Ie the conditions laid down in EC Council Regulation 1768/92 concerning the creation of a supplementary protection certificate for medicinal products (OJ L182, 2.7.92, p 1) art 10.

3 Ie the authority referred to in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 9(1): see PARA 342.

4 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 10(1).

5 Ie subject to EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 10(3): see the text and notes 7-8.

6 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 10(2).

7 Ie the conditions laid down in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 8: see PARA 342.

8 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 10(3).

9 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 10(4).

- 10 le the conditions laid down in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 3(c), (d): see PARA 341 heads (3), (4).
- 11 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 10(5).
- 12 As to the meaning of 'basic patent' see PARA 341 note 5.
- 13 le the authorisation referred to in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 3(b): see PARA 341 head (2).
- 14 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 11(1).
- 15 le the information listed in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 9(2): see PARA 342.
- 16 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 11(2).
- 17 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 12. As to fees see the Patents (Fees) Rules 2007, SI 2007/3292, rr, 2, 6, Sch 1.

UPDATE

341-345 Supplementary protection certificates

Regulation 1768/92 replaced: European Parliament and EC Council Regulation 469/2009 (OJ L152, 16.6.2009, p 1).

343 Grant of supplementary protection certificate or rejection of application

NOTE 8--The concept of 'irregularity' in art 10(3) must be given a wide interpretation and can encompass cases where a defect is cured after the date of the application: *E/ du Pont Nemours & Co v United Kingdom Intellectual Property Office* [2009] EWCA Civ 966, (2009) 111 BMLR 15.

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344. Validity of supplementary protection certificate.

The supplementary protection certificate is invalid if:

- 106 (1) it was granted contrary to the conditions for obtaining a certificate¹;
- 107 (2) the basic patent² has lapsed before its lawful term expires³;
- 108 (3) the basic patent is revoked or limited to the extent that the product⁴ for which the certificate was granted would no longer be protected by the claims of the basic patent or, after the basic patent has expired, grounds for revocation exist which would have justified such revocation or limitation⁵.

Any person may submit an application or bring an action for a declaration of invalidity of the certificate before the body responsible under national law for the revocation of the corresponding basic patent⁶.

If the certificate is so invalid, notification thereof must be published by the relevant authority⁷. The decisions of the relevant authority or of the national body are open to the same appeals as those provided for in national law against similar decisions taken in respect of national patents⁸. The procedural provisions applicable under national law to the corresponding basic patent apply to the certificate unless that law lays down special procedural provisions for certificates⁹.

1 le contrary to the provisions of EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 3: see PARA 341.

2 As to the meaning of 'basic patent' see PARA 341 note 5.

3 As to the term of a supplementary protection certificate see PARA 345.

4 As to the meaning of 'product' see PARA 341 note 1.

5 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 15(1).

6 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 15(2). The revocation of an extension of the duration may also be revoked: see art 15a.

7 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 16. As to the relevant authority see PARA 342 text to notes 17-18.

8 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 17.

9 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 18.

UPDATE

341-345 Supplementary protection certificates

Regulation 1768/92 replaced: European Parliament and EC Council Regulation 469/2009 (OJ L152, 16.6.2009, p 1).

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345. Term of supplementary protection certificate.

The supplementary protection certificate takes effect at the end of the lawful term of the basic patent¹ for a period equal to the period which elapsed between the date on which the application for a basic patent was lodged and the date of the first authorisation to place the product on the market in the European Union reduced by a period of five years². The duration of the certificate may not, however, exceed five years from the date on which it takes effect³.

The certificate lapses:

- 109 (1) at the end of the specified period⁴;
- 110 (2) if the certificate-holder surrenders it;
- 111 (3) if the annual fee⁵ is not paid in time;
- 112 (4) if and so long as the product⁶ covered by the certificate may no longer be placed on the market following the withdrawal of the appropriate authorisation or authorisations⁷ to place on the market⁸.

If the certificate lapses in accordance with head (2), (3) or (4) above, notification thereof must be published by the relevant authority⁹.

1 As to the meaning of 'basic patent' see PARA 341 note 5.

2 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 13(1). The periods under art 13(1), (2) may be extended by six months where EC Regulation 1901/2006 of the European Parliament and of the Council on medicinal products for paediatric use (OJ L378, 27.12.2006, p 1) applies: EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 13(3).

3 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 13(2). See note 2.

4 I.e. the period provided for in EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 13: see the text and notes 1-3.

5 I.e. the annual fee laid down in accordance with EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 12: see PARA 343.

6 As to the meaning of 'product' see PARA 341 note 1.

7 I.e. in accordance with EC Council Directive 65/65 on the approximation of provisions laid down by law, regulation or administrative action relating to proprietary medicinal products (OJ L22, 9.12.65, p 369) or EC Council Directive 81/851 on the approximation of the laws of the member states relating to veterinary medicinal products (OJ L317, 6.11.81, p 1).

8 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 14.

9 EC Council Regulation 1768/92 (OJ L182, 2.7.92, p 1) art 16(1).

UPDATE

341-345 Supplementary protection certificates

Regulation 1768/92 replaced: European Parliament and EC Council Regulation 469/2009 (OJ L152, 16.6.2009, p 1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/3. POST-GRANT AMENDMENT, RESTORATION AND SURRENDER/(1) AMENDMENT/346. In general.

3. POST-GRANT AMENDMENT, RESTORATION AND SURRENDER

(1) AMENDMENT

346. In general.

A patent¹ or an application² for a patent, as the case may be, may be amended at any time between the date of filing³ of the application and the expiry of the patent⁴. Once a patent has been granted⁵, the specification⁶ may only be amended, with leave, either on formal application to the comptroller⁷ or in proceedings before the court⁸ or the comptroller in which the validity of the patent may be put in issue⁹. Any amendment allowed is subject to certain statutory restrictions¹⁰ and to the right of members of the public to oppose¹¹.

The comptroller may, without any application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade mark¹².

1 I.e. a patent under the Patents Act 1977: see PARA 303.

2 As to the application see PARA 315.

3 As to the meaning of 'date of filing' see PARA 316.

4 As to the term of a patent see PARA 339; and as to the amendment of applications before grant see PARA 330.

5 As to grant see PARA 338.

6 As to the specification see PARA 319.

7 I.e. under the Patents Act 1977 s 27(1): see PARA 347. As to the comptroller see PARA 577.

8 As to the meaning of 'court' see PARA 637 note 1.

9 I.e. under the Patents Act 1977 s 75(1): see PARA 347. As to proceedings in which the validity of a patent may be put in issue see s 74; and PARA 520.

10 As to these restrictions see PARA 352.

11 See the Patents Act 1977 ss 27(5), 75(2); and PARA 372. See note 12.

12 Patents Act 1977 s 27(4). For these purposes, the reference to a registered trade mark is to be construed as a reference to a registered trade mark within the meaning of the Trade Marks Act 1994 (see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 127): s 106(1), Sch 4 para 1(1), (2). In considering whether or not to allow an application or amendment under the Patents Act 1977 ss 27, 75, the comptroller must have regard to any relevant principles applicable under the European Patent Convention (see PARA 668 et seq): ss 27(6), 75(5) (added by Patents Act 2004 s 2(1), (5)).

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347. Applications for leave to amend.

Where there are no proceedings pending¹ before the court² or the comptroller³ in which the validity of the patent may be put in issue⁴, the comptroller, on application made by the proprietor of the patent⁵, may allow the specification⁶ of the patent to be amended, subject to such conditions, if any, as he thinks fit⁷. There is no power to entertain such an application made while any such proceedings are pending⁸, and an amendment allowed upon such an application would be invalid⁹.

In any proceedings before the court or the comptroller in which the validity of a patent may be put in issue the court or the comptroller, as the case may be, may allow the proprietor of the patent to amend the specification in such manner, and subject to such terms as to advertising¹⁰ the proposed amendment and as to costs, expenses or otherwise as the court or the comptroller thinks fit¹¹.

If, in any proceedings before the court or the comptroller for the revocation of the patent¹² the court or the comptroller determines that the patent is invalidated only to a limited extent, the court or the comptroller may allow the specification to be amended instead of revoking the patent¹³.

Any amendment allowed under these provisions is subject to certain statutory restrictions¹⁴.

1 Proceedings cease to be pending when: (1) the Court of Appeal makes a final order, even though an appeal to the House of Lords remains unheard (*Cropper v Smith (No 2)* (1884) 28 ChD 148, 1 RPC 254); (2) the Court of Appeal delivers judgment, but no final order is drawn up pending an application to the UK Intellectual Property Office for leave to amend (*Deshaw Reclamation Process Ltd's Application* (1952) 69 RPC 214); or (3) the parties have settled all differences, even though no order has been made disposing of the proceedings (*Lever Bros and Unilever Ltd's Patent* (1955) 72 RPC 198, CA); and, generally, when there is no question outstanding upon which the court is required to exercise any jurisdiction (*Lever Bros and Unilever Ltd's Patent* at 205). Proceedings are still pending, however, where the parties have settled all differences and the defendants have agreed to submit to an injunction because, irrespective of consent, the court still has to decide whether or not to grant an injunction (*Critchley Bros Ltd v Engelmann and Buckham Ltd* [1971] RPC 346); likewise proceedings are still pending where a Tomlin Order has not yet been made by the court (*Congoleum Industries Inc v Armstrong Cork Co Ltd* [1977] RPC 77). In such cases the court will allow amendment only where: (a) the amendments are not substantial in amount or in effect; (b) there is no apparent matter of controversy; and (c) no matter of public interest arises: *Imperial Chemical Industries plc v Ram Bathrooms plc and Rohm GmbH* [1994] FSR 181.

The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 As to the meaning of 'court' see PARA 637 note 1.

3 As to the comptroller see PARA 577.

4 As to such proceedings see the Patents Act 1977 s 74 (see PARA 520); and as to the validity of patents see PARA 430 et seq.

5 As to the application see PARA 348.

6 As to the specification see PARA 319.

7 Patents Act 1977 s 27(1), (2). In considering whether or not to allow an application under s 27, the comptroller must have regard to any relevant principles applicable under the European Patent Convention (see PARA 668 et seq): Patents Act 1977 s 27(6) (added by Patents Act 2004 s 2(1)).

8 Patents Act 1977 s 27(2).

9 No such limitation applies to the correction of clerical errors by the comptroller: see PARA 354.

10 As to advertisements see PARAS 348-349.

11 Patents Act 1977 s 75(1) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 19). As to the procedure on application to the court see PARA 349. In considering whether or not to allow an amendment proposed under the Patents Act 1977 s 75, the court or the comptroller must have regard to any relevant principles applicable under the European Patent Convention (see PARA 668 et seq): Patents Act 1977 s 75(5) (added by the Patents Act 2004 s 2(5)).

12 Ie under the Patents Act 1977 s 72: see PARAS 564-565.

13 Patents Act 1977 s 72(4) (amended by the Patents Act 2004 ss 4, 16(2), Sch 3). The patent will be revoked unless the specification is amended under the Patents Act 1977 s 75 within a specified time to the satisfaction of the court or the comptroller, as the case may be: s 72(4). See eg *Hallen Co v Brabantia (UK) Ltd* [1990] FSR 134, [1989] RPC 307. The reference in the Patents Act 1977 s 72(4) to the specification being amended is to its being amended under s 75 and also, in the case of a European patent (UK), to its being amended under any provision of the European Patent Convention (see PARA 668 et seq) under which the claims of the patent may be limited by amendment at the request of the proprietor: Patents Act 1977 s 72(4A) (added by the Patents Act 2004 s 4). As to the meaning of 'European patent (UK)' see PARA 675 note 1.

14 See the Patents Act 1977 s 76(2), (3); and PARA 352.

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348. Procedure on application to the comptroller.

An application by the proprietor of a patent¹ to the comptroller² for leave to amend the specification³ of a patent must be made in writing, identify the proposed amendment and state the reason for making the amendment⁴. The application must, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications⁵. The comptroller may, if he thinks fit, direct the proprietor to file a copy of the specification with the amendment applied for marked on it⁶. Where the specification of a European patent (UK)⁷ was published in a language other than English, the proprietor must file a translation into English of the part of the specification which he is applying to amend and a translation of the amendment⁸. The comptroller may, if he thinks fit, direct the proprietor to file a translation into English of the specification as published⁹.

Where the court¹⁰ or the comptroller allows the proprietor of a patent to amend the specification of the patent, the comptroller may direct him to file an amended specification which complies with the formal requirements¹¹.

A person may give notice to the comptroller of his opposition to an application to amend a specification by the proprietor of a patent, and if he does so the comptroller must notify the proprietor and consider the opposition in deciding whether to grant the application¹².

Where in any proceedings before the comptroller the validity of a patent is put in issue¹³ and the proprietor of the patent applies to the comptroller for leave to amend the specification¹⁴, any person may give notice of opposition to the proposed amendment, and if he does so the court or the comptroller must notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed¹⁵.

Where an application for amendment, whether made for that purpose or in the course of other proceedings before the comptroller, is not opposed, but the comptroller is not disposed to allow the amendment, the applicant may ask to be heard before the application is refused¹⁶.

Any amendment allowed is subject to certain statutory restrictions¹⁷.

An appeal lies to the Patents Court from any decision of the comptroller under these provisions¹⁸.

1 le under the Patents Act 1977: see PARA 303.

2 le under the Patents Act 1977 s 27(1): see PARA 347. As to the comptroller see PARA 577. As to proceedings before the comptroller see PARAS 600-608.

3 As to the specification see PARA 319.

4 Patents Rules 2007, SI 2007/3291, r 35(1).

5 Patents Rules 2007, SI 2007/3291, r 35(2).

6 Patents Rules 2007, SI 2007/3291, r 35(3).

7 As to the meaning of 'European patent (UK)' see PARA 675 note 1.

8 Patents Rules 2007, SI 2007/3291, r 35(4).

9 Patents Rules 2007, SI 2007/3291, r 35(5).

- 10 As to the meaning of 'court' see PARA 637 note 1.
- 11 Patents Rules 2007, SI 2007/3291, r 35(6). The amended specification must comply with the requirements of r 14, Sch 2 (see PARA 320): r 35(6).
- 12 Patents Act 1977 s 27(5).
- 13 As to such proceedings see PARA 520.
- 14 le under the Patents Act 1977 s 75(1): see PARA 347.
- 15 Patents Act 1977 s 75(2).
- 16 See the Patents Act 1977 s 101; and PARA 593.
- 17 See the Patents Act 1977 s 76(3); and PARA 352. As to the effect of an amendment see PARA 350.
- 18 Patents Act 1977 s 97(1). As to appeals generally see PARAS 639-642. A patents county court has no jurisdiction to hear appeals from the comptroller: see PARA 644 note 2.

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349. Procedure on application to the court.

An application for permission to amend the specification of a patent¹ by the proprietor of the patent must be made by application notice². The application notice must give particulars of the proposed amendment sought and the grounds upon which the amendment is sought³. The application notice must state whether the applicant will contend that the claims prior to amendment are valid and it must be served by the applicant on all parties and the comptroller⁴ within seven days of its issue⁵. The application notice must, if it is reasonably possible, be served on the comptroller electronically⁶.

Unless the court⁷ otherwise orders, the comptroller will forthwith advertise the application to amend in the Official Journal (Patents)⁸. The advertisement will state that any person may apply to the comptroller for a copy of the application notice⁹. Within 14 days of the first appearance of the advertisement any person who wishes to oppose the application must file and serve on all parties and the comptroller a notice opposing the application which must include the grounds relied on¹⁰. Within 28 days of the first appearance of the advertisement the applicant must apply to the court for directions¹¹.

Unless the court otherwise orders, the applicant must within seven days serve on the comptroller any order of the court on the application¹².

1 le under the Patents Act 1977 s 75 (see PARA 347).

2 CPR 63.10(1). As to application notices see **CIVIL PROCEDURE** vol 11 (2009) PARA 306. Where an application for an order under the Patents Act 1977 s 75 (see PARA 347) is made to the court, the applicant must notify the comptroller, who is entitled to appear and be heard and must appear if so directed by the court: s 75(4).

3 CPR 63.10(2)(a).

4 As to the comptroller see PARA 577.

5 CPR 63.10(2)(b), (c). See *Nikken Kosakusho Works v Pioneer Trading Co* [2005] EWCA Civ 906, [2006] FSR 41, [2005] All ER (D) 350 (Jun); *Zipher Ltd v Markem Systems Ltd* [2007] EWHC 154 (Pat), [2007] FSR 481.

6 CPR 63.10(3). Where the application notice is served on the comptroller electronically, it must comply with any requirements for the sending of electronic communications to the comptroller: *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 12.2.

7 As to the meaning of 'court' see PARA 637 note 1.

8 CPR 63.10(4), (9). As to the Official Journal (Patents) see PARA 580.

9 CPR 63.10(5).

10 CPR 63.10(6).

11 CPR 63.10(7). Not later than two days before the first hearing date the applicant, the comptroller if he wishes to be heard, the parties to the proceedings and any other opponent, must file and serve a document stating the directions sought: *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 12.1.

12 CPR 63.10(8).

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350. Effect of amendment.

Any amendment of the specification of a patent¹ allowed by the comptroller² or the court³ has effect and is deemed always to have had effect from the grant of the patent⁴. It is unlikely, therefore, that the right to make any lawful amendment can be challenged except on the ground of fraud⁵, although there is power to revoke a patent where the matter disclosed⁶ in the specification of the patent extends beyond that disclosed in the application for the patent as filed⁷ or where the protection conferred by the patent has been extended by an amendment which should not have been allowed⁸. Further, it is by no means certain that an order of the comptroller allowing a forbidden amendment would not be void⁹.

1 Ie under the Patents Act 1977: see PARA 303.

2 Ie under the Patents Act 1977 ss 27(1), 75(1): see PARA 347. As to the comptroller see PARA 577.

3 Ie under the Patents Act 1977 s 75(1): see PARA 347. As to the meaning of 'court' see PARA 637 note 1.

4 Patents Act 1977 ss 27(3), 75(3). As to grant see PARA 338.

5 This was explicit in the Patents Act 1949 s 31(2) (repealed) and seems to follow from the wording of the Patents Act 1977 ss 27(3), 75(3).

6 As to the disclosure of matter see PARA 352.

7 See the Patents Act 1977 s 72(1)(d); and PARA 564. As to the meaning of 'application as filed' see PARA 317 note 2.

8 See the Patents Act 1977 s 72(1)(e); and PARA 564.

9 See the Patents Act 1977 s 76(2), (3); and PARA 352.

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351. Allowability of amendments.

Under the Patents Act 1977¹, the court² or the comptroller³, when exercising the discretion whether or not to allow a post-grant amendment, took into account the conduct of the patentee and, in particular, whether it had been in some way blameworthy⁴. On the other hand, amendments in opposition proceedings in the European Patent Office were allowed almost as a matter of course⁵ and, until the amendments to the European Patent Convention⁶ in 2000 came into force⁷, once a patent had been granted by the European Patent Office there was no opportunity before that office for post-grant amendments. There was thus a divergence of approach between the English courts and the European Patent Office, and the practice developed that where there were parallel proceedings to amend both before the court and the European Patent Office, nothing short of really blameworthy conduct on the part of the patentee should suffice to bar an amendment in the United Kingdom⁸.

The European Patent Convention now makes provision for a European patent to be limited by a post-grant amendment of the claims at the request of the proprietor⁹. Any decision to limit the European patent takes effect in all the contracting states in which the patent has been granted¹⁰. When considering whether or not to grant the request to limit the patent, the European Patent Office must first examine whether the requirements laid down in the Implementing Regulations have been met¹¹ and, if so, it must decide to limit the patent in accordance with the Implementing Regulations or else reject the request¹².

The provisions as to post-grant amendment in the Patents Act 1977¹³ have now been amended by the Patents Act 2004 so that when the court or the comptroller is considering a post-grant amendment, it or he must have regard to any relevant principles applicable under the European Patent Convention¹⁴. These principles are likely to be derived from relevant regulations made under the European Patent Convention, any relevant guidelines produced by the European Patent Office and decisions of the Opposition Division and Boards of Appeal. This is intended to ensure that, as far as possible, there is consistency in approach as regards post-grant amendment in national proceedings and before the European Patent Office.

The fact that the amendment would leave the patent still invalid was, and is likely to remain, a ground for refusing leave to amend¹⁵.

1. As enacted and following earlier practice developed under the Patents Act 1949.

2. As to the meaning of 'court' see PARA 637 note 1.

3. As to the comptroller see PARA 577.

4. See, for example, *Smith Kline & French Laboratories Ltd v Evans Medical Ltd* [1989] FSR 561; *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent* [1991] RPC 221; *Hsuing's Patent* [1992] RPC 497; *Coal Industry (Patents) Ltd's Application* [1994] RPC 661; *Kimberly-Clark Worldwide Inc v Procter & Gamble Ltd* [2000] RPC 422; *Oxford Gene Technology Ltd v Affymetrix (No 2)* [2001] RPC 18, [2000] All ER (D) 1945, CA; *M-Systems Flash Disk Pioneers Ltd v Trek 2000 International Ltd* [2008] EWHC 102 (Pat), [2008] All ER (D) 201 (Jan).

Generally, delay was a ground for refusal of leave to amend unless the patentee could show reasonable grounds for his delay and a patentee who had sought to obtain an unfair advantage from a patent which he knew or ought to have known required amendment would be refused leave: *Smith Kline & French Laboratories Ltd v Evans Medical Ltd* [1989] FSR 561. What was an acceptable delay was a question of fact and if detriment to the opponent or the public was established then the permissible period of delay might be shorter than in a case where no such detriment had been established: *Matbro Ltd v Michigan (Great Britain) Ltd* [1973] RPC 823 at 833; *Smith Kline & French Laboratories Ltd v Evans Medical Ltd*; *Instance v CCL Label Inc* [2002] FSR 430 at

440-444; *Vector Corpn v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct). However, an amendment by way of deletion was allowed unless there were exceptional circumstances such as bad faith or dishonesty (*Mabuchi Motor KK's Patents* [1996] RPC 387 at 402; *Nutrinova Nutrition Specialties & Food Ingredients GmbH v Scanchem UK Ltd (No 2)* [2001] FSR 831 at 837; *Kirin-Amgen Inc's Patent* [2002] RPC 851 at 873; *Vector Corpn v Glatt Air Techniques Inc*) or because, although a deletion, it in fact extended the disclosure (*Merck & Co Inc's Patents* [2003] EWCA Civ 1545, [2004] FSR 330 at 352). See also PARA 353.

5 See *Richardson-Vicks Inc's Patent* [1995] RPC 568; *Re Palmaz's European Patents (UK)* [1999] RPC 47 at 62-65, [2000] All ER (D) 357, [2000] IP & T 693.

6 As to the European Patent Convention see PARA 668 et seq.

7 Ie the amendments made by the Act revising the European Patent Convention of 29.11.2000, which came into force on 13 December 2007.

8 *Richardson-Vicks Inc's Patent* [1995] RPC 568; *Re Palmaz's European Patents (UK)* [1999] RPC 47 at 62-65, [2000] All ER (D) 357, [2000] IP & T 693.

9 European Patent Convention art 105a(1). The request for an amendment may not be filed while opposition proceedings in respect of the European patent are pending: art 105a(2).

10 European Patent Convention art 105b(3). It takes effect on the date on which mention of the decision is published in the European Patent Bulletin: art 105b(3).

11 European Patent Convention art 105b(1). See the Implementing Regulations r 91.

12 European Patent Convention art 105b(2).

13 Ie the Patents Act 1977 ss 27, 75 (see PARA 347).

14 See the Patents Act 1977 ss 27(6), 75(5) (both added by the Patents Act 2004 with effect from 13 December 2007). See PARA 347.

15 See eg *Bristol-Myers Co (Johnson's) Application* [1979] RPC 450; *LG Philips LCD Co Ltd v Tatung (UK) Ltd* [2006] EWCA Civ 1774, [2007] RPC 509.

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352. Restrictions on amendment.

No amendment of an application for a patent¹ may be allowed² if it results in the application disclosing matter extending beyond that disclosed in the application as filed³; and no amendment of the specification⁴ of a patent may be allowed⁵ if it results in the specification disclosing additional matter or extends the protection conferred by the patent⁶.

Matter is taken to have been disclosed in any relevant application⁷ or in the specification of a patent if it was either claimed or disclosed, otherwise than by way of disclaimer or acknowledgment of prior art, in that application or specification⁸. It is a ground of revocation that the protection conferred by the patent has been extended by an amendment which should not have been allowed⁹.

1 As to the application see PARA 315.

2 Ie under the Patents Act 1977 s 15A(6) (see PARA 318), s 18(3) (see PARA 329) or s 19(1) (see PARA 330).

3 Patents Act 1977 s 76(2) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 20; and amended by SI 2004/2357). As to the meaning of 'application as filed' see PARA 317 note 2. As to added matter see PARA 353.

4 As to the specification see PARA 319.

5 Ie under the Patents Act 1977 s 27(1) (see PARA 347), s 73 (see PARA 571) or s 75 (see PARA 348).

6 Patents Act 1977 s 76(3) (substituted by the Copyright, Designs and Patents Act 1988 Sch 5 para 20). The necessary comparison must be performed with the application as filed and not with the specification prior to amendment: *Triumph Actuation Systems LLC v Aeroquip-Vickers Ltd* [2007] EWHC 1367 (Pat) at [41], [2007] All ER (D) 150 (Jun) at [41] per Pumfrey J.

7 Ie within the meaning of the Patents Act 1977 s 5: see PARA 312.

8 Patents Act 1977 s 130(3). As a source of disclosure, claims are not accorded any higher status than the description: *Asahi Kasei Kogyo KK's Application* [1991] RPC 485 at 533, HL, per Lord Oliver of Aylmerton; *AC Edwards Ltd v Acme Signs & Displays Ltd* [1992] RPC 131, CA.

9 Patents Act 1977 s 72(1)(e). See also PARA 564.

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353. Added matter; extended protection.

The test to be applied in deciding whether an application discloses matter extending beyond that disclosed in the application as filed, or whether the specification of a granted patent discloses matter extending beyond that disclosed in the specification as filed, is whether the patentee has disclosed either by deletion or addition any inventive concept which was not disclosed before¹. For example, deletion of an essential feature from a claim may result in the amended claim disclosing a materially different invention from that disclosed in the specification and claims of the application, with the result that the invention disclosed after amendment would extend beyond that disclosed in the application²; but the omission of non-essential features may not result in an extension of the disclosure if the result is that a different invention is not disclosed in the amended specification³. An 'intermediate generalisation', namely taking features which had been disclosed only in one particular context and having no inventive significance and introducing them into a claim deprived of that context, amounts to added matter⁴. It is necessary to ascertain first what the unamended specification as a whole, including the claims, disclosed either explicitly or implicitly to the skilled reader, secondly to do the same in respect of the patent as granted and thirdly to compare the two disclosures and decide whether the amended specification contains information which is not derived directly and unambiguously from that which the specification contained previously⁵.

1 *Southco Inc v Dzus Fastener Europe Ltd* [1992] RPC 299 at 320, CA per Purchas LJ. See also *AC Edwards Ltd v Acme Signs & Displays Ltd* [1992] RPC 131, CA; *T Bonzel v Intervention Ltd (No 3)* [1991] RPC 553; *Raychem Ltd's Applications* [1986] RPC 547; *Reckitt & Colman Products Ltd v Richardson-Vicks Ltd*; *Smith Kline Beecham v Richardson-Vicks Inc* [1995] RPC 568, (1995) 25 BMLR 63; *LG Philips LCD Co Ltd v Tatung (UK) Ltd* [2006] EWCA Civ 1774, [2007] RPC 509; G 01/93 *Advanced Semiconductor Products* [1995] EPOR 97; *European Central Bank v Document Security Systems Inc* [2007] EWHC 600 (Ch), [2007] All ER (D) 420 (Mar) (affd [2008] EWCA Civ 192, [2008] All ER (D) 277 (Mar)), approved in *Vector Corp v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct).

2 *Raychem Ltd's Applications* [1986] RPC 547; *Harding's Patent* [1988] RPC 515. Pre-grant amendments which widen claims are not prohibited by the Patents Act 1977 s 76 provided that the widening does not amount to an extension of matter. Post-grant widening amendments are expressly prohibited by s 76(3)(b): see PARA 352.

3 *Southco Inc v Dzus Fastener Europe Ltd* [1992] RPC 299, CA. See also Case T-331/87 *Houdaille/Removal of Feature* [1991] EPOR 194, Technical Board of Appeal.

4 See *Re Palmaz's European Patents (UK)* [1999] RPC 47, [2000] All ER (D) 357, [2000] IP & T 693; *LG Philips LCD Co Ltd v Tatung (UK) Ltd* [2006] EWCA Civ 1774, [2007] RPC 509; *Vector Corp v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct).

5 Case T-151/84 *Thomson-CSF's Application* [1988] EPOR 29, Technical Board of Appeal; Case T-467/90 *Thomson-CSF/Spooling process for optical fibre gyroscope* [1991] EPOR 115, Technical Board of Appeal, applied in *AC Edwards Ltd v Acme Signs & Displays Ltd* [1992] RPC 131, CA. See also *T Bonzel v Intervention Ltd (No 3)* [1991] RPC 553; *Mölnlycke AB v Procter and Gamble Ltd (No 5)* [1994] RPC 49 at 135, CA; *Flexible Directional Indicators Ltd's Application* [1994] RPC 207 (pre-grant amendment); *Richardson-Vicks' Patent* [1995] RPC 568; *European Central Bank v Document Security Systems Inc* [2007] EWHC 600 (Ch), [2007] All ER (D) 420 (Mar) (affd [2008] EWCA Civ 192, [2008] All ER (D) 277 (Mar)), approved in *Vector Corp v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct).

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354. Correction of clerical errors.

The comptroller¹ may correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent² or any document filed in connection with such a patent or application³. Where the comptroller is requested to correct such an error or mistake, any person may give the comptroller notice of opposition to the request and the comptroller must determine the matter⁴.

Where the comptroller is requested to correct an error or mistake in a withdrawal of an application for a patent⁵, and: (1) the application was published⁶; and (2) details of the withdrawal were published by the comptroller, the comptroller must publish notice of such a request in the Official Journal (Patents)⁷. Where the comptroller publishes such a notice, he may only correct an error or mistake by order⁸.

The comptroller also has certain powers of correction in relation to international applications⁹. The comptroller's powers of correction are limited to mistakes in documents and do not extend to procedural mistakes¹⁰.

1 As to the comptroller see PARA 577.

2 As to the specification see PARA 319; and as to the application see PARA 315. Where the request is to correct a specification of a patent or application, the request will not be granted unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification): Patents Rules 2007, SI 2007/3291, r 105(3). However, this does not apply where the error in the specification of the patent or application is connected to the delivery of the application in electronic form or using electronic communications: r 105(4).

3 Patents Act 1977 s 117(1); and see *Dukhovoskoi's Applications* [1985] RPC 8. Where the comptroller determines that no person could reasonably object to the correction no advertisement need be published under the Patents Rules 2007, SI 2007/3291, r 75 (see PARA 600): r 105(5).

4 Patents Act 1977 s 117(2). A request to the comptroller to correct an error or mistake under s 117 must be made in writing and identify the proposed correction: Patents Rules 2007, SI 2007/3291, r 105(1). The comptroller may, if he thinks fit, require the person requesting a correction to produce a copy of the document indicating the correction: r 105(2). The correction of a name, address or address for service must be made under r 49 (see PARA 591): r 105(7).

5 As to withdrawal of applications see PARA 332.

6 If published under the Patents Act 1977 s 16: see PARA 327.

7 Patents Act 1977 s 117(3) (added by SI 2004/2357); Patents Rules 2007, SI 2007/3291, r 105(6). As to the Journal see PARA 580.

8 Patents Act 1977 s 117(4) (added by SI 2004/2357).

9 See the Patents Rules 2007, SI 2007/3291, rr 71, 72; and PARA 664.

10 *Klein Schanzlin & Becker AG's Application* [1985] RPC 241 (failure to file priority document in time not capable of correction under the Patents Act 1977 s 117(1)).

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(2) RESTORATION

355. Lapsed patents.

A patent ceases to have effect on the expiration of the period provided for the payment of any renewal fee if the fee is not paid within that period or within the following six months¹. A patent which has thus ceased to have effect may, however, be restored on application made to the comptroller² at any time within the prescribed period³. For the purposes of an application for restoration, a patent ceases to have effect on the expiry of the period allowed for payment of the renewal fee and not on the expiry of the six months' period of grace⁴.

1 See the Patents Act 1977 s 25(3), (4); and PARA 340.

2 As to the comptroller see PARA 577.

3 Patents Act 1977 s 28(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 6(1), (2)). An application under the Patents Act 1977 s 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in s 25(4) ends (see PARA 340): Patents Rules 2007, SI 2007/3291, r 40(1). Where: (1) a patent has ceased to have effect because a renewal fee has not been paid by the end of the renewal period; and (2) the renewal fee and the prescribed additional fee have not been paid by the end of the period specified in the Patents Act 1977 s 25(4) (the 'extended period'), the comptroller must, before the end of the period of six weeks beginning immediately after the end of the extended period, send a notice to the proprietor of the patent stating that the extended period has expired and referring him to the provisions of s 28 (see PARAS 356-357): Patents Rules 2007, SI 2007/3291, r 41(1), (2). The comptroller must send the notice to the address specified by r 39(3) (see PARA 340): r 41(3).

4 *Daido Kogyo KK's Patent* [1984] RPC 97, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/3. POST-GRANT AMENDMENT, RESTORATION AND SURRENDER/(2) RESTORATION/356. Restoration of lapsed patents.

356. Restoration of lapsed patents.

Where a patent has ceased to have effect by reason of a failure to pay any renewal fee¹, an application for the restoration of the patent may be made to the comptroller² at any time within the prescribed period³. Notice of the application must be published by the comptroller in the Official Journal (Patents)⁴. Such an application, which must be on the prescribed form⁵, may be made by the person who was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect⁶. Where the patent was held by two or more persons jointly, the application may, with the leave of the comptroller, be made by one or more of them without joining the others⁷. If the comptroller is satisfied that the failure of the proprietor of the patent: (1) to pay the renewal fee within the prescribed period; or (2) to pay that fee and any prescribed additional fee within the period of six months immediately following the end of that period, was unintentional⁸, the comptroller must by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee⁹.

Where the comptroller grants an application he must advertise the fact in the Official Journal (Patents)¹⁰. If, however, upon consideration of the evidence, the comptroller is not satisfied that a case for an order has been made out, he must notify the applicant accordingly¹¹. The applicant may then, before the end of the period of one month beginning with the date of that notification, request to be heard by the comptroller¹² and the comptroller must then give the applicant an opportunity to be heard before he determines whether to grant or refuse the application¹³.

1 le under the Patents Act 1977 s 25(3): see PARA 355. As to renewal fees see PARA 340.

2 As to the comptroller see PARA 577.

3 Patents Act 1977 s 28(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 6(1), (2)). An application under the Patents Act 1977 s 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in s 25(4) ends (see PARA 340): Patents Rules 2007, SI 2007/3291, r 40(1). The prescribed time limit may not be extended: see PARA 599.

4 Patents Act 1977 s 28(2A) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 6(1), (3)); Patents Rules 2007, SI 2007/3291, r 40(3). As to the Journal see PARA 580.

5 The application must be made on Patents Form 16: Patents Rules 2007, SI 2007/3291, r 40(2). The applicant must file evidence in support of the application: r 40(4). If that evidence does not accompany the application, the comptroller must specify a period within which the evidence is to be filed: r 40(5).

6 Patents Act 1977 s 28(2). As to ownership see PARA 360 et seq.

7 Patents Act 1977 s 28(2). As to the exercise of the comptroller's discretion see PARA 593.

8 See *Sirna Therapeutics Inc's Application* [2006] RPC 351.

9 Patents Act 1977 s 28(3) (substituted by SI 2004/2357; and amended by the Patents Act 2004 s 8(3)). As to prescribed additional fees see PARA 340.

10 Patents Rules 2007, SI 2007/3291, r 40(9).

11 Patents Rules 2007, SI 2007/3291, r 40(6).

12 Patents Rules 2007, SI 2007/3291, r 40(7).

13 Patents Rules 2007, SI 2007/3291, r 40(8). As to appeals against a decision of the comptroller see PARA 639.

UPDATE

356 Restoration of lapsed patents

NOTES 8, 9--See *Matshusita Electric Industrial Co Ltd v UK Intellectual Property Office* [2008] All ER (D) 219 (Jul) (a mere assertion that the failure to pay renewal fees had been unintentional was insufficient).

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357. Conditions of restoration.

An order for the restoration of a lapsed patent¹ may be made subject to such conditions as the comptroller² thinks fit, including a condition requiring compliance with any provisions relating to registration³ which have not been complied with⁴. If the proprietor of the patent fails to comply with any condition of such an order, the comptroller may revoke the order and give such directions consequential on the revocation as he thinks fit⁵. An appeal lies to the Patents Court⁶ from any decision of the comptroller under these provisions⁷. A condition may be imposed that the protection given to third parties⁸ be extended to cover the period until judgment⁹.

1 le an order made under the Patents Act 1977 s 28(3): see PARA 356.

2 As to the comptroller see PARA 577.

3 As to registration see PARA 585 et seq.

4 Patents Act 1977 s 28(4).

5 Patents Act 1977 s 28(4). The comptroller must give any party to a proceeding before him an opportunity of being heard before exercising his power under this provision: see s 101; and PARA 593.

6 As to the Patents Court see PARA 637 et seq.

7 Patents Act 1977 s 97(1). As to appeals generally see PARAS 639-642. A patents county court has no jurisdiction to hear appeals from the comptroller: see PARA 644 note 2.

8 See PARA 358.

9 *Daido Kogyo KK's Patent* [1984] RPC 97, CA. See also *Re Eveready Battery Co Inc's Patent* [2000] RPC 852.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/3. POST-GRANT AMENDMENT, RESTORATION AND SURRENDER/(2) RESTORATION/358. Effect on third persons of restoration of lapsed patents.

358. Effect on third persons of restoration of lapsed patents.

The effect of an order for the restoration of a patent¹ is as follows².

Anything done under or in relation to the patent during the period between expiry and restoration is treated as valid³; and anything done during that period which would have constituted an infringement⁴ if the patent had not expired is treated as an infringement:

- 113 (1) if done at a time when it was possible for the patent to be renewed⁵; or
- 114 (2) if it was a continuation or repetition of an earlier infringing act⁶.

If, after it was no longer possible for the patent to be so renewed, and before publication of notice of the application for restoration, a person:

- 115 (a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired; or
- 116 (b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent; but this right does not extend to granting a licence to another person to do the act⁷.

If the act was done, or the preparations were made, in the course of a business, the person entitled to the right so conferred⁸ may:

- 117 (i) authorise the doing of that act by any partners of his for the time being in that business; and
- 118 (ii) assign that right, or transmit it on death, or in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or the preparations were made⁹.

Where a product is disposed of to another person in exercise of the rights so conferred¹⁰, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent¹¹.

The above provisions apply in relation to the use of a patent for the services of the Crown¹² as they apply in relation to infringement of the patent¹³.

1 As to restoration of a patent see PARA 356.

2 Patents Act 1977 s 28A(1) (s 28A added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 7).

3 Patents Act 1977 s 28A(2) (as added: see note 2).

4 As to acts which constitute an infringement see PARA 512 et seq.

5 Ie under the Patents Act 1977 s 25(4): see PARA 340.

6 Patents Act 1977 s 28A(3) (as added: see note 2).

7 Patents Act 1977 s 28A(4) (as added: see note 2). Section 28A(4) (as added) corresponds to s 28(5)(b), (6) (repealed). The decision in *Daido Kogyo KK's Patent* [1984] RPC 97, CA (restoration made conditional upon the protection given to third parties by the Patents Act 1977 s 28(6) (repealed) being extended to cover the period until judgment) may accordingly still be relevant, although the situation there obtaining is unlikely to recur as the comptroller now has a statutory obligation to publish notice of the application for restoration in the Official Journal (Patents): see s 28(2A); and PARA 356.

8 le the right conferred by the Patents Act 1977 s 28A(4): see the text to note 7.

9 Patents Act 1977 s 28A(5) (as added: see note 2).

10 le the rights conferred by the Patents Act 1977 s 28A(4) or (5): see the text to notes 7-9.

11 Patents Act 1977 s 28A(6) (as added: see note 2).

12 As to the meaning of 'services of the Crown' and 'use for the services of the Crown' see PARA 405 note 3.

13 Patents Act 1977 s 28A(7) (as added: see note 2).

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(3) SURRENDER

359. Surrender.

The proprietor of a patent may offer to surrender his patent at any time by notice¹ given to the comptroller². A person may give notice to the comptroller of his opposition to the surrender of a patent, and if he does so the comptroller must notify the proprietor of the patent and determine the question³.

If the comptroller is satisfied that the patent may properly be surrendered, he may accept the offer and, as from the date when notice of his acceptance is published in the Official Journal (Patents)⁴, the patent ceases to have effect⁵. No action for infringement⁶ lies, however, in respect of any act done before that date and no right to compensation accrues for any use of the patented invention⁷ before that date for the services of the Crown⁸.

1 The notice of an offer by a proprietor to surrender a patent must be in writing and include: (1) a declaration that no action is pending before the court for infringement or revocation of the patent; or (2) where such an action is pending, the particulars of the action: Patents Rules 2007, SI 2007/3291, r 42.

2 Patents Act 1977 s 29(1). As to the comptroller see PARA 577.

3 Patents Act 1977 s 29(2).

4 As to the Journal see PARA 580.

5 Patents Act 1977 s 29(3). See *Dyson Ltd's Patent* [2003] RPC 24; *Dyson Ltd's Patent (No 2)* [2003] RPC 848.

6 As to proceedings for infringement see PARA 521 et seq.

7 As to the meaning of 'patented invention' see PARA 371 note 27.

8 Patents Act 1977 s 29(3). As to the meaning of 'use for the services of the Crown' see PARA 405 note 3. As to Crown use generally see PARA 404 et seq; and as to appeals against decisions of the comptroller see PARAS 639-641.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/360. In general.

4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT

(1) OWNERSHIP

360. In general.

An invention¹ is personal property² and, except in certain cases of inventions made by employees³, belongs primarily to the inventor or joint inventors⁴. A patent or an application for a patent⁵ is also personal property⁶, and rights in inventions, patents and applications⁷ may therefore devolve or be transferred⁸ at any stage from prior to the making of the invention⁹ to the expiry of the patent¹⁰ in the same way as other personal property, provided that any related agreement is not in unreasonable restraint of trade¹¹.

Questions and disputes as to the ownership of inventions, patents and applications for patents, and rights in them, being questions which relate to the ownership of personal property rights, are therefore within the inherent jurisdiction of the court¹², subject to a limitation period of two years after the grant of the patent in question¹³. The two-year limitation period does not apply, however, if it is shown that the proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him, that he was not entitled to the grant¹⁴. In addition, there is a UK Intellectual Property Office¹⁵ jurisdiction, subject to the same limitation¹⁶, to deal with such questions and disputes, which may be referred to the comptroller for determination¹⁷. The comptroller may also determine questions about entitlement to foreign patents¹⁸, provided that the patent in question has not been granted elsewhere, and settle disputes between joint applicants or proprietors, as the case may be, as to procedure¹⁹ and as to the assignment or licensing of a patent²⁰. In any of these cases, other than disputes between joint applicants or joint proprietors, the comptroller may, however, decline to deal with the question or dispute referred to him on the ground that it would more properly be determined by the court²¹.

1 As to the meaning of 'invention' see PARA 301 note 2.

2 See **PERSONAL PROPERTY** vol 35 (Reissue) PARA 1237.

3 As to rights in employees' inventions see PARA 369.

4 See the Patents Act 1977 s 7(2)(a); and PARA 307. As to the meanings of 'inventor' and 'joint inventor' see PARA 301 note 3.

5 As to the application see PARA 315.

6 Patents Act 1977 s 30(1). All patents and applications are expressly not choses in action: Patents Act 1977 s 30(1). See **CHOSSES IN ACTION** vol 13 (2009) PARA 4.

7 For these purposes, 'right', in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent: Patents Act 1977 s 130(1). This may include equitable interests: *Kakkar v Szelke* [1989] FSR 225, CA.

8 See the Patents Act 1977 s 30; and PARAS 373-374.

9 See the Patents Act 1977 s 7(2)(b); and PARA 307. In the case of inventions made by employees which by virtue of s 39 (see PARA 369) belong to the employee, any contract which purports to diminish his rights in any invention made prior to the contract is unenforceable to that extent: see s 42(2); and PARA 369.

10 As to the term of patents see PARA 339.

11 As to restraint of trade see **COMPETITION** vol 18 (2009) PARA 377 et seq.

12 As to the meaning of 'court' see PARA 637 note 1. This jurisdiction is subject to certain limitations in respect of questions relating to European patents: see the Patents Act 1977 s 82; and PARA 365.

13 See the Patents Act 1977 s 37(9); and PARA 367. As to the two-year period see *Yeda Research and Development Co Ltd v Rhone Poulenc Rorer International Holdings Inc* [2007] UKHL 43, [2008] 1 All ER 425, [2008] RPC 1. Proceedings in which this jurisdiction is invoked are normally taken by the Patents Court or by the patents county court. As to the Patents Court see PARA 637 et seq; and as to the patents county court see PARA 644 et seq.

14 See the Patents Act 1977 s 37(9); and PARA 367.

15 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

16 See the Patents Act 1977 s 37(5); and PARA 367.

17 Ie under the Patents Act 1977 s 8(1) (reference before grant: see PARA 361) and s 37(1) (reference after grant: see PARA 366). As to the comptroller see PARA 577.

18 Ie under the Patents Act 1977 s 12: see PARA 364.

19 Ie under the Patents Act 1977 s 10 (see PARA 361) and s 12(4) (see PARA 364).

20 Ie under the Patents Act 1977 s 37(1)(c) (see PARA 366).

21 See the Patents Act 1977 s 8(7) (see PARA 361), s 12(2) (see PARA 364) and s 37(8) (see PARA 366). As to when the comptroller should decline jurisdiction in favour of the court see *Luxim Corp v Ceravision Ltd* [2007] EWHC 1624 (Ch), [2007] RPC 797, [2007] All ER (D) 116 (Jul). Where the comptroller so declines to deal with a question, any person seeking the court's determination of that question must issue a claim form within 14 days of the comptroller's decision: CPR 63.11. The presence of allegations of improper conduct or breach of fiduciary duty may lead the comptroller to decline jurisdiction: *Reflex Modulation Ltd v Alteristic Instruments Ltd* BL O/084/08, C-G.

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361. Determination of right to patent before grant.

At any time before a patent has been granted¹ for an invention², whether or not an application³ has been made for it, any person may refer to the comptroller⁴ the question whether he is entitled to be granted a patent for that invention⁵, either alone or with any other persons, or has or would have any right⁶ in or under any patent so granted or any application for such a patent⁷. Similarly, at any time before a patent has been granted for an invention, any of two or more co-proprietors of an application for a patent for that invention may refer to the comptroller the question whether any right in or under the application should be transferred or granted to any other person⁸. In both these cases, the comptroller must determine the question referred and may make such order as he thinks fit to give effect to the determination⁹. If, however, it appears to him that the question referred involves matters which would more properly be determined by the court¹⁰, he may decline to deal with it¹¹.

Where a reference has been made to the comptroller under these provisions but has not been determined before the time when the application is first in order for a grant of a patent, that fact does not prevent the grant of a patent¹². However, on the grant of the patent the person who made the reference is treated as having referred to the comptroller the question whether the patent has been granted to the person entitled to it¹³.

If any dispute arises between joint applicants for a patent as to whether or in what manner the application should be proceeded with, the comptroller, on a request made by any of the parties, may give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it is to be proceeded with, or for both those purposes, according as the case may require¹⁴.

1 As to grant see PARA 338.

2 As to the meaning of 'invention' see PARA 301 note 2. In the context of a dispute as to entitlement the term 'invention' means that which was conceived by the applicant for the patent to be his invention, whether patentable or not: *Viziball Ltd's Application* [1988] RPC 213. The precise formulation of the claims is not important: *Norris's Patent* [1988] RPC 159.

3 As to the application see PARA 315.

4 As to the comptroller see PARA 577.

5 In under the Patents Act 1977 s 7(2): see PARA 307.

6 As to the meaning of 'right' see PARA 360 note 7.

7 Patents Act 1977 s 8(1)(a). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

8 Patents Act 1977 s 8(1)(b). As to the transfer of rights in or under an application see s 30; and PARAS 373-374. See *Yeda Research and Development Co Ltd v Rhone Poulenc Rorer International Holdings Inc* [2007] UKHL 43, [2008] 1 All ER 425, [2008] RPC 1.

9 Patents Act 1977 s 8(1). As to particular orders which the comptroller may make on a reference under s 8(1)(a) see PARA 362.

10 As to the meaning of 'court' see PARA 637 note 1.

11 Patents Act 1977 s 8(7). As to the procedure in this case see PARA 360 note 21.

12 Patents Act 1977 s 9.

13 Patents Act 1977 s 9. As to questions referred in this case see s 37; and PARA 366.

14 Patents Act 1977 s 10. As to the effect of such directions on any third party rights under an application for a patent see PARA 363.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/362. Relief available from the comptroller.

362. Relief available from the comptroller.

Where at any time before a patent has been granted¹ for an invention² a person refers a question relating to his entitlement to a patent for it³, the comptroller⁴ must determine the question and may make such order as he thinks fit to give effect to that determination⁵. In particular, where the reference is made between the filing of an application⁶ for a patent and the grant of a patent pursuant to the application, the comptroller may⁷:

- 119 (1) order that the application is to proceed in the name of the person making the reference, either solely or jointly with that of any other applicant, instead of in the name of the applicant or any specified applicant⁸;
- 120 (2) where the reference was made by two or more persons, order that the application is to proceed in all their names jointly⁹;
- 121 (3) refuse to grant a patent in pursuance of the application or order the application to be amended¹⁰ so as to exclude any of the matters in respect of which the question was referred¹¹;
- 122 (4) make an order transferring or granting any licence or other right¹² in or under the application¹³ and give directions to any person for carrying out the provisions of any such order¹⁴.

Where, however, on a reference it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor¹⁵ or the applicant for the patent has become entitled to be granted, whether alone or with any other persons, a patent for the invention or has or would have any right in or under any patent so granted or any application for any such patent, an order may not be made under head (1), (2) or (4) above on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference¹⁶.

Where a question relating to entitlement to a patent is referred to the comptroller after an application for the patent has been made and:

- 123 (a) the comptroller orders the application for a patent for the invention to which the question relates to be amended¹⁷;
- 124 (b) the application is refused¹⁸ before the comptroller has disposed of the reference, whether the reference was made before or after the publication of the application¹⁹; or
- 125 (c) the application is refused under any other provision of the Patents Act 1977 or is withdrawn²⁰ before the comptroller has disposed of the reference, whether the application is refused or withdrawn before or after its publication²¹,

the comptroller may order that any person by whom the reference was made may make a new application for a patent, within the prescribed period²², for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application²³.

Where a person refers to the comptroller any question relating to rights under a joint application for a patent²⁴, any order made may contain directions to any person for transferring or granting any right in or under the application²⁵.

If any person to whom the comptroller has given directions²⁶ fails to do anything necessary for carrying out those directions within 14 days after the date of the directions, the comptroller, on application by any person in whose favour or on whose reference the directions were given, may authorise him to do that thing on behalf of the person to whom the directions were given²⁷.

No directions may be given by the comptroller under these provisions so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such²⁸.

1 As to grant see PARA 338.

2 As to the meaning of 'invention' see PARA 301 note 2.

3 Ie under the Patents Act 1977 s 8(1)(a): see PARA 361.

4 As to the comptroller see PARA 577.

5 Patents Act 1977 s 8(1). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608. For guidance in relation to patent entitlement disputes see *University of Southampton's Applications* [2004] EWHC 2107 (Pat), [2005] RPC 11 (on appeal *IDA Ltd v University of Southampton* [2006] EWCA Civ 145, [2006] RPC 567, [2006] All ER (D) 22 (Mar)). See also *Hughes v Paxman* [2006] EWCA Civ 818, [2007] RPC 34.

6 As to the filing of an application see PARA 318.

7 The following provisions do not apply where the application is refused or withdrawn before the reference is disposed of by the comptroller: Patents Act 1977 s 8(2).

8 Patents Act 1977 s 8(2)(a).

9 Patents Act 1977 s 8(2)(b).

10 As to the amendment of applications before grant see PARA 330.

11 Patents Act 1977 s 8(2)(c).

12 As to the meaning of 'right' see PARA 360 note 7.

13 As to rights in or under an application and the transfer of them see the Patents Act 1977 s 30; and PARAS 373-374.

14 Patents Act 1977 s 8(2)(d). As to the effect of non-compliance with directions see the text to notes 26-27.

15 As to the meaning of 'inventor' see PARA 301 note 3.

16 Patents Act 1977 s 8(6).

17 Patents Act 1977 s 8(3)(a).

18 Ie under the Patents Act 1977 s 8(2)(c): see the text to notes 10-11.

19 Patents Act 1977 s 8(3)(b). As to publication of the application see PARA 327.

20 As to the refusal and withdrawal of applications see PARA 332.

21 Patents Act 1977 s 8(3)(c) (amended by the Patents Act 2004 s 6(1)).

22 The period prescribed for filing a new application under the Patents Act 1977 s 8(3) is the relevant period: Patents Rules 2007, SI 2007/3291, r 20(1). The relevant period is: (1) where the comptroller's decision to make an order under that provision is not appealed, three months beginning with the date on which the order was made; or (2) where that decision is appealed, three months beginning with the date on which the appeal was finally disposed of: r 20(3). The comptroller may however, if he thinks fit, shorten the relevant period after giving the parties such notice and subject to such conditions as the comptroller may direct: r 20(4).

23 Patents Act 1977 s 8(3). See *Viziball Ltd's Application* [1988] RPC 213. An application for a patent which: (1) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has

been granted; and (2) discloses additional matter, that is matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed, may be filed under the Patents Act 1977 s 8(3) but may not be allowed to proceed unless it is amended so as to exclude the additional matter: s 76(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 20). As to the disclosure of matter see PARA 352. Where such a new application is made, it is treated as having been filed on the date of filing the earlier application: Patents Act 1977 s 8(3). As to the meaning of 'date of filing' see PARA 316.

24 Ie under the Patents Act 1977 s 8(1)(b): see PARA 361.

25 Patents Act 1977 s 8(4).

26 Ie contained in an order made under the Patents Act 1977 s 8(2)(d), (4).

27 Patents Act 1977 s 8(5).

28 Patents Act 1977 s 8(8).

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363. Effect of transfer on rights of third persons of application for patent.

Where an order is made or directions are given¹ that an application for a patent² is to proceed in the name of one or some of the original applicants, whether or not it is also to proceed in the name of some other person, any licences³ or other rights⁴ in or under the application continue in force and are treated as granted by the persons in whose name the application is to proceed, subject to the provisions of the order and any directions⁵.

Where, however, an order is made or directions are given⁶ that an application for a patent is to proceed in the name of one or more persons none of whom was an original applicant, on the ground that the original applicant or applicants was or were not entitled to be granted the patent⁷, any licences or other rights in or under the application lapse on the registration⁸ of that person or those persons as the applicant or applicants or, where the application has not been published⁹, on the making of the order, subject to the provisions of the order and any directions¹⁰.

If, however, before registration of a reference¹¹ resulting in the making of such an order the original applicant or any of the applicants¹² or a licensee¹³ of the applicant, acting in good faith, worked the invention in question in the United Kingdom¹⁴ or made effective and serious preparations to do so, that or those original applicant or applicants or the licensee, on making a request within the prescribed period¹⁵ to the person in whose name the application is to proceed, is or are entitled to be granted a licence other than an exclusive licence¹⁶ to continue working or, as the case may be, to work the invention¹⁷. If, before registration of a reference resulting in the making of such an order, the original applicant or applicants or licensee has acted in such a way, he may, on making a request within the prescribed period to the new applicant, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention so far as it is the subject of the new application¹⁸. Any such licence¹⁹ must be granted for a reasonable period and on reasonable terms²⁰.

Further, where an order is made²¹, the person in whose name the application is to proceed or, as the case may be, the person who makes the new application, or any person claiming that he is entitled to be granted any such licence may refer to the comptroller²² for determination of the question whether the latter is so entitled and whether any such period is or terms are reasonable²³. The comptroller, if he considers it appropriate, may order the grant of such a licence²⁴.

1 le under the Patents Act 1977 s 8 (see PARA 362) or s 10 (see PARA 361).

2 As to the application see PARA 315.

3 As to licences see PARA 378 et seq.

4 As to the meaning of 'right' see PARA 360 note 7.

5 Patents Act 1977 s 11(1). Without prejudice to any other method of enforcement, any order for the grant of a licence under s 11 has effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order: s 108.

6 le under the Patents Act 1977 s 8 (see PARA 362).

7 As to who may be granted a patent see PARA 307.

- 8 As to registration see PARA 585 et seq.
- 9 As to publication of the application see PARA 327.
- 10 Patents Act 1977 s 11(2).
- 11 Ie under the Patents Act 1977 s 8 (see PARA 362).
- 12 Patents Act 1977 s 11(3)(a).
- 13 Patents Act 1977 s 11(3)(b).
- 14 As to the meaning of 'United Kingdom' see PARA 303 note 5.
- 15 The period prescribed for the purposes of the Patents Act 1977 s 11(3), (3A) (see the text and note 18) is two months beginning with: (1) where s 11 is applied by s 12(5) (foreign and convention patents: see PARA 364), the date on which the order under s 12(1) was made; and (2) in any other case, the date on which the order under s 8 was made (see PARA 362): Patents Rules 2007, SI 2007/3291, r 90(1).
- 16 As to the meaning of 'exclusive licence' see PARA 380.
- 17 Patents Act 1977 s 11(3).
- 18 Patents Act 1977 s 11(3A) (added by the Patents Act 2004 s 6(2)).
- 19 Ie a licence under the Patents Act 1977 s 11(3) or s 11(3A) (see the text and notes 17-18).
- 20 Patents Act 1977 s 11(4) (amended by the Patents Act 2004 s 6(3)).
- 21 Ie an order under the Patents Act 1977 s 11(2) (see the text to notes 6-10) or s 11(3A) (see the text to note 18).
- 22 As to the comptroller see PARA 577.
- 23 Patents Act 1977 s 11(5) (amended by the Patents Act 2004 s 6(4)). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.
- 24 Patents Act 1977 s 11(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/364. Determination of right to foreign patents.

364. Determination of right to foreign patents.

At any time before a patent¹ is granted for an invention in pursuance of an application made under the law of any country other than the United Kingdom or under any treaty or international convention, whether or not that application has been made:

- 126 (1) any person may refer to the comptroller² the question whether he is entitled to be granted, either alone or with any other persons, any such patent for that invention or has or would have any right³ in or under any such patent or an application for such a patent⁴; or
- 127 (2) any of two or more co-proprietors of an application for such a patent for that invention may so refer the question whether any right in or under the application should be transferred or granted to any other person⁵.

The comptroller must determine the question so far as he is able to and may make such order as he thinks fit to give effect to the determination⁶. If, however, it appears to the comptroller that the question referred involves matters which would more properly be determined by the court⁷, he may decline to deal with it⁸. The comptroller also has jurisdiction to determine disputes between joint applicants for any such foreign patent as to whether the application should proceed⁹. In certain cases, namely:

- 128 (a) where an application for a European patent (UK)¹⁰ is refused or withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after publication of the application but before a question relating to the right to the patent has been referred to the comptroller¹¹ or before proceedings relating to that right have begun before the relevant convention court¹²;
- 129 (b) where an application has been made for a European patent (UK) and on such a reference to the comptroller under head (1) or head (2) above or any such proceedings as are mentioned in head (a) above the comptroller, the court or the relevant convention court determines by a final decision¹³, whether before or after publication of the application, that a person other than the applicant has the right to the patent, but that person requests the European Patent Office that the application for the patent should be refused¹⁴; or
- 130 (c) where an international application for a patent (UK)¹⁵ is withdrawn, or the designation of the United Kingdom in the application is withdrawn, whether before or after the making of any reference¹⁶ or the publication of the application¹⁷,

the comptroller may order:

- 131 (i) that any person, other than the applicant, who appears to him to be entitled to be granted a patent¹⁸ may within the prescribed period¹⁹ apply²⁰ for such a patent for the whole or part of any matter comprised in the earlier application²¹; and
- 132 (ii) that, if the later application is filed, it is to be treated as having been filed on the date of filing²² the earlier application²³.

¹ For these purposes, references to a patent and an application for a patent include respectively references to protection in respect of an invention and an application which, in accordance with the law of any country

other than the United Kingdom or any treaty or international convention, is equivalent to an application for a patent or for such protection: Patents Act 1977 s 12(7)(a). As to foreign patents and applications generally see PARA 307 et seq. As to the meaning of 'United Kingdom' see PARA 303 note 5.

2 As to the comptroller see PARA 577.

3 As to the meaning of 'right' see PARA 360 note 7.

4 Patents Act 1977 s 12(1)(a). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608. As to rights under patents see PARA 360. See eg *Cannings' United States Application* [1992] RPC 459 (where the comptroller made a determination in relation to a United States application which was the national phase of an international application made through the Patent Co-operation Treaty); *LIFFE Administration and Management v Pinkava* [2007] EWCA Civ 217, [2007] 4 All ER 981, [2007] RPC 667 (which concerned rights in US patent applications with subject matter not patentable in the United Kingdom). As to the treaty see PARA 653 et seq. As to the national phase see PARA 665.

5 Patents Act 1977 s 12(1)(b).

6 Patents Act 1977 s 12(1). Section 11 (see PARA 363) applies to any orders made under s 12(1) and to any orders made and directions given by the relevant convention court with respect to a question corresponding to any question which may be determined under s 12(1): s 12(5). See also PARA 363 note 15. For these purposes, 'relevant convention court', in relation to any proceedings under the European Patent Convention or the Patent Co-operation Treaty, means that court or other body which under that convention or treaty has jurisdiction over those proceedings, including, where it has such jurisdiction, any department of the European Patent Office: Patents Act 1977 s 130(1) (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 27(b), Sch 3). As to those conventions see PARA 653 et seq.

The Patents Act 1977 s 12(1), in its application to a European patent and an application for any such patent, has effect subject to s 82 (see PARA 365): s 12(3).

7 As to the meaning of 'court' see PARA 637 note 1.

8 Patents Act 1977 s 12(2).

9 The Patents Act 1977 s 10 (see PARA 361), except so much of it as enables the comptroller to regulate the manner in which an application is to proceed, applies to disputes between joint applicants for any such patent as is mentioned in s 12(1) as it applies to joint applicants for a patent under the Patents Act 1977: s 12(4).

10 As to the meaning of 'European patent (UK)' see PARA 675 note 1. As to European patents generally see PARA 668 et seq.

11 Ie under the Patents Act 1977 s 12(1): see the text to notes 1-6.

12 Patents Act 1977 s 12(6)(a) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 5(a)).

13 For these purposes, a decision is taken to be final when the time for appealing from it has expired without an appeal being brought or, where an appeal is brought, when it is finally disposed of: Patents Act 1977 s 12(7)(b).

14 Patents Act 1977 s 12(6)(b).

15 As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1. As to international patents generally see PARA 652 et seq.

16 Ie under the Patents Act 1977 s 12(1): see the text to notes 1-6.

17 Patents Act 1977 s 12(6)(c) (amended by the Patents Act 2004 Sch 2 paras 1(1), 5(b)).

18 Ie a patent under the Patents Act 1977. As to persons entitled to be granted such a patent see PARA 307.

19 The period prescribed for filing a new application under the Patents Act 1977 s 12(6) is the relevant period: Patents Rules 2007, SI 2007/3291, r 20(1). The relevant period is: (1) where the comptroller's decision to make an order under that provision is not appealed, three months beginning with the date on which the order was made; or (2) where that decision is appealed, three months beginning with the date on which the appeal was finally disposed of: r 20(3). The comptroller may however, if he thinks fit, shorten the relevant period after giving the parties such notice and subject to such conditions as the comptroller may direct: r 20(4).

20 As to the application see PARA 315.

21 An application for a patent which: (1) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and (2) discloses additional matter, that is matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed, may be filed under the Patents Act 1977 s 12 but may not be allowed to proceed unless it is amended so as to exclude the additional matter: s 76(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 20). As to the disclosure of matter see PARA 352.

22 As to the meaning of 'date of filing' see PARA 316.

23 Patents Act 1977 s 12(6).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/365. Jurisdiction to determine questions as to right to European patents.

365. Jurisdiction to determine questions as to right to European patents.

The jurisdiction of the court¹ and the comptroller² to determine questions³ about entitlement to European patents⁴ is subject to certain conditions⁵ in the case of:

- 133 (1) a question arising before the grant of a European patent as to whether a person has a right to be granted a European patent or a share in any such patent⁶; or
- 134 (2) any such question (an 'employer-employee question') between an employer⁷ and an employee⁸, or their successors in title, arising out of an application for a European patent for an invention made by the employee⁹.

The court and the comptroller have jurisdiction to determine any question under head (1) above if either of the following conditions is satisfied, namely:

- 135 (a) the applicant for the patent has his residence or principal place of business in the United Kingdom¹⁰; or
- 136 (b) the other party claims that the patent should be granted to him and he has his residence or principal place of business in the United Kingdom and the applicant does not have his residence or principal place of business in any of the relevant contracting states¹¹;

and also if, in either of those cases, there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom¹².

Similarly, the court and the comptroller have jurisdiction to determine an employer-employee question if either of the following conditions is satisfied, namely:

- 137 (i) the employee is mainly employed in the United Kingdom¹³; or
- 138 (ii) the employee is not mainly employed anywhere or his place of main employment cannot be determined, but the employer has a place of business in the United Kingdom to which the employee is attached, whether or not he is also attached elsewhere¹⁴;

and also if, in either of those cases, there is no written evidence that the parties have agreed to submit to the jurisdiction of the competent authority of a relevant contracting state other than the United Kingdom or, where there is such evidence of such an agreement, if the law applicable to the contract of employment does not recognise the validity of the agreement¹⁵.

In addition, without prejudice to the above provisions, the court and the comptroller have jurisdiction to determine any question under head (1) or head (2) above if there is written evidence that the parties have agreed to submit to the jurisdiction of the court or the comptroller, as the case may be, and, in the case of an employer-employee question, the law applicable to the contract of employment recognises the validity of the agreement¹⁶.

If, after proceedings to determine a question under head (1) or head (2) above have been brought before the competent authority of a relevant contracting state other than the United

Kingdom, proceedings are begun before the court or a reference is made to the comptroller¹⁷ to determine that question, the court or the comptroller, as the case may be, must stay the proceedings unless or until the competent authority of that other state either determines to decline jurisdiction and no appeal lies from the determination or the time for appealing expires¹⁸, or makes a determination which the court or the comptroller refuses to recognise¹⁹.

A determination of a question under head (1) or head (2) above by the competent authority of a relevant contracting state other than the United Kingdom from which no appeal lies or in respect of which the time for appealing has expired is recognised in the United Kingdom as if it had been made by the court or the comptroller unless the court or he refuses to recognise it²⁰. The court or the comptroller may refuse to recognise any such determination that the applicant for a European patent had no right to be granted the patent, or any share in it, if either the applicant did not contest the proceedings in question because he was not notified of them at all or in the proper manner or was not notified of them in time for him to contest the proceedings²¹, or the determination in the proceedings in question conflicts with the determination of the competent authority of any relevant contracting state in proceedings instituted earlier between the same parties as in the proceedings in question²².

1 As to the meaning of 'court' see PARA 637 note 1.

2 As to the comptroller see PARA 577.

3 In the Patents Act 1977 s 12: see PARA 364. For these purposes, references to the determination of a question include respectively references, in the case of the court, to the making of a declaration with respect to that question and, in the case of the court or the comptroller, to the making of an order under s 12 in relation to that question: s 82(8). As to the comptroller's power to award costs on a reference under s 12 see *Rizla Ltd's Application* [1993] RPC 365.

4 As to the meaning of 'European patent' see PARA 668 note 5. As to European patents generally see PARA 668 et seq.

5 Patents Act 1977 s 82(1). Section 12 (see PARA 364) does not confer jurisdiction on the comptroller to determine a question to which s 82 applies except in accordance with s 82(3)-(9) (see the text and notes 3, 6-19): s 82(2).

6 This includes whether or not the person has any equitable interest in the patent eg under a constructive trust: *Kakkar v Szelke* [1989] FSR 225, CA. As to shares in patents see PARA 360 note 7.

7 For these purposes, 'employer', in relation to an employee, means the person by whom the employee is or was employed: Patents Act 1977 s 130(1). As to the meaning of 'employee' see note 8.

8 For these purposes, 'employee' means a person who works or, where the employment has ceased, worked under a contract of employment or in employment under or for the purposes of a government department or a person who serves (or served) in the naval, military or air forces of the Crown: Patents Act 1977 s 130(1) (amended by the Armed Forces Act 1981 s 22(1), (3)).

9 Patents Act 1977 s 82(3).

10 Patents Act 1977 s 82(4)(a). As to the meaning of 'United Kingdom' see PARA 303 note 5.

11 Patents Act 1977 s 82(4)(b). For these purposes, 'relevant contracting state' means a country which is a party to the European Patent Convention and has not exercised its right under the convention to exclude the application of the protocol to the convention known as the 'Protocol on Recognition': Patents Act 1977 s 82(9). As to the convention see PARA 668.

12 Patents Act 1977 s 82(4).

13 Patents Act 1977 s 82(5)(a).

14 Patents Act 1977 s 82(5)(b).

15 Patents Act 1977 s 82(5) (amended by the Contracts (Applicable Law) Act 1990 s 5, Sch 4 para 3). As to the law applicable to the contract see **CONFLICT OF LAWS** vol 8(3) (Reissue) PARA 349 et seq.

16 Patents Act 1977 s 82(6) (amended by the Contracts (Applicable Law) Act 1990 Sch 4 para 3).

17 le under the Patents Act 1977 s 12: see PARA 364.

18 Patents Act 1977 s 82(7)(a).

19 Patents Act 1977 s 82(7)(b).

20 Patents Act 1977 s 83(1). Where in proceedings before the comptroller a person seeks recognition of a relevant determination, he must furnish to the comptroller a copy of the determination duly certified by the relevant official of the competent authority: Patents Rules 2007, SI 2007/3291, r 61(1). 'Relevant determination' means the determination of a question to which the Patents Act 1977 s 82 applies by the competent authority of a relevant contracting state other than the United Kingdom: Patents Rules 2007, SI 2007/3291, r 61(2).

21 Patents Act 1977 s 83(2)(a).

22 Patents Act 1977 s 83(2)(b).

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366. Determination of right to patent after grant.

After a patent has been granted¹ for an invention², any person having or claiming a proprietary interest in or under the patent may refer to the comptroller³ the question:

- 139 (1) who is or are the true proprietor or proprietors of the patent;
- 140 (2) whether the patent should have been granted⁴ to the person or persons to whom it was granted; or
- 141 (3) whether any right⁵ in or under the patent should be transferred⁶ or granted to any other person or persons⁷.

The comptroller must determine the question and make such order as he thinks fit to give effect to the determination⁸.

Such an order may contain provision:

- 142 (a) directing that the person by whom the reference is made be included, whether or not to the exclusion of any other person, among the persons registered⁹ as proprietors of the patent¹⁰;
- 143 (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent¹¹;
- 144 (c) granting any licence or other right in or under the patent¹²;
- 145 (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order¹³.

Where the comptroller finds on such a reference that the patent was granted to a person not entitled to be granted that patent, whether alone or with other persons, and on an application for revocation¹⁴ makes an order on the ground for the conditional or unconditional revocation of the patent, the comptroller may order that the person by whom the application was made or his successor in title may make a new application for a patent:

- 146 (i) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent¹⁵; and
- 147 (ii) in the case of conditional revocation, for the matter which in the comptroller's opinion should be excluded from that specification by amendment¹⁶.

Where such a new application is made¹⁷, it is treated as having been filed on the date of filing¹⁸ the application for the patent to which the reference relates¹⁹.

Where a question is so referred to the comptroller, an order may not be made²⁰ on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent, except those who are parties to the reference²¹.

If it appears to the comptroller on such a reference that the question referred to him would more properly be determined by the court²², he may decline to deal with it and, without

prejudice to the court's jurisdiction to determine any such question and make a declaration, the court has jurisdiction to do so²³, subject to certain statutory limitations²⁴.

1 As to grant see PARA 338.

2 As to the meaning of 'invention' see PARA 301 note 2.

3 As to the comptroller see PARA 577.

4 As to who may be granted a patent see PARA 307.

5 As to the meaning of 'right' see PARA 360 note 7.

6 As to the transfer of rights under a patent see PARA 373 et seq.

7 Patents Act 1977 s 37(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 9(1), (2)). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608. Where a co-proprietor of a patent applies, the comptroller has the power to order that licences under the patent be granted: *Hughes v Paxman* [2006] EWCA Civ 818, [2007] RPC 34. As to the application of the Patents Act 1977 s 37 to EU compulsory licences see para 402.

8 Patents Act 1977 s 37(1) (as substituted: see note 7). See *Norris's Patent* [1988] RPC 159. An order under the Patents Act 1977 s 37 must not be so made as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such: s 37(6). For the statutory limitations as to time on the comptroller's jurisdiction see PARA 367.

9 As to registration see PARA 585 et seq.

10 Patents Act 1977 s 37(2)(a). The court cannot make an order pursuant to s 37(2) to a person who has no proprietary interest in the patent; the purpose of s 37(2) is to enable the comptroller to resolve a dispute between those sharing the proprietary interest: *Cinpres Gas Injection Ltd v Melea Ltd* [2006] EWHC 2950 (Ch), [2006] All ER (D) 305 (Nov); revsd [2008] EWCA Civ 9, [2008] All ER (D) 165 (Jan). See also *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693; affd [1999] RPC 442, [1998] All ER (D) 545, CA.

11 Patents Act 1977 s 37(2)(b).

12 Patents Act 1977 s 37(2)(c).

13 Patents Act 1977 s 37(2)(d). If any person to whom such directions have been given fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the comptroller may, on application made to him by any person in whose favour or on whose reference the order containing the directions was made, authorise that person to do that thing on behalf of the person to whom the directions were given: s 37(3).

14 Ie under the Patents Act 1977 s 72: see PARA 565. As to revocation generally see PARA 564 et seq.

15 Patents Act 1977 s 37(4)(a).

16 Patents Act 1977 s 37(4)(b). As to the specification see PARA 319; and as to amendment of the specification see PARA 348.

17 An application for a patent which: (1) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and (2) discloses additional matter, that is matter extending beyond that disclosed in the earlier application, as filed, or the application for the patent, as filed, may be filed under the Patents Act 1977 s 37(4) but may not be allowed to proceed unless it is amended so as to exclude the additional matter: s 76(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 20). As to the disclosure of matter see PARA 352.

18 As to the meaning of 'date of filing' see PARA 316.

19 Patents Act 1977 s 37(4) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 9(1), (3) (a)). A new application for a patent may be filed under the Patents Act 1977 s 37(4) before the end of the relevant period: Patents Rules 2007, SI 2007/3291, r 20(2). The relevant period is: (1) where the comptroller's decision to make an order under that provision is not appealed, three months beginning with the date on which the order was made; or (2) where that decision is appealed, three months beginning with the date on which the appeal was finally disposed of: r 20(3). However, the comptroller may, if he thinks fit, shorten the relevant

period after giving the parties such notice and subject to such conditions as the comptroller may direct: r 20(4). As to appeals see PARAS 639-642.

20 le by virtue of the Patents Act 1977 s 37(2) (see the text to notes 10-13) or under s 37(4) (see the text to notes 18-19).

21 Patents Act 1977 s 37(7) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 9(1), (3) (a)).

22 As to the meaning of 'court' see PARA 637 note 1. As to when the comptroller should decline jurisdiction in favour of the court see *Luxim Corpn v Ceravision Ltd* [2007] EWHC 1624 (Ch), [2007] RPC 797, [2007] All ER (D) 116 (Jul). Where the comptroller so declines to deal with a question, any person seeking the court's determination of that question must issue a claim form within 14 days of the comptroller's decision: CPR 63.11. The presence of allegations of improper conduct or breach of fiduciary duty may lead the comptroller to decline jurisdiction: *Reflex Modulation Ltd v Alteristic Instruments Ltd* BL O/084/08, C-G.

23 Patents Act 1977 s 37(8) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 9(1), (3) (b)). As to procedure see PARA 360.

24 See the Patents Act 1977 s 37(9); and PARA 367.

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367. Disputes two years after grant.

Where a question as to entitlement to a patent is referred to the comptroller¹ or proceedings are commenced invoking the jurisdiction of the court² more than two years after the date of the grant of the patent³:

- 148 (1) the comptroller may not make an order transferring the patent in question⁴ or allowing a new application to be made⁵; and
- 149 (2) the court, in exercise of its declaratory jurisdiction⁶, may not determine the question whether the patent was granted to a person not so entitled,

unless, in either case, it is shown that any person registered⁷ as a proprietor of the patent knew at the time of the grant or transfer of the patent to him, as the case may be, that he was not entitled to the patent⁸.

1 Ie under the Patents Act 1977 s 37(1): see PARA 366. As to the comptroller see PARA 577. As to the effect of the two-year limitation period see *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2007] UKHL 43, [2008] 1 All ER 425, [2008] RPC 1.

2 Ie under the Patents Act 1977 s 37(8): see PARA 366. As to the meaning of 'court' see PARA 637 note 1.

3 As to grant see PARA 338.

4 Ie under the Patents Act 1977 s 37(2): see PARA 366.

5 Ie under the Patents Act 1977 s 37(4): see PARA 366.

6 Ie under the Patents Act 1977 s 37(8): see PARA 366.

7 As to registration see PARA 585 et seq.

8 Patents Act 1977 s 37(5), (9).

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368. Effect on third persons of transfer of patent.

Where an order is made¹ that a patent be transferred from any person or persons (the 'old proprietor or proprietors') to one or more persons, whether or not including an old proprietor, then, subject to the provisions of the order, any licences² or other rights³ granted or created by the old proprietor or proprietors continue in force and are treated as granted by the person or persons to whom the patent is ordered to be transferred (the 'new proprietor or proprietors')⁴.

Where an order is so made that a patent is to be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor, on the ground that the patent was granted to a person not entitled to be granted the patent⁵, any licences or other rights in or under the patent lapse on the registration⁶ of that person or those persons as the new proprietor or proprietors of the patent, subject to the provisions of the order⁷.

Where an order is so made that a patent is to be so transferred or that a person other than an old proprietor may make a new application for a patent, and, before the reference of the question⁸ resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith, worked the invention in question in the United Kingdom⁹ or made effective and serious preparations to do so, the old proprietor or proprietors or the licensee, on making a request to the new proprietor or proprietors or, as the case may be, the new applicant, within the prescribed period¹⁰, is or are entitled to be granted a licence, other than an exclusive licence¹¹, to work or to continue working the invention, as the case may be, so far as it is the subject of the new application¹². Any such licence must be granted for a reasonable period and on reasonable terms¹³. The new proprietor or proprietors of the patent or, as the case may be, the new applicant or any person claiming that he is entitled to be granted any such licence may refer to the comptroller¹⁴ the question whether that person is so entitled and whether any such period is or terms are reasonable¹⁵; and the comptroller must determine the question and may, if he considers it appropriate, order the grant of such a licence¹⁶.

1 Ie under the Patents Act 1977 s 37: see PARA 366.

2 As to licences see PARA 378 et seq.

3 As to the meaning of 'right' see PARA 360 note 7.

4 Patents Act 1977 s 38(1). Section 38 is subject to s 33 (effect of registration on rights in patents: see PARAS 588-589): s 38(1). Without prejudice to any other method of enforcement, any order for the grant of a licence under s 38 has effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order: s 108. As to the application of s 38 to EU compulsory licences see para 402.

5 As to entitlement see PARA 307.

6 As to registration see PARA 585 et seq.

7 Patents Act 1977 s 38(2).

8 Ie under the Patents Act 1977 s 37: see PARA 366.

9 As to the meaning of 'United Kingdom' see PARA 303 note 5.

10 The period prescribed for the purposes of the Patents Act 1977 s 38(3) is two months beginning with the date on which the order mentioned in s 38(2) was made: Patents Rules 2007, SI 2007/3291, r 90(2).

11 As to the meaning of 'exclusive licence' see PARA 380.

12 Patents Act 1977 s 38(3) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 10(1), (2)).

13 Patents Act 1977 s 38(4).

14 As to the comptroller see PARA 577.

15 As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

16 Patents Act 1977 s 38(5) (amended by the Patents Act 2004 Sch 2 paras 1(1), 10(1), (3)).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/369. Rights in employees' inventions.

369. Rights in employees' inventions.

Where the rights in an invention¹ made by an employee² have not been dealt with by agreement³, then, subject to certain conditions as to the place of his employment⁴, and notwithstanding anything in any rule of law⁵, an invention made by an employee is taken, as between him and his employer⁶, to belong to his employer for all purposes⁷ if:

- 150 (1) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties⁸; or
- 151 (2) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking⁹.

Any other invention made by an employee is taken, as between him and his employer, to belong to the employee¹⁰.

Any term in a contract, whenever made, relating to inventions made by an employee, and entered into by him either with the employer (alone or with another)¹¹ or with some other person at the request of the employer or pursuant to the employee's contract of employment¹², which diminishes the employee's rights¹³ in inventions of any description made by him after the date of the contract, or in or under patents¹⁴ for those inventions or applications for such patents, is unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent¹⁵.

Where by virtue of these provisions an invention belongs, as between him and his employer, to an employee, nothing done:

- 152 (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent; or
- 153 (b) by any person for the purpose of performing or working the invention,

is to be taken to infringe any copyright¹⁶ or design right¹⁷ to which, as between him and his employer, his employer is entitled in any model or document relating to the invention¹⁸.

1 As to the meaning of 'invention' see PARA 301 note 2.

2 As to the meaning of 'employee' see PARA 365 note 8. In the Patents Act 1977 ss 39-43, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee: s 43(3).

3 As to the enforceability of contracts relating to employees' inventions see the Patents Act 1977 s 42 (see the text and notes 11-15).

4 The Patents Act 1977 ss 39-42 do not apply to an invention made by an employee unless, at the time he made the invention, one of the following conditions was satisfied in his case, that is to say: (1) he was mainly

employed in the United Kingdom; or (2) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in the United Kingdom to which the employee was attached, whether or not he was also attached elsewhere: s 43(2). As to the meaning of 'United Kingdom' see PARA 303 note 5.

5 Cases decided before the enactment of the Patents Act 1977 are of doubtful guidance: *Liffe Administration and Management v Pinkava* [2007] EWCA Civ 217 at [57], [2007] 4 All ER 981 at [57], [2007] RPC 667 at [57] per Sir Andrew Morritt C.

6 As to the meaning of 'employer' see PARA 365 note 7.

7 le for the purposes of the Patents Act 1977 and all other purposes. Section 39 does not allow an employee to retain a beneficial interest in his invention by way of constructive trust: *French v Mason* [1999] FSR 597, [1998] All ER (D) 486.

8 Patents Act 1977 s 39(1)(a). See *Harris' Patent* [1985] RPC 19. Extra or different duties undertaken are not to be regarded only as duties 'specifically assigned' as it is quite possible for them in the course of time to become 'normal' under the Patents Act 1977 s 39(1): *LIFFE Administration and Management v Pinkava* [2007] EWCA Civ 217, [2007] 4 All ER 981, [2007] RPC 667. See also *Greater Glasgow Health Board's Application* [1996] RPC 207.

9 Patents Act 1977 s 39(1)(b). See *Harris' Patent* [1985] RPC 19.

10 Patents Act 1977 s 39(2).

11 Patents Act 1977 s 42(1)(a).

12 Patents Act 1977 s 42(1)(b).

13 As to the meaning of 'right' see PARA 360 note 7.

14 In the Patents Act 1977 ss 39-42, references to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under the law of the United Kingdom or the law in force in any other country or under any treaty or international convention: s 43(4) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 11(2)). As to treaties and international conventions see PARA 652 et seq.

15 Patents Act 1977 s 42(2). Section 42(2) is not, however, to be construed as derogating from any duty of confidentiality owed by an employee to his employer by virtue of any rule of law or otherwise: s 42(3). As to the duty of confidentiality see **EMPLOYMENT** vol 39 (2009) PARA 55; **CONFIDENCE AND DATA PROTECTION** vol 8(1) (2003 Reissue) PARA 431. Section 42 applies to any arrangement made with a Crown employee by or on behalf of the Crown as his employer as it applies to any contract made between an employee and an employer other than the Crown: s 42(4). For these purposes, 'Crown employee' means a person employed under or for the purposes of a government department or any officer or body exercising on behalf of the Crown functions conferred by any enactment or a person serving in the naval, military or air forces of the Crown: s 42(4) (amended by the Armed Forces Act 1981 s 22(1), (2)).

16 As to copyright see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 54 et seq.

17 As to design right see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 501 et seq.

18 Patents Act 1977 s 39(3) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 11(1)).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/370. Compensation of employees for certain inventions.

370. Compensation of employees for certain inventions.

Where it appears to the court¹ or the comptroller² on an application made by an employee³ within the prescribed period⁴:

- 154 (1) that the employee has made an invention⁵ belonging to the employer⁶ for which a patent has been granted⁷;
- 155 (2) that the invention or the patent for it is, having regard among other things to the size and nature of the employer's undertaking, of outstanding benefit⁸ to the employer; and
- 156 (3) that by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer,

the court or the comptroller may award him compensation⁹.

The court or the comptroller may also award compensation to an employee on such an application where it appears to the court or the comptroller that:

- 157 (a) a patent has been granted for an invention made by and belonging to the employee¹⁰;
- 158 (b) the employee's rights in the invention, or in any patent or application for a patent¹¹ for the invention, have been assigned¹² to the employer or an exclusive licence¹³ under the patent or application has been granted to the employer¹⁴;
- 159 (c) the benefit derived by the employee from the contract of assignment or grant or any ancillary contract (the 'relevant contract') is inadequate in relation to the benefit derived by the employer¹⁵ from the invention or the patent for it or both¹⁶; and
- 160 (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract¹⁷.

If it appears to the comptroller on an application under the above provisions that the application involves matters which would more properly be determined by the court, he may decline to deal with it¹⁸.

The above provisions do not, however, apply to the invention of an employee where a relevant collective agreement¹⁹ provides for the payment of compensation in respect of inventions of the same description as that invention to employees of the same description as that employee²⁰.

1 As to the meaning of 'court' see PARA 637 note 1. An application by an employee for compensation under the Patents Act 1977 s 40(1) or (2) must be made in a claim form and within the prescribed period: CPR 63.12(1). The prescribed period begins on the date of the grant of the patent and ends one year after the patent has ceased to have effect: CPR 63.12(2). Where a patent has ceased to have effect as a result of failure to pay the renewal fees within the prescribed period (see PARA 340) and application for restoration is made to the comptroller under the Patents Act 1977 s 28 (see PARA 356), the prescribed period: (1) if restoration is ordered, continues as if the patent had remained continuously in effect; or (2) if restoration is refused, is treated as expiring one year after the patent ceased to have effect, or six months after the refusal, whichever is the later: CPR 63.12(3).

Where an employee applies for compensation under the Patents Act 1977 s 40(1) or (2), the court must at the case management conference give directions as to: (a) the manner in which the evidence, including any accounts of expenditure and receipts relating to the claim, is to be given at the hearing of the claim and if written evidence is to be given, the period within which witness statements or affidavits must be filed; and (b) the provision to the claimant by the defendant or a person deputed by him, of reasonable facilities for inspecting and taking extracts from the accounts by which the defendant proposes to verify the accounts in head (a) or from which those accounts have been derived: *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 13.1.

In proceedings under the Patents Act 1977 s 40, the court, in determining whether to award costs or expenses to any party and what costs or expenses to award, must have regard to all the relevant circumstances, including the financial position of the parties: s 106(1), (1A)(a) (s 106(1) amended, and s 106(1A) added by the Patents Act 2004 s 14). If in any such proceedings the Patents Court directs that any costs of one party are to be paid by another party, the court may settle the amount of the cost by fixing a lump sum or may direct that the costs are to be taxed on a scale specified by the court, being a scale of costs prescribed by rules of court: Patents Act 1977 s 106(2) (amended by the Constitutional Reform Act 2005 s 59(5), Sch 11 para 23(1), (4) from a day to be appointed).

2 As to the comptroller see PARA 577. As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608. All relevant patents must be identified on the prescribed form: *British Steel plc's Patent* [1992] RPC 117.

3 As to the meaning of 'employee' see PARA 365 note 8.

4 The period prescribed for the purposes of the Patents Act 1977 s 40(1) and (2) is the period beginning with the date of grant of the patent and ending one year after the patent ceased to have effect: Patents Rules 2007, SI 2007/3291, r 91(1). However, if an application for restoration is made under the Patents Act 1977 s 28 (see PARA 356) and: (1) the application is granted, the prescribed period continues as if the patent had remained continuously in effect; or (2) the application is refused, the prescribed period is the period beginning with the date of grant of the patent and ending one year after the patent ceased to have effect or, if it expires later, the period of six months beginning with the date on which the application was refused: Patents Rules 2007, SI 2007/3291, r 91(2). As to the grant and term of patents see PARAS 338-339.

5 As to the making of an invention by an employee see PARA 369 note 2.

6 As to the meaning of 'employer' see PARA 365 note 7. For these purposes, references to an invention belonging to an employer or employee are references to its so belonging as between the employer and the employee: Patents Act 1977 s 40(7). As to when an invention is deemed to belong to an employer see PARA 369.

7 As to references to a patent being granted see PARA 369 note 14.

8 For these purposes, 'benefit' means benefit in money or money's worth: Patents Act 1977 s 43(7). 'Outstanding' means something out of the ordinary and not as such would normally be expected to arise from the results of the duties for which the employee was paid: *GEC Avionics Ltd's Patent* [1992] RPC 107. The onus is on the employee to prove that the patent was of outstanding benefit (*Memco-Med Ltd's Patent* [1992] RPC 403) and that the benefit derived from the patent and not the invention (*Memco-Med Ltd's Patent*).

9 Patents Act 1977 s 40(1) (substituted by the Patents Act 2004 s 10(1), (8)). As to the amount of compensation see PARA 371. For applications for compensation in which the employee did not succeed see *GEC Avionics Ltd's Patent* [1992] RPC 107; *British Steel plc's Patent* [1992] RPC 117; and *Memco-Med Ltd's Patent* [1992] RPC 403.

10 Patents Act 1977 s 40(2)(a). Section 40(2) has effect notwithstanding anything in the relevant contract or any agreement applicable to the invention, other than a relevant collective agreement: s 40(4). As to the meaning of 'relevant collective agreement' see note 19. As to when an invention is deemed to belong to an employee see PARA 369.

11 As to the meaning of 'right' see PARA 360 note 7.

12 As to assignment see PARA 374.

13 As to the meaning of 'exclusive licence' see PARA 380.

14 Patents Act 1977 s 40(2)(b). See also note 10.

15 For these purposes, the benefit derived or expected to be derived by an employer from an invention or patent includes, where he dies before any award is made under the Patents Act 1977 s 40 in respect of the patent, any benefit derived or expected to be derived from it by his personal representatives or by any person in whom it was vested by their assent: s 43(5) (amended by the Patents Act 2004 s 10(6), (8)). The benefit

derived or expected to be derived by an employer from an invention does not include any benefit derived or expected to be derived from the invention after the patent for it has expired or has been surrendered or revoked: Patents Act 1977 s 43(5A) (added by the Patents Act 2004 s 10(7), (8)).

16 Patents Act 1977 s 40(2)(c) (amended by the Patents Act 2004 s 10(2), (8)). See also note 10.

17 Patents Act 1977 s 40(2)(d). See also note 10.

18 Patents Act 1977 s 40(5). Where the comptroller declines to deal with an application under s 40(5), any person seeking the court's determination of that application must issue a claim form within 14 days of the comptroller's decision: CPR 63.11(b).

19 For these purposes, 'relevant collective agreement' means a collective agreement within the meaning of the Trade Union and Labour Relations (Consolidation) Act 1992, made by or on behalf of a trade union to which the employee belongs, and by the employer or an employer's association to which the employer belongs which is in force at the time of the making of the invention: Patents Act 1977 s 40(6) (amended by the Trade Union and Labour Relations (Consolidation) Act 1992 s 300(2), Sch 2 para 9); and see **EMPLOYMENT** vol 41 (2009) PARA 1042.

20 Patents Act 1977 s 40(3).

UPDATE

370 Compensation of employees for certain inventions

NOTE 1--Appointed day is 1 October 2009: SI 2009/1604.

NOTE 8--See also *Kelly v GE Healthcare Ltd* [2009] EWHC 181 (Pat), [2009] IP & T 927.

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371. Award and assessment of compensation.

An award of compensation¹ to an employee² in relation to a patent for an invention³ must be such as will secure for the employee a fair share, having regard to all the circumstances, of the benefit which the employer has derived, or may reasonably be expected to derive⁴, from any of the following: (1) the invention in question; (2) the patent for the invention; (3) the assignment or grant of the property or any right in the invention⁵ or the property in, or any right under, an application for that patent, to a person connected with the employer⁶.

In determining the fair share of the benefit to be secured for an employee in respect of an invention which has always belonged to an employer, the court⁷ or the comptroller⁸ must, among other things, take the following matters into account⁹:

- 161 (a) the nature of the employee's duties, his remuneration and the other advantages he derives or has derived from his employment or has derived¹⁰ in relation to the invention¹¹;
- 162 (b) the effort and skill which the employee has devoted to making the invention¹²;
- 163 (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor¹³ of the invention¹⁴; and
- 164 (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities¹⁵.

In determining the fair share of the benefit to be secured for an employee in respect of an invention which originally belonged to him, the court or the comptroller must, among other things, take the following matters into account¹⁶:

- 165 (i) any conditions in a licence or licences granted in respect of the invention or the patent for it¹⁷;
- 166 (ii) the extent to which the invention was made jointly by the employee with any other person¹⁸; and
- 167 (iii) the contribution made by the employer to the making, developing and working of the invention as mentioned in head (d) above¹⁹.

Any order for payment of compensation may be an order for payment of a lump sum or for a periodical payment, or both²⁰.

Without prejudice to the rule²¹ that a statutory power may in general be exercised from time to time, the refusal of the court or the comptroller to make an order on an application by an employee²² does not prevent a further application being made by him or any successor in title of his²³. Where such an order has been made, the court or the comptroller, as the case may be, on the application of either the employer or employee²⁴, may vary or discharge it, or suspend any provision of it and revive any provision so suspended²⁵.

Where an employee dies before an award is made²⁶ in respect of a patented invention²⁷ made by him, his personal representatives or their successors in title may exercise his right to proceed with an application for compensation²⁸.

1 le an award under the Patents Act 1977 s 40(1), (2): see PARA 370.

2 As to the meaning of 'employee' see PARA 365 note 8.

3 As to the meaning of 'invention' see PARA 301 note 2.

4 As to the meaning of 'benefit derived or expected to be derived by an employer' see PARA 370 note 15; as to the meaning of 'benefit' see PARA 370 note 8; and as to the meaning of 'employer' see PARA 365 note 7.

5 As to employers' rights in an invention see PARA 369.

6 Patents Act 1977 s 41(1) (substituted by the Patents Act 2004 s 10(3), (8)). As to the meaning of 'right' see PARA 360 note 7. As to transactions in patents and applications for patents see PARAS 373-374. For the purposes of the Patents Act 1977 s 41(1), the amount of any benefit derived or expected to be derived by an employer from the assignment or grant of: (1) the property in, or any right in or under, a patent for the invention or an application for such a patent; or (2) the property or any right in the invention, to a person connected with him must be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him: s 41(2). The Income and Corporation Taxes Act 1988 s 839 applies for determining for this purpose whether one person is connected with another as it applies for determining that question for the purposes of the Tax Acts: Patents Act 1977 s 43(8); Income and Corporation Taxes Act 1988 s 844, Sch 30 para 21(3); and see **INCOME TAXATION** vol 23(2) (Reissue) PARA 1258.

Where the Crown or a Research Council in its capacity as employer assigns or grants the property in, or any right in or under, an invention, patent or application for a patent to a body having among its functions that of developing or exploiting inventions resulting from public research and does so for no consideration or only a nominal consideration, any benefit derived from the invention, patent or application by that body is to be treated for the purposes of the Patents Act 1977 s 41(1), (2) as so derived by the Crown or, as the case may be, Research Council: s 41(3). For these purposes, 'Research Council' means a body which is a Research Council for the purposes of the Science and Technology Act 1965 or the Arts and Humanities Research Council (as defined by the Higher Education Act 2004 s 1) (see **NATIONAL CULTURAL HERITAGE** vol 77 (2010) PARA 967 et seq): Patents Act 1977 s 41(3) (amended by the Higher Education Act 2004 s 49, Sch 6 para 5). As to the application of the Patents Act 1977 s 41 to EU compulsory licences see para 402.

7 As to the meaning of 'court' see PARA 637 note 1.

8 As to the comptroller see PARA 577.

9 Patents Act 1977 s 41(4) (amended by the Patents Act 2004 ss 10(4), (8), 16(2), Sch 3).

10 le under the Patents Act 1977.

11 Patents Act 1977 s 41(4)(a).

12 Patents Act 1977 s 41(4)(b). As to the making of an invention by an employee see PARA 369.

13 As to the meaning of 'joint inventor' see PARA 301 note 3.

14 Patents Act 1977 s 41(4)(c).

15 Patents Act 1977 s 41(4)(d).

16 Patents Act 1977 s 41(5) (amended by the Patents Act 2004 ss 10(4), (8), 16(2), Sch 3).

17 Patents Act 1977 s 41(5)(a) (amended by the Patents Act 2004 s 10(5), (8)). As to licences see PARA 378 et seq.

18 Patents Act 1977 s 41(5)(b).

19 Patents Act 1977 s 41(5)(c).

20 Patents Act 1977 s 41(6). Any sums awarded by the comptroller are, if a county court so orders, recoverable by execution issued from the county court or otherwise as if they were payable under an order of that court: s 41(9). As to the issue of execution in the county court see **CIVIL PROCEDURE** vol 12 (2009) PARA 1283

et seq; **COURTS** vol 10 (Reissue) PARA 711. As from a day to be appointed, any sums may be recoverable under the County Courts Act 1984 s 85; see the Patents Act 1977 s 41(9) (prospectively amended by the Tribunals, Courts and Enforcement Act 2007 s 62(3), Sch 13 paras 39, 40).

21 le the Interpretation Act 1978 s 12: see **STATUTES** vol 44(1) (Reissue) PARA 1343.

22 le an application under the Patents Act 1977 s 40: see PARA 370.

23 Patents Act 1977 s 41(7); Interpretation Act 1978 ss 17(2)(a), 25(2). As to devolution of rights in respect of patents see PARA 373.

24 As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

25 Patents Act 1977 s 41(8). Section 40(5) (see PARA 370) applies to the application as it applies to an application under s 40 (see PARA 370): s 41(8).

26 le under the Patents Act 1977 s 40 (see PARA 370).

27 'Patented invention' means an invention for which a patent is granted; and 'patented process' is to be construed accordingly: Patents Act 1977 s 130(1).

28 Patents Act 1977 s 43(6).

UPDATE

371 Award and assessment of compensation

NOTE 6--The words 'that person' in the 1977 Act s 41(2) refer to a notional non-connected counterparty operating in the appropriate market at the appropriate time: *Shanks v Unilever plc* [2009] EWHC 3164 (Ch), [2009] All ER (D) 44.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/372. Rights of co-owners.

372. Rights of co-owners.

Where a patent is granted¹ to two or more persons, then, subject to any agreement to the contrary, each of them is entitled to an equal undivided share in the patent², and each of them is entitled, by himself or his agents, to do in respect of the invention³ concerned, for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the patent concerned⁴. However, except under a direction from the comptroller⁵ and subject to any agreement for the time being in force, where two or more persons are proprietors of a patent, none of them may amend the specification of the patent⁶ or apply for such an amendment to be allowed or for the patent to be revoked⁷ or grant a licence under the patent⁸, or assign or mortgage a share in the patent⁹ without the consent of the other or others¹⁰.

Where a patented product¹¹ is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him are entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor¹². One of two or more co-proprietors may not form a company to work the patent, or otherwise allow manufacture by an independent contractor, without the consent of the others¹³, but a purchaser of a patented article from one proprietor is not concerned with the arrangements for manufacture¹⁴. Subject to any directions by the comptroller¹⁵, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect; and such a supply of those means does not amount to an infringement of the patent¹⁶.

The above provisions also have effect in relation to an application for a patent¹⁷.

1 As to grant see PARA 338.

2 Patents Act 1977 s 36(1). See *Young v Wilson* (1955) 72 RPC 351 (right to exploit without accounting may be ousted by agreement).

3 As to the meaning of 'invention' see PARA 301 note 2.

4 Patents Act 1977 s 36(2)(a). Any such act does not amount to an infringement of the patent: s 36(2)(b). As to proceedings for infringement see PARA 521 et seq. However, nothing in s 36(1), (2) affects the mutual rights or obligations of trustees or personal representatives of a deceased person or their rights and obligation as such: s 36(6).

5 ie under the Patents Act 1977 s 8 (see PARA 362), s 12 (see PARA 364) and s 37 (see PARA 366). As to the comptroller see PARA 577.

6 As to amendment see PARA 348 et seq.

7 As to revocation see PARA 564 et seq.

8 As to licences see PARA 378 et seq.

9 As to transactions in rights in patents see PARA 373 et seq.

10 Patents Act 1977 s 36(3) (amended by the Patents Act 2004 s 9).

11 For these purposes, 'patented product' means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been

applied: Patents Act 1977 s 130(1). As to the meanings of 'patented invention' and 'patented process' see PARA 371 note 27.

12 Patents Act 1977 s 36(5). As to registration see PARA 585 et seq.

13 As to the distinction between working by an agent and by an independent contractor see *Howard and Bullough Ltd v Tweedales and Smalley* (1895) 12 RPC 519; *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693 (affd [1999] RPC 442, [1998] All ER (D) 545, CA).

14 See the Patents Act 1977 s 36(5); and PARA 506.

15 See note 5.

16 Patents Act 1977 s 36(4).

17 Patents Act 1977 s 36(7). References to a patent and a patent being granted accordingly include references respectively to any such application and to the application being filed (s 36(7)(a)); and the reference in s 36(5) (see the text to notes 11-12) to a patented product is to be construed accordingly (s 36(7)(b)). As to the application see PARA 315.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(1) OWNERSHIP/373. Devolution.

373. Devolution.

Any patent or application for a patent¹ is personal property, without being a thing in action², and, subject to certain statutory provisions³, any patent or any application for a patent vests by operation of law in the same way as any other personal property⁴. A patent cannot, however, be taken in execution or reached by a judgment creditor otherwise than by bankruptcy⁵.

Where the legal owner of a patent is a corporation which ceases to exist, for example by dissolution of a company, an order vesting the patent in the beneficial owner can be obtained⁶. Where the beneficial owner dies intestate, the patent belongs, in default of any other beneficiary taking all absolute interest, to the Crown⁷ as bona vacantia and does not disappear by merger⁸.

A person who becomes entitled to a patent or an interest in a patent by transmission or operation of law, may, but need not, register his title in the register of patents⁹.

1 As to the application see PARA 315.

2 Patents Act 1977 s 30(1). See **PERSONAL PROPERTY** vol 35 (Reissue) PARA 1204.

3 The Patents Act 1977 s 30(2)-(4) has effect subject to the subsequent provisions of the Patents Act 1977: s 30(5).

4 Patents Act 1977 s 30(3). A patent or application for a patent or right in it may be vested by an assent of personal representatives (s 30(3)), but any such assent is void unless it is in writing and is signed by or on behalf of the personal representative (s 30(6)(b)). As to the meaning of 'right' see PARA 360 note 7. As to the rights of the representatives where the inventor dies before the patent is granted see PARA 307; as to devolution on death intestate see **EXECUTORS AND ADMINISTRATORS** vol 17(2) (Reissue) PARA 583 et seq; and as to transmission on bankruptcy see *Hesse v Stevenson* (1803) 3 Bos & P 565; *M'Alpine v Mangnall* (1846) 3 CB 496, Ex Ch; and **BANKRUPTCY AND INDIVIDUAL INSOLVENCY** vol 3(2) (2002 Reissue) PARA 425. Patents granted after the bankruptcy adjudication and before discharge vest in the trustee in bankruptcy: *Hesse v Stevenson*. Acquisition of title by virtue of a series of mergers and demergers under foreign law may amount to devolution by operation of law: *Tamglass Ltd OY v Luoyang Glass Technology Co Ltd* [2006] EWHC 445 (Ch), [2006] All ER (D) 201 (Feb); *Siemens Schweiz AG v Thorn Security Ltd* [2007] EWHC 2242 (Ch), [2008] RPC 58, [2007] All ER (D) 61 (Oct).

5 *British Mutoscope and Biograph Co Ltd v Homer* [1901] 1 Ch 671, 18 RPC 177; *Edwards & Co v Picard* [1909] 2 KB 903, CA. In *A-G v Lord Oswald* (1848) 10 Dunl (Ct of Sess) 969, the statement in Bell's Commentaries that a patent is unattachable by any diligence but adjudication was approved.

6 See *Re Dutton's Patents* (1923) 67 Sol Jo 403, 40 RPC 84.

7 Or to the Duchy of Lancaster or the Duke of Cornwall for the time being, as the case may be: Administration of Estates Act 1925 s 46(1)(vi).

8 See *Re Dutton's Patents* (1923) 67 Sol Jo 403, 40 RPC 84; the Administration of Estates Act 1925 s 46(1)(vi); and **EXECUTORS AND ADMINISTRATORS** vol 17(2) (Reissue) PARA 613.

9 See the Patents Act 1977 ss 32-34; PARA 585 et seq; and *Re Casey's Patents, Stewart v Casey* [1892] 1 Ch 104, CA. Devolution by operation of law is not an assignment and is not a registrable transaction: *Tamglass Ltd OY v Luoyang Glass Technology Co Ltd* [2006] EWHC 445 (Ch), [2006] All ER (D) 201 (Feb); *Siemens Schweiz AG v Thorn Security Ltd* [2007] EWHC 2242 (Ch), [2008] RPC 58, [2007] All ER (D) 61 (Oct).

UPDATE

373 Devolution

NOTES 4, 9--*Tamglass*, cited, overruled, *Siemens*, cited, reversed: [2008] EWCA Civ 1161, [2009] IP & T 527 (Patents Act 1977 s 33 wide enough to include an assignment by operation of law, such as by way of corporate merger).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(2) ASSIGNMENT/374. In general.

(2) ASSIGNMENT

374. In general.

Any patent or application for a patent¹ or any right² in such a patent or application may be assigned or mortgaged³. An assignment or mortgage⁴ is, however, void unless it is in writing and signed by or on behalf of the assignor or mortgagor or, in the case of a body corporate, is so signed or is under the seal of that body⁵. An assignment of a patent or any such application or a share⁶ in it may confer on the assignee the right to bring proceedings for previous infringements⁷ or previous Crown use⁸. The assignee or mortgagee of a patent may, but need not, register his title or mortgage in the register of patents⁹.

1 As to the application see PARA 315.

2 As to the meaning of 'right' see PARA 360 note 7.

3 Patents Act 1977 s 30(2). Where there are two or more co-proprietors of a patent, any assignment or mortgage is subject to the consent of all of them: see ss 30(2), 36(3); and PARA 372. Future rights in respect of a patent are included in an assignment of the interest in a patent: *Buchanan v Alba Diagnostics Ltd* [2004] UKHL 5, [2004] RPC 681.

4 'Mortgage', when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, is to be construed accordingly: Patents Act 1977 s 130(1).

5 Patents Act 1977 s 30(6)(a), (6A) (s 30(6)(a) amended, and s 30(6A) added, by SI 2004/2357). In all cases of partial assignment it should be clearly stated who is to pay renewal fees. As to renewal fees see PARA 340. An assignment of the right to apply for a patent must also be in writing signed by the assignor (*Xtralite (Rooflights) Ltd v Hartington Conway Ltd* [2004] RPC 137, C-G) but an estoppel could bind the true owner despite the lack of writing (*Xtralite (Rooflights) Ltd v Hartington Conway Ltd* [2003] EWHC 1872 (Ch), [2004] RPC 161, [2003] All ER (D) 555 (Jul)).

6 As to shares in patents see PARA 360 note 7.

7 ie proceedings under the Patents Act 1977 s 61 or s 69: see PARAS 523, 545, 548, 549, 555.

8 Patents Act 1977 s 30(7). As to such Crown use see s 58; and PARA 410.

9 As to registration see PARA 585 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(2) ASSIGNMENT/375. Covenants.

375. Covenants.

There is no implied covenant for validity¹ when a patent² is assigned³, but an assignor is estopped from denying validity as against his assignee⁴. An assignor may, however, exclude liability in respect of his right to assign the patent⁵.

A covenant to pay a sum out of the profits derived from the use of the invention or by way of royalty runs with the patent and is binding on a legal assignee of the patent with notice of the covenant⁶. A charge may also arise in favour of a solicitor who has successfully defended a claim for revocation⁷. Charges on patents belonging to limited companies must be registered⁸.

1 As to validity of a patent see PARA 426 et seq.

2 The following principles were established in respect of assignments under previous legislation (see PARA 302) but continue to apply to assignments of patents under the Patents Act 1977. As to assignment generally see PARA 374.

3 *Hall v Conder* (1857) 26 LJCP 138, 288, Ex Ch; *Smith v Neale* (1857) 26 LJCP 143. The same rule applies to agreements to assign: *Hall v Conder*, *Smith v Buckingham* (1870) 18 WR 314; *Liardet v Hammond Electric Light and Power Co* (1883) 31 WR 710.

4 *Walton v Lavater* (1860) 8 CBNS 162. An assignor is not, however, so estopped as against the assignee of his trustee in bankruptcy: *Smith v Cropper* (1885) 10 App Cas 249, 2 RPC 17, HL. Where there is an express covenant as to validity in an agreement, or an undertaking to execute an assignment containing such a covenant, the purchaser is entitled to set up the invalidity of the patents, or some of them, as a defence to an action on the agreement: see *Hazlehurst v Rylands* (1890) 9 RPC 1, CA; *Nadel v Martin* (1903) 20 RPC 721, CA (affd (1905) 23 RPC 41, HL); *Berchem v Wren* (1904) 21 RPC 683. A statement that the assignor is the original inventor does not amount to a warranty of validity: *Thompson v Jefferson* (1928) 45 RPC 309, PC. This is, however, subject to the provisions relating to anti-competitive practices: see **COMPETITION** vol 18 (2009) PARAS 3, 115 et seq.

5 See the Unfair Contract Terms Act 1977 ss 1(2), 3, Sch 1 para 1(c); and **CONTRACT** vol 9(1) (Reissue) PARA 828.

6 *Werderman v Société Générale d'Electricité* (1881) 19 ChD 246, CA, followed in *Dansk Rekyllriffel Syndikat Akt v Snell* [1908] 2 Ch 127, 25 RPC 421, and explained in *Bagot Pneumatic Tyre Co v Clipper Pneumatic Tyre Co* [1902] 1 Ch 146, 19 RPC 69, CA (where it was held that equitable assignees are not so bound).

7 See *Re Brown's Patent* (1915) 32 RPC 491. As to proceedings for revocation see PARA 564 et seq. The charge extends to the interests of the parties who have not appeared: *Re Brown's Patent*. See **LEGAL PROFESSIONS** vol 66 (2009) PARA 996 et seq.

8 See the Companies Act 1985 s 396(1)(j) (amended by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 31(1), (2)); and **COMPANIES** vol 15 (2009) PARA 1279. As from a day to be appointed, the Companies Act 1985 s 396(1)(j) is repealed by the Companies Act 2006 s 1295, Sch 16, and replaced by ss 860(1), (7)(i), 861(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(2) ASSIGNMENT/376. Agreements for sale.

376. Agreements for sale.

Agreements as to the sale of a patent¹, or any interest in a patent, need not be in writing², and may be enforced in the ordinary way by an order for specific performance³ or, in the case of an agreement for sale made before grant of the patent⁴, by applying to the comptroller⁵ for a direction that the application proceed in the name of the purchaser⁶. The consideration paid upon a sale of patent rights⁷ is, in many cases, liable to income tax⁸.

1 The following principles were established in respect of assignments under previous legislation (see PARA 302) but continue to apply to assignments of patents under the Patents Act 1977. As to assignment generally see PARA 374.

2 See *Smith v Neale* (1857) 26 LJCP 143, although this particular point was not dealt with in the argument. As to covenants for validity in such agreements see PARA 375 text and note 4.

3 See *Bewley v Hancock* (1856) 6 De GM & G 391; *Printing and Numerical Registering Co v Sampson* (1875) LR 19 Eq 462; *Liardet v Hammond Electric Light and Power Co* (1883) 31 WR 710; *Re Casey's Patent, Stewart v Casey* [1892] 1 Ch 104, 9 RPC 9, CA; *Coflexip Stena Offshore Ltd's Patent* [1997] RPC 179 at 188. Equitable rights can be enforced as to foreign patents: see *Worthington Pumping Engine Co v Moore* (1902) 20 RPC 41; *Richmond & Co Ltd v Wrightson* (1904) 22 RPC 25. See also **SPECIFIC PERFORMANCE** vol 44(1) (Reissue) PARA 830.

4 As to grant see PARA 338.

5 As to the comptroller see PARA 577.

6 See the Patents Act 1977 s 8; and PARAS 361-362. See also *Coflexip Stena Offshore Ltd's Patent* [1997] RPC 179.

7 As to the meaning of 'right' see PARA 360 note 7.

8 See the Income and Corporation Taxes Act 1988 s 524; and **INCOME TAXATION** vol 23(2) (Reissue) PARAS 1487-1488. As to the taxation of patent royalties generally see **INCOME TAXATION** vol 23(2) (Reissue) PARAS 1484-1486.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/4. OWNERSHIP, DEVOLUTION AND ASSIGNMENT/(2) ASSIGNMENT/377. Agreements to assign future patents.

377. Agreements to assign future patents.

In general, an agreement to assign patents¹ for future inventions either generally or for particular subjects is not necessarily contrary to public policy and may be upheld². The commonest form of such agreement relates to improvements relating to named inventions, although somewhat broader terms are often used³. Such an agreement made between an employee⁴ and his employer⁵ is, however, unenforceable⁶. Further, under the EU rules relating to competition⁷, an obligation of a licensee under a patent licence to assign to the licensor any patents granted for improvements made by the licensee may be void⁸.

1 The following principles were established in respect of assignments under previous legislation (see PARA 302) but continue to apply to assignments of patents under the Patents Act 1977. As to assignment generally see PARA 374.

2 *Bewley v Hancock* (1856) 6 De GM & G 391; *Printing and Numerical Registering Co v Sampson* (1875) LR 19 Eq 462. In *Sadgrove v Godfrey* (1919) 37 RPC 7, one of the agreements sued on contained a provision that one of the parties should not invent machines of a named class, but the question as to whether such a provision was void was not decided.

3 The question of what is an 'improvement' has been discussed in a number of cases: see *Wilson v Barbour* (1888) 5 RPC 675, CA; *Valveless Gas Engine Syndicate Ltd v Day* (1898) 16 RPC 97, CA; *Davies v Davies Patent Boiler Ltd* (1908) 25 RPC 823; *Hopkins v Linotype and Machinery Ltd* (1910) 101 LT 898, 27 RPC 109, HL; *Osrarn-Robertson Lamp Works Ltd v Public Trustee* (1920) 37 RPC 189; *Vislok Ltd v Peters* (1927) 44 RPC 235. In *Davies v Curtis and Harvey Ltd* (1903) 20 RPC 561, CA, Romer LJ suggested that an 'improvement' must be something coming within the claim of the original patent, but there are certainly cases in which a wider interpretation has been attached to the term. But 'improvement' is not a term of art and could have wider or narrower meanings according to the context: *Buchanan v Alba Diagnostics Ltd* [2004] UKHL 5, [2004] RPC 681, 2004 SLT 255. Where the covenant extends to patents 'of which the assignor may become possessed', it includes patents which he may acquire by purchase (*Printing and Numerical Registering Co v Sampson* (1875) LR 19 Eq 462), but not those in which he merely acquires an equitable interest together with other persons (*Pneumatic Tyre Co Ltd v Dunlop* (1896) 12 TLR 620, 13 RPC 553, CA).

4 As to the meaning of 'employee' see PARA 365 note 8.

5 As to the meaning of 'employer' see PARA 365 note 7.

6 See the Patents Act 1977 s 42(2); and PARA 369.

7 See the Treaty establishing the European Economic Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) ('EC Treaty') art 81 (formerly art 85 and renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ); and **COMPETITION** vol 18 (2009) PARA 61 et seq.

8 *Re the Agreement of A Raymond & Co* [1972] CMLR D45, EC Commission; *Re the Agreement between Kabel-und Metallwerke Neumeyer AG and Les Etablissements Luchaire SA* [1975] 2 CMLR D40, EC Commission. As to block exemptions for certain categories of patent licensing agreements see EC Commission Regulation 2349/84 (OJ L219, 16.8.84, p 15); EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2); and **COMPETITION** vol 18 (2009) PARA 61 et seq. But an assignment of future improvements was held not to be an unreasonable restraint of trade at common law: *Buchanan v Alba Diagnostics Ltd* [2004] UKHL 5, [2004] RPC 681, 2004 SLT 255.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(1) LICENCES BY AGREEMENT/378. Power to license.

5. LICENCES AND CROWN USE

(1) LICENCES BY AGREEMENT

378. Power to license.

Subject to the rights of co-owners¹, a licence may be granted under any patent or application² for a patent for working the invention³ which is the subject of the patent or application⁴. To the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged⁵. Any such licence or sub-licence vests by operation of law in the same way as any other personal property⁶ and may be vested by an assent of personal representatives⁷. Notice of the grant of the licence may be entered on the register of patents⁸, and a licence duly granted and registered is binding on the successors in title of the proprietor of the patent who granted it. Equally, if the covenants contained in the licence agreement⁹ are assignable¹⁰, the assignee may enforce them against the licensee¹¹.

1 le subject to the Patents Act 1977 s 36(3): see PARA 372.

2 As to the application see PARA 315.

3 As to the meaning of 'invention' see PARA 301 note 2.

4 Patents Act 1977 s 30(4). A licensee may call upon the legal owner to perform all acts contracted for in the licence: *Frentzell v Dougill* (1904) 21 RPC 641. As to the effect of licences against the Crown and government departments see PARA 404.

5 Patents Act 1977 s 30(4)(a). See also PARA 382.

6 As to personal property generally see **PERSONAL PROPERTY** vol 35 (Reissue) PARA 1201 et seq.

7 Patents Act 1977 s 30(4)(b). Any such assent is void unless it is in writing and signed by or on behalf of the personal representative: see s 30(6)(b) (amended by SI 2004/2357).

8 As to the register see PARA 585. As to the effect of registration or notice of rights in patents see the Patents Act 1977 s 33; and PARA 589.

9 As to covenants see PARA 387.

10 As to assignment see the text to note 5; and PARA 382.

11 *National Carbonising Co Ltd v British Coal Distillation Ltd* [1936] 2 All ER 1012, (1937) 54 RPC 41, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(1) LICENCES BY AGREEMENT/379. Form of licence.

379. Form of licence.

No special form or words is or are required for the grant of a licence¹ under a patent, and licences under hand, parol licences², implied licences³ and licences by estoppel⁴ are well recognised. A licence need not be in writing for notice of it to be registered⁵.

The forms of licence agreements are well established⁶. An agreement to grant a licence, if the parties act on it, is treated in equity as a licence⁷. An agreement to renew a licence on the same terms as originally applied to it is presumed where a licensee continues to manufacture and pay royalties after the expiration of his licence⁸; and an agreement for a licence is presumed where user of an invention has been permitted during negotiations for a licence⁹. A parol licence, in order to be enforceable, must be certain in its terms¹⁰.

1 As to the power to license see PARA 378. An assignment of an existing licence is, however, void unless it is in writing and signed by or on behalf of the parties to the assignment, or, in the case of a body corporate, it is so signed or is under the seal of that body: Patents Act 1977 s 30(6)(a) (6A) (s 30(6)(a) amended, s 30(6A) added, by SI 2004/2357).

2 *Chanter v Dewhurst* (1844) 13 LJ Ex 198; *Chanter v Johnson* (1845) 14 LJ Ex 289; *Crossley v Dixon* (1863) 10 HL Cas 293.

3 Eg the implied licence given to purchasers from the patentee or from a licensee who has power to sell: see PARA 385.

4 *Kenny's Patent Button-Holeing Co Ltd v Somervell and Lutwyche* (1878) 38 LT 878; *Lawson v Macpherson & Co* (1897) 14 RPC 696; *Badische Anilin und Soda Fabrik v Isler* [1906] 1 Ch 605, 23 RPC 173 (affd [1906] 2 Ch 443, 23 RPC 633, CA).

5 Any transaction, instrument or event affecting rights in or under a patent may be registered: Patents Act 1977 s 32(2)(b) (substituted by the Patents, Designs and Marks Act 1986 s 1, Sch 1 para 4); and see PARAS 585-586. As to the overriding of unregistered licence rights see the Patents Act 1977 s 33(1); and PARA 589.

6 An agreement that, subject to certain specified matters, a licence was to be in 'the normal terms of a patent licence' was treated by the court as enforceable in *Miles-Martin Pen Co Ltd and Martin v Selsdon Fountain Pen Co Ltd* (1950) 67 RPC 64, CA.

7 Cf *Ward v Livesey* (1887) 5 RPC 102; *Postcard Automatic Supply Co v Samuel* (1889) 6 RPC 560; but see *Henderson v Shiels* (1906) 24 RPC 108.

8 *Warwick v Hooper* (1850) 3 Mac & G 60; *Goucher v Clayton* (1865) 13 LT 115. As to royalties see PARA 389.

9 *Tweeddale v Howard and Bullough Ltd* (1896) 13 RPC 522. In some cases the proposed licensee may be in a position to elect whether or not he will be treated as a licensee: *Postcard Automatic Supply Co v Samuel* (1889) 6 RPC 560. Where the negotiations for a licence fell through, damages were refused for acts done with the patentee's knowledge during such negotiations: *Coslett Anti-Rust Syndicate Ltd v Lennox* (1912) 29 RPC 477. The licence may preclude the proprietor of the patent from suing for infringement prior to the licence: *Campbell v G Hopkins & Sons (Clerkenwell) Ltd* (1931) 49 RPC 38.

10 An oral agreement to grant a licence at royalties to be fixed by arbitration was upheld, and in default of arbitration royalties were fixed by the official referee: see *Fleming v JS Doig (Grimsby) Ltd* (1921) 38 RPC 57; *Mellor v William Beardmore & Co Ltd* (1926) 43 RPC 361 (varied (1927) 44 RPC 175); *Brake v Radermacher* (1903) 20 RPC 631.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(1) LICENCES BY AGREEMENT/380. Limits of licence.

380. Limits of licence.

A licence granted under a patent¹ may be limited as to persons², time, place³, manufacture, use or sale⁴. If the licence is limited, proceedings for infringement of the patent will lie against the licensee for acts done outside the ambit of the licence⁵. A sole licence is one by which the proprietor of the patent agrees to grant no other licence for the technical field concerned within the licensed district during the currency of the licence, and, if the proprietor also agrees that he will not himself exercise the invention in that technical field either generally or within the particular district, the licence is termed an 'exclusive licence'⁶. For the purposes of the Patents Act 1977, 'exclusive licence' means a licence from the proprietor of or applicant for a patent conferring on the licensee, or on him and persons authorised by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application relates⁷.

1 As to the power to license see PARA 378.

2 A licence is in general personal in the absence of express terms: *British Mutoscope and Biograph Co Ltd v Homer* [1901] 1 Ch 671, 18 RPC 177; *National Carbonising Co Ltd v British Coal Distillation Ltd* [1936] 2 All ER 1012, (1937) 54 RPC 41, CA; and see PARA 382 note 3.

3 See PARA 382. For an action for infringement outside the licensed area see *Fuel Economy Co Ltd v Murray* [1930] 2 Ch 93, 47 RPC 346, CA.

4 See PARA 382.

5 *Fuel Economy Co Ltd v Murray* [1930] 2 Ch 93, 47 RPC 346, CA. As to proceedings for infringement see PARA 521 et seq.

6 *Rapid Steel Co v Blankstone* (1907) 24 RPC 529.

7 Patents Act 1977 s 130(1). 'Exclusive licensee' and 'non-exclusive licence' are to be construed accordingly: s 130(1). A licence to be the exclusive manufacturer for the licensor is not an exclusive licence of a right 'in respect of the invention to which the patent relates' but is merely a contractual restriction: *Bondax Carpets Ltd v Advance Carpet Tiles* [1993] FSR 162. See also *Dendron GmbH v University of California (No 3)* [2004] EWHC 1163 (Ch), [2004] FSR 861 (exclusive licensee's authority to grant exclusive sub-licence challenged).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(1) LICENCES BY AGREEMENT/381. Distinction between licence and assignment.

381. Distinction between licence and assignment.

There is a fundamental distinction between a licence granted under a patent¹ and an assignment of the patent². An assignee stands in the place of the proprietor of the patent and derives his rights from the grant of the patent, whereas a licensee, although having a proprietary interest in the patent³, derives his title from the proprietor by a permission which permits him to do acts which would otherwise be prohibited and which confers upon him no rights as against the general public⁴. An exclusive licensee⁵ is, however, in a somewhat different position from other licensees; he may sue for infringement within the field of his exclusive licence in his own name⁶, and by the terms of his licence may acquire substantially the whole of the rights in the patent⁷.

1 As to the power to license see PARA 378.

2 As to assignments of patents see PARA 374 et seq; and as to assignments of licences see PARA 382.

3 *British Nylon Spinners Ltd v Imperial Chemical Industries Ltd* [1953] Ch 19, [1952] 2 All ER 780, 69 RPC 288, CA.

4 See eg *Gillette Safety Razor Co Ltd v AW Gamage Ltd* (1908) 25 RPC 492; revsd 25 RPC 782, CA.

5 As to the meaning of 'exclusive licensee' see PARA 380 text and note 7.

6 As to proceedings for infringement see PARA 521 et seq. As to the meaning of 'exclusive licence' see PARA 380.

7 As to the meaning of 'right' see PARA 360 note 7. An exclusive licensee may also in some cases be treated for tax purposes as having acquired the whole: see the Income and Corporation Taxes Act 1988 s 533(3); and **INCOME TAXATION** vol 23(2) (Reissue) PARA 1487.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(1) LICENCES BY AGREEMENT/382. Assignment of licence.

382. Assignment of licence.

A licence granted under a patent¹ may be assigned² to the extent that the licence so provides³. The licensee may exercise his powers by himself, his servants or his agents, although not by an independent contractor⁴. If a licence is assignable⁵, it may be assigned to a person with a business more extensive than that of the original licensee⁶.

1 As to the power to license see PARA 378.

2 An assignment of a licence probably needs to be in writing and signed by the assignor: see the Patents Act 1977 s 30(6)(a); and PARA 374 text to note 5.

3 Patents Act 1977 s 30(4)(a); and see PARA 378 text to note 5. Even where a licence is not assignable, if the proprietor of the patent accepts royalties from the assignee of the licence, he is estopped from disputing the assignment: *Lawson v Macpherson & Co* (1897) 14 RPC 696. As to royalties see PARA 389.

4 *Dixon v The London Small Arms Co Ltd* (1876) 1 App Cas 632, HL; *Allen & Hanburys Ltd's (Salbutamol) Patent* [1987] RPC 327 at 380, CA, per Dillon LJ. See also *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693. As to what is and is not manufacture by a licensee see *Dunlop Pneumatic Tyre Co Ltd v Holborn Tyre Co Ltd* (1901) 18 RPC 222; *Dunlop Pneumatic Co Ltd v Cresswell Cheshire Rubber Co* (1901) 18 RPC 473; *Dunlop Pneumatic Tyre Co Ltd v North British Rubber Co Ltd* (1904) 21 RPC 161, CA. See also PARA 372 note 13.

5 A licence to A and his assigns was held by Maule J in *Bower v Hodges* (1853) 22 LJCP 194 to imply a power to sub-license, but this decision, it is submitted, is not of general application. Cf the Patents Act 1977 s 30(4)(a); and PARA 378 text to note 5. As to whether the benefit of a sub-licence is assigned with the head licence see *Massman v Massman and Custodian of Enemy Property* (1944) 61 RPC 12, CA.

6 *Bown v Humber & Co Ltd* (1889) 6 RPC 9 (assignee entitled to use the licence both at premises used by assignor and at assignee's other premises).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(1) LICENCES BY AGREEMENT/383. Agreements for licence.

383. Agreements for licence.

Specific performance may be granted of agreements for the grant of licences under patents¹. The ordinary rules as to the invalidity of an instrument obtained by fraud or executed by both parties under a mutual mistake apply to licences².

¹ *Brake v Radermacher* (1903) 20 RPC 631; *British Nylon Spinners Ltd v Imperial Chemical Industries Ltd* [1953] Ch 19, [1952] 2 All ER 780, 69 RPC 288, CA. As to the power to license see PARA 378.

² *McDougall Bros v Partington* (1890) 7 RPC 216; *Ashworth v Law* (1890) 7 RPC 231; *Edison-Bell Consolidated Phonograph Co Ltd v Rosenberg and Scott* (1899) 16 RPC 608; *Cambridge Antibody Technology v Abbott Biotechnology Ltd* [2004] EWHC 2974 (Pat), [2005] FSR 590, [2004] All ER (D) 323 (Dec); *QR Sciences Ltd v BTG International Ltd* [2005] EWHC 670 (Ch), [2005] FSR 909, [2005] All ER (D) 196 (Apr). This does not apply, however, to a mutual mistake as to the validity of the patent: cf *Taylor v Hare* (1805) 1 Bos & PNR 260.

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384. Construction of licence.

Generally, a licence granted under a patent¹ to manufacture implies a licence to use², and a licence to vend gives the right to license purchasers to use, or sell again, the article purchased³. A licence merely to 'use and exercise' may also from its general terms be extended so as to authorise manufacture and sale⁴, or import for subsequent sale and distribution⁵. A personal licence to use certain goods, the property of the licensor, does not, however, give the power to license others to use them⁶. If a licence only permits the making of an article of a particular kind, proceedings for infringement will lie against the licensee for making articles within the patent and not within the licence⁷. If a licence is in respect of any chemical compound 'invented' at the date of the licence, it does not cover compounds which at that date had not been made and tested, but which were known only by their chemical formulae⁸.

1 As to the power to license see PARA 378.

2 See, however, *Basset v Graydon* (1897) 14 RPC 701, HL; *Huntoon Co v Kolynos (Inc)* [1930] 1 Ch 528, 47 RPC 403, CA.

3 *Thomas v Hunt* (1864) 17 CBNS 183; *National Phonograph Co of Australia Ltd v Menck* [1911] AC 336, 28 RPC 229, PC. A licence to vend does not, however, necessarily give the right to limit the licence so given to purchasers: see PARA 385.

4 *Dunlop Pneumatic Tyre Co Ltd v North British Rubber Co Ltd* (1904) 21 RPC 161, CA.

5 See *Pfizer Corp v Ministry of Health* [1965] AC 512, [1965] 1 All ER 450, [1965] RPC 261, HL.

6 *British Mutoscope and Biograph Co Ltd v Homer* [1901] 1 Ch 671, 18 RPC 177.

7 *SA pour la Fabrication d'Appareils d'Eclairage v Midland Lighting Co* (1897) 14 RPC 419; *Dunlop Pneumatic Tyre Co Ltd v Buckingham and Adams Cycle and Motor Co Ltd* (1901) 18 RPC 423, CA. As to proceedings for infringement see PARA 521 et seq.

8 *Beecham Group Ltd v Bristol Laboratories International SA* [1978] RPC 521, HL.

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385. Implied and limited licences.

An article sold by the proprietor of a patent¹ or his licensee², or by one of the co-proprietors³, is presumed to be free of patent claims, giving the purchaser the right to use it as if there were no patent⁴. Under English national law, however, if at the time of sale⁵ the purchaser has notice of some restriction⁶, imposed by the proprietor or those representing him, that restriction will bind the purchaser⁷, although the court will not presume that the purchaser knew of the restriction merely because notice of it was marked upon the article, if the marking was not such as to be apparent under ordinary conditions to a customer at the time of the sale⁸. Furthermore, if there is knowledge of the restriction, there need not be knowledge of the extent of the restriction⁹. Attempts to impose such a restriction will, however, contravene European law if the restriction would affect trade between member states, as in almost every such case it would¹⁰. If a limitation of licence is lawful, the position is the same whether the article is purchased direct from the proprietor of the patent, from a vendor expressly licensed to sell it, or from some other person into whose hands it has later fallen¹¹; and a purchaser without notice of limitations will acquire a full licence, although not even the original manufacturer of the article had power to grant a full licence¹².

In the absence of express terms to the contrary, the licence obtained by a purchaser from the proprietor of the patent in one country extends to all other countries where that proprietor owns the patent rights¹³. Under English national law the licence obtained by a purchaser from a manufacturer who is licensed to manufacture and sell only in one country does not, however, so extend¹⁴, but, here again, once the proprietor of the patent has allowed the patented goods to reach the market in one member state, the doctrine of exhaustion of rights debars him from enforcing his patent anywhere else in the European Union¹⁵.

1 As to ownership of a patent see PARA 360 et seq.

2 As to the power to license see PARA 378.

3 As to disposals of patented products by co-proprietors see PARA 372.

4 *Incandescent Gas Light Co Ltd v Cantelo* (1895) 11 TLR 381, 12 RPC 262; *Scottish Vacuum Cleaner Co Ltd v Provincial Cinematograph Theatres Ltd* (1915) 32 RPC 353.

5 *Gillette Industries Ltd v Bernstein* [1942] Ch 45, [1941] 3 All ER 248, 58 RPC 271, CA. See also *Incandescent Gas Light Co Ltd v Cantelo* (1895) 11 TLR 381, 12 RPC 262; *Scottish Vacuum Cleaner Co Ltd v Provincial Cinematograph Theatres Ltd* (1915) 32 RPC 353.

6 The restriction may be a limitation as to price (*Columbia Graphophone Co Ltd v Murray* (1922) 39 RPC 239) provided: (1) it is not a minimum resale price restriction (see **COMPETITION** vol 18 (2009) PARA 116 et seq); (2) it is not a limitation as to the class of trader (*Re Co-operative Union Ltd's Application* (1933) 50 RPC 161); or (3) it does not require the affixing of a licence plate to the article (*Hazeltine Corp v Lissen Ltd* (1938) 56 RPC 62). A restriction as to the sale price may apply to new and second hand articles: *Columbia Graphophone Co v Thoms* (1924) 41 RPC 294. It is sufficient that the purchaser has notice that the restriction exists, without knowing that it is imposed by virtue of a limited patent licence: *Dunlop Rubber Co Ltd v Longlife Battery Depot* [1958] 3 All ER 197, [1958] 1 WLR 1033, [1958] RPC 473.

7 *National Phonograph Co of Australia Ltd v Menck* [1911] AC 336, 28 RPC 229, PC. It is doubtful, however, whether a licensee without power to sub-license can impose restrictions upon purchasers from him: see *Gillette Safety Razor Co Ltd v AW Gamage Ltd* (1908) 25 RPC 492.

8 A notice embossed on the article is ineffective if the article is usually sold wrapped up (*Alfred Dunhill Ltd v Griffith Bros* (1933) 51 RPC 93); and a notice on the wrapper is ineffective if the purchaser does not see it until after purchase (*Dunlop Rubber Co Ltd v Longlife Battery Depot* [1958] 3 All ER 197, [1958] 1 WLR 1033, [1958] RPC 473, CA). Registration of a licence does not give notice of its contents to a purchaser: *Heap v Hartley* (1889) 42 ChD 461, 6 RPC 495, CA; *Scottish Vacuum Cleaner Co Ltd v Provincial Cinematograph Theatres Ltd* (1915) 32 RPC 353.

9 *Columbia Phonograph Co, General v Regent Fittings Co* (1913) 30 RPC 484; *Columbia Graphophone Co v Vanner* (1916) 33 RPC 104; *Columbia Graphophone Co Ltd v Murray* (1922) 39 RPC 239; *Columbia Graphophone Co v Thoms* (1924) 41 RPC 294; *Sterling Drug Inc v CH Beck Ltd* [1973] RPC 915.

10 le under the provisions of the Treaty establishing the European Economic Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) ('EC Treaty') relating to the free movement of goods (arts 23-31) and competition (arts 81-89) (renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ); and **COMPETITION** vol 18 (2009) PARA 61 et seq. Exclusive licensing agreements are inherently restrictive and must comply with the technology transfer block exemption under EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2) (see **COMPETITION** vol 18 (2009) PARAS 61 et seq, 67) or else be notified to the Commission for individual exemption (see **COMPETITION** vol 18 (2009) PARA 66).

11 See the cases cited in notes 4-9. It is the rights of subsequent purchasers that become the subject of litigation in this connection, since relations between the proprietor of the patent and purchasers directly from him will be governed by contract.

12 *Badische Anilin und Soda Fabrik v Isler* [1906] 1 Ch 605, 23 RPC 173 per Buckley J; on appeal [1906] 2 Ch 443, 23 RPC 633, CA; *Hazeltine Corp v Lissen Ltd* (1938) 56 RPC 62.

13 *Betts v Willmott* (1871) 6 Ch App 239, CA; *National Phonograph Co of Australia Ltd v Menck* [1911] AC 336, 28 RPC 229, PC.

14 The licensee-manufacturer himself does not by implication acquire any such licence (*SA des Manufactures de Glaces v Tilghman's Patent Sand Blast Co* (1883) 25 ChD 1, CA), so that purchasers from him can expect to be in no better position (*Coppin v Palmer* (1898) 15 RPC 373). Cf *Dunlop Pneumatic Tyre Co Ltd v Buckingham and Adams Cycle and Motor Co Ltd* (1901) 18 RPC 423, CA.

15 See note 10.

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386. Implied terms.

The ordinary rules of construction of contracts apply to implying terms in a licence granted under a patent¹. There is ordinarily no implied term that a licensee will manufacture or use his licence².

1 *BP Refinery (Westernport) Pty Ltd v Shire of Hastings* (1978) 52 ALJR 20 at 26; *Liverpool City Council v Irwin* [1977] AC 239, [1976] 2 All ER 39, HL; *Campbell v G Hopkins & Sons (Clerkenwell) Ltd* (1931) 49 RPC 38; and see PARA 384.

2 It is therefore customary in an exclusive licence to provide for minimum royalties, or other minimum payments, to safeguard the proprietor of the patent against failure effectively to work the licence; and provisions to cover the case of failure to work so complete as to abuse the patent monopoly (see PARA 395) may be desirable. In the case of any licence, but especially an exclusive licence, it is not unusual to provide expressly that the licensee use his 'best endeavours' to work the invention. This is a very stringent term: see *Terrell v Mabie Todd & Co Ltd* (1952) 69 RPC 234 and the cases there cited; *Transfield Pty Ltd v Arlo International Ltd* [1981] RPC 141, Aus HC. As to the meaning of 'exclusive licence' see PARA 380.

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387. Covenants.

Ordinary conveyancing practice assumes that there is no implied covenant by a licensor of a patent¹ that manufacture under his patent will not constitute an infringement of any other patent, but express covenants to this effect are not unusual in international agreements². A covenant by the proprietor of a patent by all means in his power to protect and defend a patent from infringement implies a covenant to pay renewal fees³. Where there is a covenant for quiet enjoyment, an exclusive licensee⁴ can call upon the proprietor to restrain infringement⁵. No covenant that the licensed patents are valid will in general be implied⁶. A covenant for quiet enjoyment probably does, however, import a limited covenant that the proprietor has not done any act invalidating the patent, for example omitted to pay renewal fees⁷. It is a breach of contract in the case of an exclusive licence⁸ if the proprietor himself uses or works the patent⁹. A licensor will be restrained from using threats of infringement proceedings against the licensee¹⁰. In the absence of express provisions making the performance of a covenant for quiet enjoyment a condition precedent to the covenant for the payment of royalties¹¹, the court will not construe it as such. A breach of the former covenant is, therefore, available only by way of counterclaim and not as a defence to an action for royalties¹². It would seem that there is not necessarily an obligation on a licensor to keep the patent in force, although in some cases this may be inferred from the general terms of the licence¹³.

1 As to the power to license see PARA 378.

2 It is necessary to limit such a covenant to cases where the licensee works to particular designs or specifications, and usual to limit the damages for breach to the amount of the royalties otherwise due to the proprietor of the patent.

3 *Lines v Usher* (1897) 14 RPC 206, CA; *Cummings v Stewart (No 2)* [1913] 1 IR 95, 30 RPC 1. In both these cases *Mills v Carson* (1892) 9 RPC 338 was distinguished. As to renewal fees see PARA 340.

4 As to the meaning of 'exclusive licensee' see PARA 380 text and note 7.

5 *Mills v Carson* (1892) 10 RPC 9, CA. It is not necessary that an action should be brought in every case if the infringement is effectively kept down: *Dunlop Pneumatic Tyre Co Ltd v North British Rubber Co Ltd* (1904) 21 RPC 161, CA. There is no such obligation in the case of other licences: *Bessimer v Wright* (1858) 31 LTOS 213. An exclusive licensee may in any event sue for infringement in his own name: see PARA 521. As to proceedings for infringement see PARA 521 et seq.

6 *Bessimer v Wright* (1858) 31 LTOS 213.

7 Cf PARA 375 note 4. As to quiet enjoyment see the text and note 11.

8 As to the meaning of 'exclusive licence' see PARA 380.

9 *Rapid Steel Co v Blankstone* (1907) 24 RPC 529.

10 *Clark v Adie* (1873) 21 WR 456 (on appeal 21 WR 764); *SA des Manufactures de Glaces v Tilghman's Patent Sand Blast Co* (1883) 25 ChD 1, CA. As to such threats generally see PARA 557 et seq.

11 As to royalties see PARA 389.

12 *Mills v Carson* (1892) 10 RPC 9, CA; *Huntoon Co v Kolynos (Inc)* [1930] 1 Ch 528, 47 RPC 403, CA. If, however, there is such a condition and the patent has been allowed to lapse, royalties paid in ignorance of this may be recovered: *Lines v Usher* (1897) 14 RPC 206, CA.

13 *Mills v Carson* (1892) 10 RPC 9, CA; *Lines v Usher* (1897) 14 RPC 206, CA.

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388. Challenge of validity by licensee.

A covenant¹ by a licensee not to dispute validity of the patent² under which the licence is granted³ is likely to be void under European law, although the licensor may reserve the right to determine the licence⁴ in the event of such a challenge⁵. A plea of invalidity is not, however, a defence to an action to recover royalties⁶ under the licence⁷.

1 As to covenants generally see PARA 387.

2 As to the validity of patents see PARA 426 et seq.

3 As to the power to license see PARA 378.

4 As to the determination of licences generally see PARA 390.

5 A 'no-challenge' clause is usually contrary to the Treaty establishing the European Economic Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) ('EC Treaty') art 81 (renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ) (see **COMPETITION** vol 18 (2009) PARA 61 et seq); see *Re the Agreements of the Davidson Rubber Co* [1972] CMLR D52, EC Commission; *Re the Agreement of A Raymond & Co* [1972] CMLR D45, EC Commission; *Re the Agreement of the Kabel-und Metallwerke Neumeyer AG and Les Etablissements Luchaire SA* [1975] 2 CMLR D40, EC Commission; *Association des Ouvriers en Instruments de Precision v Beyrard* [1976] 1 CMLR D14, EC Commission; *IMA AG v Windsurfing International Inc* [1984] 1 CMLR 1, EC Commission; but see Case 65/86 *Bayer AG v Maschinenfabrik Hennocke GmbH v Süllhöfer* [1988] ECR 5249, [1990] 4 CMLR 182, [1990] FSR 300, ECJ (where a no-challenge clause in a royalty-free licence was upheld). See also EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2); and **COMPETITION** vol 18 (2009) PARAS 61 et seq, 67.

6 As to royalties see PARA 389.

7 *Fuel Economy Co Ltd v Murray* [1930] 2 Ch 93, 47 RPC 346, CA. Validity in any case may not be put in issue in proceedings in contract (see the Patents Act 1977 s 74(2); and PARA 520 note 2), although a counterclaim for revocation of the patent would seem to be permissible.

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389. Royalties.

Royalties may be made payable on any basis and on any articles manufactured by a licensee under a patent¹, whether within or without the patent², and may continue to be payable whether or not the patent is valid³ and until such time as the licence is determined⁴. Money paid for royalties under a licence cannot be recovered on the ground that the patent was invalid, unless the licence so provides⁵. Where a licence is given under an application for a patent but no patent is granted, it would seem that money paid cannot be recovered, as the licensee has been protected from possible proceedings for infringement from the date of publication of the specification⁶.

Royalties due under a licence carry interest⁷. An assignee of a share of the profits can have an account of royalties taken against the licensee, provided that the account is taken in such circumstances as will bind the assignor⁸. A covenant to render accounts is generally only auxiliary to the covenant to pay⁹. An auditor required to 'verify' the amount of the royalties payable by a licensee must check statements by the licensee as to what articles manufactured by him are, and what are not, within the licence, and a covenant to supply such an auditor with necessary information must be construed accordingly¹⁰. There are special provisions as to the taxation of patent royalties and of lump sums paid as consideration for the grant of a patent licence¹¹. A covenant to permit the grantor to inspect accounts will ordinarily continue in force even if the agreement is determined¹². There have been many cases as to the amount of royalty payable under licences, but, as each case depends upon the wording of the particular agreement, no general rule can be deduced¹³.

There seems to be no objection to the proprietor of the patent suing for royalties, or in the alternative for infringement, in cases where the existence of a licence may be disputed¹⁴.

1 As to the power to license see PARA 378.

2 *Baird v Neilson* (1842) 8 CI & Fin 726, HL. Payment of royalties on non-patented goods may, however, contravene the Treaty establishing the European Economic Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) ('EC Treaty') art 81 (renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation* (No 2) (Note) [1999] All ER (EC) 646, ECJ) (see **COMPETITION** vol 18 (2009) PARA 61 et seq). See, however, EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2); and **COMPETITION** vol 18 (2009) PARAS 61 et seq, 66.

3 *Mills v Carson* (1892) 9 TLR 80, 10 RPC 9, CA; *African Gold Recovery Co Ltd v Sheba Gold Mining Co Ltd* (1897) 2 Com Cas 277, 14 RPC 660. The obligation to pay royalties despite the invalidity of the patent, or one or more of several licensed patents, may be contrary to EC Treaty art 81. See also EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2); and **COMPETITION** vol 18 (2009) PARA 61 et seq. As to the validity of a patent see PARA 426 et seq.

4 Payment of royalties after the patent has expired may, however, contravene EC Treaty art 81. See also EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2); and Case 320/87 *Ottung v Klee & Weilbach A/S* [1989] ECR 1177, [1991] FSR 657, ECJ.

5 *Taylor v Hare* (1805) 1 Bos & PNR 260.

6 *Otto v Singer* (1889) 7 RPC 7. The same applies if the granted patent covers less than the original application: *Haddan v Smith* (1847) 10 LTOS 154. As to proceedings for infringement see PARA 521 et seq.

7 *Redges v Mulliner* (1892) 10 RPC 21. In *Gill v Stone & Co Ltd* (1911) 28 RPC 329 a notice was given that interest at 5% would be claimed, and interest was allowed from the date when royalties became payable. Nevertheless, it is correct practice to provide explicitly for this in the licence agreement.

8 *Bergmann v Macmillan* (1881) 17 ChD 423.

9 *Bower v Hodges* (1853) 22 LJCP 194. Failure to keep proper books may, however, be a material breach of the conditions and lead to forfeiture of the licence: *Ward v Livesey* (1887) 5 RPC 102.

10 *Fomento (Sterling Area) Ltd v Selsdon Fountain Pen Co Ltd* [1958] 1 All ER 11 at 20, [1958] 1 WLR 45 at 57, [1958] RPC 8 at 17, HL, per Lord Morton of Henryton and at 23, 61 and 20 per Lord Denning.

11 As to the taxation of patent royalties see **INCOME TAXATION** vol 23(2) (Reissue) PARA 1484 et seq.

12 *Anglo-American Asphalt Co Ltd v Crowley Russell & Co Ltd* [1945] 2 All ER 324 (where the licensee was ordered to give inspection of books for six years back from the date of the writ, although royalty statements and payments had been accepted by the licensor throughout the life of the agreement).

13 See eg *Hall v Bainbridge and Enderby* (1843) 5 QB 233 (liability to pay royalties on orders taken although the patented invention was not in fact used); *Tielens v Hooper* (1850) 20 LJ Ex 78 (provision for a minimum payment per annum, with a right to terminate the licence if this was not paid, held not to amount to a covenant to pay that minimum amount); *Oxley v Holden* (1860) 30 LJCP 68 (liability to pay royalties for fixing articles for which a royalty was payable); *Edwards v Normandy* (1864) 12 WR 548 (interpretation of 'profits' for royalty purposes); *Goucher v Clayton* (1865) 13 LT 115 (whether higher or lower royalty was payable for user, after the end of the licence term, and liability to pay royalty on renewal of patented parts); *Siemens v Taylor* (1892) 9 RPC 393 (liability to pay full royalties after some of the patents had expired); *Bagott Pneumatic Tyre Co v Clipper Pneumatic Tyre Co* [1902] 1 Ch 146, 19 RPC 69, CA (interpretation of 'profits' for royalty purposes, and liability of assignees to be sued); *Fomento (Sterling Area) Ltd v Selsdon Fountain Pen Co Ltd* [1958] 1 All ER 11, [1958] 1 WLR 45, [1958] RPC 8, HL, upholding on this point [1956] RPC 344, CA (agreement to reduce royalties if licence 'at a lower royalty' granted to another); *Bristol Repetition Ltd v Fomento (Sterling Area) Ltd* [1961] RPC 222 (liability to pay full royalties after some patents had expired); *Hansen v Magnavox Electronics Co Ltd* [1977] RPC 301, CA (liability to pay royalties after some patents had expired); *Shiley Inc's Patent* [1988] RPC 97 (the rate of royalty for a surgical device is higher than that for a mechanical device (range usually 5-7%) but lower than that of a pharmaceutical invention (range usually 25-30%)); *Cambridge Display Technology Ltd v El Dupont de Nemours & Co* [2004] EWHC 1415 (Ch), [2005] FSR 253, [2004] All ER (D) 186 (Jun) (when first payment of minimum royalty due).

14 *Haddan v Smith* (1847) 10 LTOS 154; cf *Postcard Automatic Supply Co v Samuel* (1889) 6 RPC 560.

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390. Powers to determine licence.

The question whether either party may terminate a licence depends upon its special terms. If the licence agreement is silent as to determination, there is no presumption that it is intended to be permanent¹. If there is provision for termination in certain events, there may be a presumption that it cannot be determined otherwise². If the licence is expressed to be for a definite time, it cannot be revoked³ except for acts bringing about forfeiture⁴, nor may the licensee disclaim it⁵. If there is a provision that a licence is determinable on a certain date, if certain provisions have not been complied with, acceptance of royalties after that date may estop the licensor from terminating it⁶.

1 If there is a presumption, it is rather in favour of a power to determine upon reasonable notice (reasonable, that is, at the date of the notice): *Martin-Baker Aircraft Co Ltd v Canadian Flight Equipment Ltd* [1955] 2 QB 556 at 577, 581, [1955] 2 All ER 722 at 732, 735, 72 RPC 236 at 243, 245 per McNair J. See also *Dorling v Honnor Marine Ltd* [1965] Ch 1, [1964] 1 All ER 241, CA (copyright licence).

2 *Guyot v Thomson* [1894] 3 Ch 388, 11 RPC 541, CA; *Cutlan v Dawson* (1897) 14 RPC 249, CA.

3 *Guyot v Thomson* [1894] 3 Ch 388, 11 RPC 541, CA; *Ward v Livesey* (1887) 5 RPC 102.

4 A mere breach of covenant, eg to pay renewal fees (*Mills v Carson* (1892) 9 TLR 80, 10 RPC 9, CA), or to sue infringers (*Huntoon Co v Kolynos (Inc)* [1930] 1 Ch 528, 47 RPC 403), or to provide working instructions (*Cheetham v Nuthall* (1893) 10 RPC 321), does not give rise to forfeiture. See also the cases cited in notes 2, 3. The court has power to grant relief against forfeiture to contracts concerning the transfer of proprietary or possessory rights (*Sport International Bussum BV v Inter-Footwear Ltd* [1984] 2 All ER 321, [1984] 1 WLR 776, HL; *BICC plc v Burndy Corp* [1985] Ch 232, [1985] 1 All ER 417, [1985] RPC 273 at 305, CA); but this does not extend to contracts creating such rights (*Sport International Bussum BV v Inter-Footwear Ltd* at 325 and at 794 per Lord Templeman).

5 *Cutlan v Dawson* (1897) 14 RPC 249, CA.

6 *Warwick v Hooper* (1850) 3 Mac & G 60.

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391. Effect of war.

A patent licence is not invalid by reason of the fact that the proprietor of the patent or any person otherwise interested in it is an enemy¹ if, were he not an enemy, it would have been in force in favour of a person resident in the United Kingdom²; nor is any contract, in so far as it relates to such a licence, invalid by reason of the fact that any party to it is an enemy³. This does not, however, validate grants or assignments of licences⁴, or contracts, made during the existence of a state of war, and such as to be invalid apart from this provision, nor does it authorise the performance of a licence agreement in a manner unlawful by reason of war⁵. The Crown has special powers to make use of patented inventions for the efficient prosecution of any war in which it may be engaged⁶.

1 For these purposes, 'enemy' has the same meaning as in the Trading with the Enemy Act 1939 (see s 2; and **WAR AND ARMED CONFLICT** vol 49(1) (2005 Reissue) PARA 577): Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 10(1).

2 As to the meaning of 'United Kingdom' see PARA 303 note 5.

3 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 1(1).

4 As to the power to license see PARA 378; and as to assignments of licences see PARA 382.

5 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 1(1) proviso.

6 See the Patents Act 1977 s 59(1)(a); and PARA 411.

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(2) LICENCES OF RIGHT

392. Entry of licences of right.

At any time after the grant of a patent¹ its proprietor may apply to the comptroller² for an entry to be made in the register³ to the effect that licences under the patent are to be available as of right⁴. Where such an application is made, the comptroller must give notice of the application to any person registered as having a right⁵ in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, must make the entry applied for⁶.

Where such an entry is made in respect of a patent:

- 168 (1) any person is, at any time after the entry is made, entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the comptroller on the application of the proprietor or the person requiring the licence⁷;
- 169 (2) the comptroller may, on the application of the holder of any licence granted⁸ under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled⁹;
- 170 (3) if in proceedings for infringement¹⁰ of the patent, otherwise than by the importation of any article from a country which is not a member state of the European Economic Community, the defendant undertakes¹¹ to take a licence on such terms, no injunction may be granted against him and the amount, if any, recoverable against him by way of damages must not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement¹²;
- 171 (4) if the expiry date in relation to a renewal fee¹³ falls after the date of the entry, that fee is to be half the fee which would be payable had the entry not been made¹⁴.

The licensee under a licence of right may, unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides, request the proprietor to take proceedings to prevent any infringement of the patent, and, if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were the proprietor, making the proprietor a defendant¹⁵. A proprietor so added as defendant is not liable for any costs or expenses unless he enters an appearance and takes part in the proceedings¹⁶.

1 As to grant see PARA 338.

2 As to the comptroller see PARA 577.

3 As to the register see PARA 585 et seq.

4 Patents Act 1977 s 46(1). An application under s 46(1) must be made on Patents Form 28: Patents Rules 2007, SI 2007/3291, r 43(1).

5 As to the meaning of 'right' see PARA 360 note 7.

6 Patents Act 1977 s 46(2). Where an entry is made in the register to the effect that licences under a patent are to be available as of right, the comptroller must advertise the entry in the Official Journal (Patents) (see PARA 580); Patents Rules 2007, SI 2007/3291, r 43(2). As to the application of the Patents Act 1977 s 46(2) to EU compulsory licences see para 402.

7 Patents Act 1977 s 46(3)(a). An application by a person other than the proprietor to the comptroller under s 46(3)(a) or (b) must be made on Patents Form 2 and accompanied by two copies of the draft of the licence he proposes should be granted: Patents Rules 2007, SI 2007/3291, r 89(1). The comptroller must notify the proprietor of the patent that an application has been made and must send a copy of the draft licence with the notification: r 89(2), (3). In the notification, the comptroller must specify a period within which the proprietor may file a statement of grounds: r 89(4). The proprietor must file a statement of grounds in accordance with r 76(4) (see PARA 601); otherwise he is treated as supporting the applicant's case: r 89(5). Proceedings are to continue under Pt 7 (rr 73-91) (see PARAS 600-608) as if they had been started under r 76(1) (see PARA 601) and for those purposes the proprietor is the 'claimant' and the applicant is the 'defendant': r 89(6). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

See *Beecham Group plc v Gist-Brocades NV* [1986] 1 WLR 51, [1986] RPC 203, HL (procedure on extension of patent). Terms of a licence of right can include the right to grant sub-licences to subsidiary companies when appropriate: *Hilti AG's Patent* [1988] RPC 51. Where the entry has been made compulsorily (eg under the Patents Act 1977 ss 48-51 (see PARA 395 et seq)), the comptroller may settle terms of a licence notwithstanding that the applicant is challenging the validity of the patent in infringement proceedings: *El Du Pont De Nemours & Co (Blades') Patent* [1988] RPC 479. As to settlement of terms see also *Smith Kline & French Laboratories Ltd's (Cimetidine) Patents* [1990] RPC 203, CA; *American Cyanamid Co's (Fenbufen) Patent* [1990] RPC 309; *Research Corp'n's (Carboplatin) Patent* [1990] RPC 663; *Cabot Safety Corp'n's Patent* [1992] RPC 39; *Smith Kline & French Laboratories Ltd v Harris Pharmaceuticals Ltd* [1992] FSR 110; *Research Corp'n's Supplementary Protection Certificate (No 2)* [1996] RPC 320. An applicant for a licence of right is not precluded from challenging the validity of the patent in other proceedings: *El Du Pont De Nemours & Co (Blades') Patent* [1988] RPC 479. In all the cases cited in this note, the patent had been compulsorily endorsed licences of right under the Patents Act 1977 Sch 1 (now spent).

8 As to the power to license see PARA 378.

9 Patents Act 1977 s 46(3)(b). See also note 7.

10 As to proceedings for infringement see PARA 521 et seq.

11 The undertaking may be given at the time before final order in the proceedings, without any admission of liability: Patents Act 1977 s 46(3A) (added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 12(1), (3)).

12 Patents Act 1977 s 46(3)(c) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 12(1), (2)).

13 As to renewal fees see PARA 340.

14 Patents Act 1977 s 46(3)(d) (substituted by the Patents Act 2004 s 8(4)(a)). For the purposes of the Patents Act 1977 s 46(3)(d), the expiry date in relation to a renewal fee is the day at the end of which, by virtue of s 25(3) (see PARA 340), the patent in question ceases to have effect if that fee is not paid: s 46(3B) (added by the Patents Act 2004 s 8(4)(b)).

15 Patents Act 1977 s 46(4).

16 Patents Act 1977 s 46(5). As to proceedings for infringement see PARA 517 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(2) LICENCES OF RIGHT/393. Cancellation of entry as to licences of right.

393. Cancellation of entry as to licences of right.

At any time after an entry¹ has been made on the register² that licences are available as of right under a patent³, the proprietor of the patent may apply⁴ to the comptroller⁵ for cancellation of the entry⁶. Where such an application is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the comptroller may cancel the entry if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application⁷.

Within two months after the making of the relevant entry, any person who claims that the proprietor is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the comptroller for cancellation of the entry⁸. Where the comptroller is satisfied, on such an application, that the proprietor is and was so precluded, he must cancel the entry, and the proprietor is then liable to pay, within a period specified by the comptroller, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent ceases to have effect at the expiration of that period⁹ if that sum is not so paid¹⁰.

Where an entry is cancelled under these provisions, the rights and liabilities of the proprietor are afterwards the same as if the entry had not been made¹¹.

Where an application has been made under these provisions, then, in the case of an application by the proprietor¹², any person¹³, and, in the case of an application by a person claiming that the proprietor is precluded from granting licences¹⁴, the proprietor¹⁵, may, within four weeks after the advertisement of the application for cancellation in the Official Journal (Patents), give notice to the comptroller of opposition to the cancellation¹⁶. In considering the application, the comptroller must determine whether the opposition is justified¹⁷.

1 I.e. an entry under the Patents Act 1977 s 46: see PARA 392.

2 As to the register see PARA 585 et seq.

3 See PARA 392.

4 An application under the Patents Act 1977 s 47(1) for the cancellation of an entry made under s 46 (see PARA 392) must be made on Patents Form 30: Patents Rules 2007, SI 2007/3291, r 43(3).

5 As to the comptroller see PARA 577.

6 Patents Act 1977 s 47(1).

7 Patents Act 1977 s 47(2). As to renewal fees see PARA 340.

8 Patents Act 1977 s 47(3); Patents Rules 2007, SI 2007/3291, r 43(4). The prescribed time limit may not be extended: see PARA 599. As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

9 As to the restoration of lapsed patents see PARA 356.

10 Patents Act 1977 s 47(4).

11 Patents Act 1977 s 47(5).

12 I.e. an application under the Patents Act 1977 s 47(1): see the text and notes 1-6.

- 13 See the Patents Act 1977 s 47(6)(a).
- 14 le on an application under the Patents Act 1977 s 47(3): see the text and note 8.
- 15 See the Patents Act 1977 s 47(6)(b).
- 16 Patents Act 1977 s 47(6); Patents Rules 2007, SI 2007/3291, r 77(8), (10).
- 17 Patents Act 1977 s 47(6). As to appeals from the comptroller's decision see PARA 573.

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(3) COMPULSORY LICENCES

394. Kinds of compulsory licensing.

There are two sets of provisions for the compulsory licensing of patents:

- 172 (1) provisions for licensing in case of abuse of monopoly¹ which could apply to many patents, but have been little used; and
- 173 (2) a provision for the licensing of enemy patents in time of war².

In addition, the Crown has certain rights to make use of patented inventions, and technical information relating to them, without the consent of the proprietor of the patent³.

1 See PARA 395 et seq.

2 See PARA 401.

3 See PARA 405 et seq.

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395. Grounds for compulsory licensing in case of abuse of monopoly.

At any time after the expiration of three years, or of such other period as may be prescribed¹, from the date of the grant of a patent², any person may apply to the comptroller³ for compulsory licensing⁴ on one or more of the following grounds:

- 174 (1) in the case of an application made in respect of a patent whose proprietor is a WTO proprietor⁵, the relevant grounds are⁶:
 - 7 10. (a) where the patented invention⁷ is a product, that a demand for the product in the United Kingdom⁸ is not being met on reasonable terms⁹;
 11. (b) that by reason of the refusal of the proprietor of the patent¹⁰ to grant a licence or licences on reasonable terms¹¹: (i) the exploitation in the United Kingdom of any other patented invention which involves an important technical advance of considerable economic significance in relation to the invention for which the patent concerned was granted is prevented or hindered; or (ii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced¹²;
 12. (c) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced¹³.
- 8 175 (2) in the case of an application in respect of a patent whose proprietor is not a WTO proprietor, the relevant grounds are¹⁴:
 - 9 13. (a) where the patented invention is capable of being commercially worked in the United Kingdom¹⁵, that it is not being so worked¹⁶ or is not being so worked to the fullest extent that is reasonably practicable¹⁷;
 14. (b) where the patented invention is a product, that a demand for the product in the United Kingdom is not being met on reasonable terms, or is being met to a substantial extent by importation from a country which is not a member state¹⁸;
 15. (c) where the patented invention is capable of being commercially worked in the United Kingdom, that it is being prevented or hindered from being so worked¹⁹, where the invention is a product, by the importation of the product from a country which is not a member state²⁰ or, where the invention is a process, by the importation from such a country of a product obtained directly by means of the process or to which the process has been applied²¹;
 16. (d) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms: (i) a market for the export of any patented product made in the United Kingdom is not being supplied²²; (ii) the working or efficient working in the United Kingdom of any other patented invention which makes a substantial contribution to the art is prevented or hindered²³; or (iii) the establishment or development of commercial or industrial activities in the United Kingdom is unfairly prejudiced²⁴;
 17. (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product

or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in the United Kingdom, is unfairly prejudiced²⁵.

10

1 A rule made under the Patents Act 1977 s 48(1) prescribing another period must not be made unless a draft of the rule has been laid before, and approved by resolution of, each House of Parliament: s 48(6) (s 48 substituted by SI 1999/1899). At the date at which this volume states the law no such rule had been made.

2 As to grant see PARA 338.

3 As to the comptroller see PARA 577. As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608. The burden of proof to show that one or more of the grounds of the Patents Act 1977 s 48 is met is on the applicant for the compulsory licence: *Richco Plastic Co's Patent* [1989] RPC 722.

4 Patents Act 1977 s 48(1) (as substituted: see note 1). The application may be: (1) for a licence under the patent; (2) for an entry to be made in the register to the effect that licences under the patent are to be available as of right; or (3) where the applicant is a government department, for the grant to any person specified in the application of a licence under the patent: s 48(1)(a)-(c) (as substituted: see note 1). As to opposition, appeal and arbitration in respect of such applications see PARA 400; and as to the possible relief which may be applied for see PARA 396. The applicant for a compulsory licence does not have to admit the validity of the patent and may challenge it in other proceedings, although this may result in the application being stayed until the outcome of those proceedings is known: *Halcon SD Group Inc's Patents* [1989] RPC 1. The applicant does not have to show a definite intention to work the licence; a genuine interest is enough to found an application: *Halcon SD Group Inc's Patents*.

5 A proprietor is a WTO proprietor for the purposes of the Patents Act 1977 ss 48, 48A, 48B, 50 and 52 if: (1) he is a national of, or is domiciled in, a country which is a member of the World Trade Organisation; or (2) he has a real and effective industrial or commercial establishment in such a country: s 48(5) (as substituted: see note 1). As to the World Trade Organisation see **INTERNATIONAL RELATIONS LAW** vol 61 (2010) PARA 461; **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 7. No order or entry may be made under s 48 in respect of a patent whose proprietor is a WTO proprietor unless: (a) the applicant has made efforts to obtain a licence from the proprietor on reasonable commercial terms and conditions; and (b) his efforts have not been successful within a reasonable period: s 48A(2) (s 48A added by SI 1999/1899). No order or entry may be so made if the patented invention is in the field of semi-conductor technology: Patents Act 1977 s 48A(3) (as so added).

6 Patents Act 1977 ss 48(4)(a), 48A(1) (s 48(4)(a) as substituted (see note 1); s 48A as added (see note 5)).

7 As to the meaning of 'patented invention' see PARA 371 note 27; and see *Re Lake's Patent* (1909) 26 RPC 443.

8 As to the meaning of 'United Kingdom' see PARA 303 note 5. Demand must be an existing demand, and not one which the applicant hopes to create: *Re Cathro's Application* (1934) 51 RPC 75.

9 Patents Act 1977 s 48A(1)(a) (as added: see note 5).

10 He is distinct from his exclusive licensee: *Re Colbourne Engineering Co Ltd's Application* (1954) 72 RPC 169. As to refusal see *Re Loewe Radio Co Ltd's Application* (1929) 46 RPC 479. As to the meaning of 'exclusive licensee' see PARA 380 note 7.

11 It may be reasonable to insist upon licensing a group of patents together, and demand a royalty regardless of whether or not use is made of the patents: *Re Brownie Wireless Co of Great Britain Ltd* (1929) 46 RPC 457. As to royalties see PARA 389.

12 Patents Act 1977 s 48A(1)(b) (as added: see note 5). No order or entry may be made under s 48 in respect of a patent on the ground mentioned in head (1)(b)(i) in the text unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms: s 48A(4) (as added: see note 5). A licence granted in pursuance of an order or entry so made must not be assigned except to a person to whom the patent for the other invention is also assigned: s 48A(5) (as added: see note 5). It may be fair for the proprietor of the patent to hold to his monopoly until he has recovered the cost of developing the invention: *Re Colbourne Engineering Co Ltd's Application* (1954) 72 RPC 169.

13 Patents Act 1977 s 48A(1)(c) (as added: see note 5).

14 Patents Act 1977 ss 48(4)(b), 48B(1) (s 48(4)(b) as substituted (see note 1); s 48B added by SI 1999/1899)).

15 An invention is not incapable of being worked in the United Kingdom because specially skilled labour or special tools are required to be imported: *Johnson's Patent* (1909) 26 RPC 52; *Wardwell's Patent* (1913) 30 RPC 408. The only inventions likely to be held incapable of being worked in the United Kingdom are inventions dealing with activities not found there eg gold mining. Non-working in the United Kingdom of an invention which is worked abroad requires an explanation: *Re The Application of A Hamson & Son (London) Ltd* [1958] RPC 88. A licensee who is willing to work the invention in the United Kingdom should be given the opportunity to do so even though the proprietor of the patent can justify his failure on the ground that it would be uneconomical to do so: *Re Kalle & Co AG's Patent* [1966] FSR 112. There is some doubt as to the position where working is prohibited by law, in particular by another patent monopoly; cf *Re Taylor's Patent* [1912] 1 Ch 635, 29 RPC 296; and PARA 396.

Where: (1) an application is made on the ground that the patented invention is not being commercially worked in the United Kingdom or is not being so worked to the fullest extent that is reasonably practicable; and (2) it appears to the comptroller that the time which has elapsed since the publication in the journal of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked, he may by order adjourn the application for such period as will in his opinion give sufficient time for the invention to be so worked: Patents Act 1977 s 48B(2) (as added: see note 14).

16 le by the proprietor of the patent, or licensees, or infringers: *Re Mercedes Daimler Co's Application* (1910) 27 RPC 762; *Re Wardwell's Patent* (1913) 30 RPC 408; *Hill's Patent* (1915) 32 RPC 475. Thus an applicant for compulsory licensing who has already commenced manufacture may not rely on this ground.

17 Patents Act 1977 s 48B(1)(a) (as added: see note 14). No order or entry may be made under s 48 in respect of a patent on the ground mentioned in s 48B(1)(a) if: (1) the patented invention is being commercially worked in a country which is a member state; and (2) demand in the United Kingdom is being met by importation from that country: s 48B(3) (as added: see note 14).

Where the application is on the ground that the invention is not being worked to the fullest extent possible, the applicant may be required to establish what demand might be expected and the extent to which it is not met: *Kamborian's Patent* [1961] RPC 403.

18 Patents Act 1977 s 48B(1)(b) (as added: see note 14).

19 Importation does not necessarily hinder working in the United Kingdom; it may foster it by creating a demand for the article imported: *McKechnie Bros Ltd's Application* (1934) 51 RPC 461 at 472 per Luxmoore J. A proprietor of a patent should be careful not to build up the market in the United Kingdom solely by importation: see *Fette's Patent* [1961] RPC 396.

20 Patents Act 1977 s 48B(1)(c)(i) (as added: see note 14).

21 Patents Act 1977 s 48B(1)(c)(ii) (as added: see note 14).

22 Patents Act 1977 s 48B(1)(d)(i) (as added: see note 14). No entry may be made in the register on the ground mentioned in s 48B(1)(d)(i), and any licence granted under s 48 on that ground must contain such provisions as appear to the comptroller to be expedient for restricting the countries in which any product concerned may be disposed of or used by the licensee: s 48B(4) (as added: see note 14).

23 Patents Act 1977 s 48B(1)(d)(ii) (as added: see note 14). No order or entry may be made under s 48 in respect of a patent on the ground mentioned in s 48B(1)(d)(ii) unless the comptroller is satisfied that the proprietor of the patent for the other invention is able and willing to grant to the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms: s 48B(5) (as added: see note 14).

24 Patents Act 1977 s 48B(1)(d)(iii) (as added: see note 14).

25 Patents Act 1977 s 48B(1)(e) (as added: see note 14).

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396. Possible relief for abuse of monopoly.

Where, on an application in respect of a patent for compulsory licensing in the case of abuse of monopoly¹, the comptroller² is satisfied that any of the grounds on which the application is made³ are established, he may:

- 176 (1) order⁴ the grant of a licence to the applicant on such terms⁵ as the comptroller thinks fit⁶;
- 177 (2) make an entry in the register⁷ that licences under the patent are to be available as of right⁸;
- 178 (3) where the applicant is a government department⁹, order the grant of a licence to the person specified in the application on such terms as the comptroller thinks fit¹⁰.

An application may be made for relief under these provisions in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent, and no person is estopped or barred from alleging any of the grounds on which such an application may be made by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence¹¹.

Where a holder of a licence does apply for relief, the comptroller may, if he orders the grant of a licence to the applicant, order the existing licence to be cancelled¹² or, instead of ordering the grant of a licence, may order the existing licence to be amended¹³.

Where the comptroller is satisfied on an application made for relief in respect of a patent that the manufacture, use or disposal of materials not protected by it is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product¹⁴ or the use of the patented process¹⁵, he may order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant¹⁶.

Any licence granted pursuant to an order or by virtue of an entry under these provisions entitles the licensee to institute proceedings for infringement¹⁷ in his own name if the proprietor fails to institute such proceedings¹⁸.

No order or entry may be made under the above provisions which would be at variance with any treaty or international convention to which the United Kingdom¹⁹ is a party²⁰, and Her Majesty may by Order in Council provide that the comptroller may not, otherwise than for purposes of the public interest, make an order or entry in respect of a patent in pursuance of an application under the above provisions if the invention concerned is being commercially worked in any relevant country²¹ specified in the Order and demand in the United Kingdom for any patented product resulting from that working is being met by importation from that country²².

In any proceedings on an application made in relation to a patent under the statutory provisions relating to compulsory licences²³ any statement with respect to any activity in relation to the patented invention, or with respect to the grant or refusal of licences under the patent, contained in a report of the Competition Commission²⁴ is prima facie evidence of the matters stated²⁵.

- 1 le an application under the Patents Act 1977 s 48(1): see PARA 395.
- 2 As to the comptroller see PARA 577.
- 3 le the grounds specified in the Patents Act 1977 s 48A(1) or s 48B(1): see PARA 395.
- 4 le on an application under the Patents Act 1977 s 48(1)(a): see PARA 395.
- 5 A licence granted in pursuance of an order or entry made under the Patents Act 1977 s 48 in respect of a patent whose proprietor is a WTO proprietor (see PARA 395 note 5): (1) must not be exclusive; (2) must not be assigned except to a person to whom there is also assigned the part of the enterprise that enjoys the use of the patented invention, or the part of the goodwill that belongs to that part; (3) must be predominantly for the supply of the market in the United Kingdom; (4) must include conditions entitling the proprietor of the patent concerned to remuneration adequate in the circumstances of the case, taking into account the economic value of the licence; and (5) must be limited in scope and in duration to the purpose for which the licence was granted: s 48A(6) (s 48A added by SI 1999/1899).
- 6 Patents Act 1977 s 48(2)(a) (s 48 substituted by SI 1999/1899). Without prejudice to any other method of enforcement, any order for the grant of a licence under the Patents Act 1977 s 48 or s 49 has effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order: s 108. For a form of licence see *Re Application by A Hamson & Son (London) Ltd* [1958] RPC 88, although the extremely wide powers of sub-licensing contained in that licence are possibly exceptional.
- 7 le on an application under the Patents Act 1977 s 48(1)(b): see PARA 395. As to the register see PARA 585 et seq.
- 8 Patents Act 1977 s 48(2)(b) (as substituted: see note 6). The comptroller may make an entry in the register notwithstanding any contract which would have precluded the entry on the application of the proprietor of the patent under s 46 (see PARA 392) (s 53(3)); and any entry made under s 48 has the same effect as an entry made under s 46 (s 53(4)).
- 9 le where the application is made under the Patents Act 1977 s 48(1)(c): see PARA 395.
- 10 Patents Act 1977 s 48(4)(c) (as substituted: see note 6).
- 11 Patents Act 1977 s 48(3) (as substituted: see note 6).
- 12 Patents Act 1977 s 49(2)(a).
- 13 Patents Act 1977 s 49(2)(b).
- 14 As to the meaning of 'patented product' see PARA 372 note 11.
- 15 As to the meaning of 'patented process' see PARA 371 note 27.
- 16 Patents Act 1977 s 49(1). Although this provision incorporates a ground for an application, it operates whether or not the application is made on that ground. As to the effect of such an order see note 6.
- 17 As to proceedings for infringement see PARA 521 et seq.
- 18 Patents Act 1977 s 49(4); applying s 46(4), (5) (see PARA 392).
- 19 As to the meaning of 'United Kingdom' see PARA 303 note 5.
- 20 Patents Act 1977 s 53(5). As to treaties and conventions see PARA 652 et seq.
- 21 For these purposes, 'relevant country' means a country other than a member state or a member of the World Trade Organisation whose law in the opinion of Her Majesty in Council incorporates or will incorporate provisions treating the working of an invention in, and importation from, the United Kingdom in a similar way to that in which the Order in Council would, if made, treat the working of an invention in, and importation from, that country: Patents Act 1977 s 54(2) (amended by SI 1999/1899).
- 22 Patents Act 1977 s 54(1).
- 23 le the Patents Act 1977 s 48.

24 le a report laid before Parliament under the Fair Trading Act 1973 Pt VII (ss 81-83) (repealed), the Competition Act 1980 s 17 or published under the Enterprise Act 2002 Pt 3 (ss 22-130) or Pt 4 (ss 131-184): see **COMPETITION** vol 18 (2009) PARAS 238, 281.

25 Patents Act 1977 s 53(2) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 15(a), (b); the Enterprise Act 2002 s 278, Sch 25 para 8(1), (4); and SI 1999/506).

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397. Relevant considerations.

The power of compulsory licensing in respect of a patent whose proprietor is not a WTO proprietor¹ on grounds of abuse of monopoly² must be exercised with a view to securing the following general purposes³:

- 179 (1) that inventions which can⁴ be worked on a commercial scale in the United Kingdom⁵ and which should in the public interest be so worked must be worked there without undue delay and to the fullest extent that is reasonably practicable⁶;
- 180 (2) that the inventor⁷ or other person beneficially entitled to a patent must receive reasonable remuneration having regard to the nature of the invention⁸;
- 181 (3) that the interests of any person for the time being working or developing an invention in the United Kingdom under the protection of a patent must not be unfairly prejudiced⁹.

Subject to the above considerations, the following matters must be taken into account by the comptroller in deciding whether to exercise the power¹⁰:

- 182 (a) the nature of the invention, the time which has elapsed since the publication in the Official Journal (Patents)¹¹ of a notice of the grant of the patent¹² and the measures already taken by the proprietor or any licensee to make full use of the invention¹³;
- 183 (b) the ability of any person to whom a licence would be granted under the order to work the invention to the public advantage¹⁴; and
- 184 (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted¹⁵.

Matters subsequent to the making of the application for a compulsory licence need not, however, be taken into account¹⁶.

It would seem that it is always an objection to an application for a compulsory licence that the acts of the proprietor of the patent himself were justified and legitimate¹⁷.

1 As to the meaning of 'WTO proprietor' see PARA 395 note 5.

2 I.e. the comptroller's powers on an application under the Patents Act 1977 s 48: see PARAS 395-396. As to the comptroller see PARA 577.

3 Patents Act 1977 s 50(1) (amended by SI 1999/1899).

4 Cf the use of the expression 'capable of being' in PARA 395 head (2)(a).

5 As to the meaning of 'United Kingdom' see PARA 303 note 5.

6 Patents Act 1977 s 50(1)(a).

7 As to the meaning of 'inventor' see PARA 301 note 3.

8 Patents Act 1977 s 50(1)(b).

9 Patents Act 1977 s 50(1)(c). As to the meaning of 'unfairly' see PARA 395 note 12.

10 Patents Act 1977 s 50(2) (amended by SI 1999/1899).

11 As to the Journal see PARA 580.

12 As to the publication of such a notice see PARA 338.

13 Patents Act 1977 s 50(2)(a).

14 Patents Act 1977 s 50(2)(b). The applicant for the licence must show that he is likely to have available various resources including the technical expertise and know-how for putting the invention into practice in a way which would benefit the public: *Enviro-Spray Systems Inc's Patents* [1986] RPC 147. Where an applicant is unable to satisfy the Patents Act 1977 s 50(2)(b), a licence should not be granted with the intention that it be worked, not by the applicant, but by a sub-licensee: *Re Therma-Tru Corpn's Patent* [1997] RPC 777.

15 Patents Act 1977 s 50(2)(c).

16 Patents Act 1977 s 50(2). See *Zanetti-Streccia's Patent* [1973] RPC 227. As to when working after the date of the application will be ignored see *Re McKechnie Bros Ltd's Application* (1934) 51 RPC 461; *Re Fabricmeter Co Ltd's Application* (1935) 53 RPC 307; *Re Boulton's Patent* (1909) 26 RPC 383.

17 See the Patents Act 1977 s 53(5); International Convention for the Protection of Industrial Property (Lisbon, 31 October 1958; TS 38 (1962); Cmnd 1715) art 5A(4). No order or entry may be made in pursuance of any application under the Patents Act 1977 ss 48-51 (see PARAS 423-425) which would be at variance with any treaty or international convention to which the United Kingdom is a party: s 53(5). As to treaties and international conventions see PARA 652 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(3) COMPULSORY LICENCES/398. Powers exercisable following merger and market investigations.

398. Powers exercisable following merger and market investigations.

The Competition Commission¹ or (as the case may be) the Secretary of State² may apply to the comptroller³ to take action⁴ where:

- 185 (1) the provisions of the Enterprise Act 2002⁵ relating to powers to take remedial action following merger or market investigations apply⁶;
- 186 (2) the Competition Commission or (as the case may be) the Secretary of State considers that it would be appropriate to make an application⁷ for the purpose of remedying, mitigating or preventing a matter which cannot be dealt with under the enactment concerned⁸; and
- 187 (3) the matter concerned involves: (a) conditions in licences⁹ granted under a patent by its proprietor restricting the use of the invention¹⁰ by the licensee or the right of the proprietor to grant other licences¹¹; or (b) a refusal by the proprietor of a patent to grant licences on reasonable terms¹².

Before making an application the Competition Commission or (as the case may be) the Secretary of State must publish, in such manner as it or he thinks appropriate, a notice describing the nature of the proposed application and must consider any representations which may be made within 30 days of such publication by persons whose interests appear to it or him to be affected¹³.

The comptroller may, if it appears to him on an application¹⁴ that the application is made in accordance with the above provisions, by order cancel or modify any condition concerned of the kind mentioned in head (3)(a) above or may, instead or in addition, make an entry in the register¹⁵ to the effect that licences under the patent are to be available as of right¹⁶.

1 As to the Competition Commission see **COMPETITION** vol 18 (2009) PARA 9 et seq. References in the Patents Act 1977 s 50A to the Competition Commission, in cases where the Enterprise Act 2002 s 75(2) applies, are to be read as references to the Office of Fair Trading: Patents Act 1977 s 50A(5) (s 50A added by the Enterprise Act 2002 s 278, Sch 25 para 8(1), (2)). As to the Office of Fair Trading see **COMPETITION** vol 18 (2009) PARA 6.

2 As to the Secretary of State see PARA 575.

3 As to the comptroller see PARA 577.

4 Patents Act 1977 s 50A(2) (as added: see note 1).

5 I.e. the Enterprise Act 2002 ss 41(2), 55(2), 66(6), 75(2), 83(2), 138(2), 147(2), 160(2), Sch 7 paras 5(2), 10(2): see **COMPETITION** vol 18 (2009) PARA 1 et seq. See also the Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003, SI 2003/1592, art 16, Sch 4 para 3. References in the Enterprise Act 2002 s 35, 36, 47, 63, 134 or 141 (questions to be decided by the Competition Commission in its reports) to taking action under s 41(2), 55, 66, 138 or 147 include references to taking action under the Patents Act 1977 s 50A(2) (see the text to notes 1-4): s 50A(6) (as added: see note 1).

6 Patents Act 1977 s 50A(1)(a) (as added: see note 1).

7 I.e. under the Patents Act 1977 s 50A.

8 Patents Act 1977 s 50A(1)(b) (as added: see note 1).

9 As to licences generally see PARA 378 et seq.

- 10 As to the meaning of 'invention' see PARA 301 note 2.
- 11 Patents Act 1977 s 50A(1)(c)(i) (as added: see note 1).
- 12 Patents Act 1977 s 50A(1)(c)(ii) (as added: see note 1).
- 13 Patents Act 1977 s 50A(3) (as added: see note 1).
- 14 Is an application under the Patents Act 1977 s 50A.
- 15 As to the register see PARA 585.
- 16 Patents Act 1977 s 50A(4) (as added: see note 1). As to licences of right see PARAS 392-393. Action taken by virtue of s 50A(4) in consequence of an application under s 50A(2) (see the text to notes 1-4) where an enactment mentioned in s 50A(1)(a) (see note 5) applies is to be treated, for the purposes of the Enterprise Act 2002 ss 91(3), 92(1)(a), 162(1) and 166(3) (duties to register and keep under review enforcement orders etc), as if it were the making of an enforcement order (within the meaning of the Part concerned) under the relevant power in Pt 3 (ss 22-130) or (as the case may be) Pt 4 (ss 131-184) of that Act: Patents Act 1977 s 50A(7) (as added: see note 1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(3) COMPULSORY LICENCES/399. Powers exercisable in consequence of report of Competition Commission.

399. Powers exercisable in consequence of report of Competition Commission.

The appropriate minister or ministers¹ may apply to the comptroller² for compulsory licensing where a report of the Competition Commission has been laid before Parliament containing conclusions to the effect:

- 188 (1) on a competition reference, that a person was engaged in an anticompetitive practice which operated or may be expected to operate against the public interest; or
- 189 (2) on a reference of public bodies and certain other persons³, that a person is pursuing a course of conduct which operates against the public interest⁴.

Before making such an application, the appropriate minister or ministers must publish, in such manner as he or they think appropriate, a notice describing the nature of the proposed application and must consider any representations which may be made within 30 days of such publication by persons whose interests appear to him or them to be affected⁵.

If on an application under the above provisions it appears to the comptroller that the matters specified in the Commission's report as being those which in the Commission's opinion operate, or operated or may be expected to operate, against the public interest include: (a) conditions in licences granted under a patent by its proprietor restricting the use of the invention by the licensee or the right of the proprietor to grant other licences; or (b) a refusal by the proprietor of a patent to grant licences on reasonable terms, he may by order cancel or modify any such condition or may, instead or in addition, make an entry in the register to the effect that licences under the patent are to be available as of right⁶.

1 For these purposes, 'appropriate minister or ministers' means the minister or ministers to whom the report of the Competition Commission was made: Patents Act 1977 s 51(4) (s 51 substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 14). As to the Competition Commission see **COMPETITION** vol 18 (2009) PARA 9 et seq.

2 As to the comptroller see PARA 577.

3 I.e a reference under the Competition Act 1980 s 11: see **COMPETITION** vol 18 (2009) PARA 10.

4 Patents Act 1977 s 51(1) (as substituted (see note 1); and amended by SI 1999/506). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

5 Patents Act 1977 s 51(2) (as substituted: see note 1).

6 Patents Act 1977 s 51(3) (as substituted: see note 1). As to licences of right see PARAS 392-393.

UPDATE

399 Powers exercisable in consequence of report of Competition Commission

NOTE 3--Competition Act 1980 s 11 amended: SI 2009/1941.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(3) COMPULSORY LICENCES/400. Opposition, appeal and arbitration.

400. Opposition, appeal and arbitration.

The proprietor of the patent concerned or any other person wishing to oppose an application for the grant of compulsory licences¹ may give to the comptroller² notice of opposition in accordance with the prescribed procedure³. The comptroller must consider the opposition in deciding whether to grant the application⁴.

Where an order or entry has been made⁵ in respect of a patent whose proprietor is a WTO proprietor⁶:

- 190 (1) the proprietor or any other person may, in accordance with rules, apply to the comptroller to have the order revoked or the entry cancelled on the grounds that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur⁷;
- 191 (2) any person wishing to oppose an application under head (1) above may, in accordance with rules, give to the comptroller notice of opposition⁸; and
- 192 (3) the comptroller must consider any opposition in deciding whether to grant the application⁹.

If it appears to the comptroller on an application under head (1) above that the circumstances which led to the making of the order or entry have ceased to exist and are unlikely to recur, he may revoke the order or cancel the entry and terminate any licence granted to a person in pursuance of the order or entry subject to such terms and conditions as he thinks necessary for the protection of the legitimate interests of that person¹⁰.

Where an appeal¹¹ is brought from an order made by the comptroller in pursuance of an application for compulsory licensing¹² or from a decision of his to make an entry in the register¹³ in pursuance of such an application or from a revocation or cancellation made by him¹⁴ or from a refusal of his to make such an order, entry, revocation or cancellation, the Attorney General, or such other counsel as he may appoint, is entitled to appear and be heard¹⁵.

Where an application¹⁶ is opposed and either the parties consent¹⁷ or the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the comptroller's opinion conveniently be made before him¹⁸, he may at any time order the whole of the proceedings, or any question or issue of fact arising in them, to be referred to an arbitrator agreed on by the parties or, in default of agreement, appointed by the comptroller¹⁹.

1 Ie an application under the Patents Act 1977 ss 48-51: see PARAS 395-399.

2 As to the comptroller see PARA 577.

3 Patents Act 1977 s 52(1) (s 52 substituted by SI 1999/1899). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

4 Patents Act 1977 s 52(1) (as substituted: see note 3).

5 Ie under the Patents Act 1977 s 48: see PARAS 395-396.

6 Patents Act 1977 s 52(2) (as substituted: see note 3). As to the meaning of 'WTO proprietor' see PARA 395 note 5.

- 7 Patents Act 1977 s 52(2)(a) (as substituted: see note 3).
- 8 Patents Act 1977 s 52(2)(b) (as substituted: see note 3). As to notice of opposition see PARA 348.
- 9 Patents Act 1977 s 52(2)(c) (as substituted: see note 3).
- 10 Patents Act 1977 s 52(3) (as substituted: see note 3).
- 11 As to appeals generally see PARA 572 et seq.
- 12 Ie an order under the Patents Act 1977 ss 48-51: see PARAS 395-399.
- 13 As to the register see PARA 585 et seq.
- 14 Ie under the Patents Act 1977 s 52(3) (see the text to note 10).
- 15 Patents Act 1977 s 52(4) (as substituted: see note 3). As to the Attorney General see **CONSTITUTIONAL LAW AND HUMAN RIGHTS** vol 8(2) (Reissue) PARA 529.
- 16 Ie under the Patents Act 1977 ss 48-51 (see PARAS 395-399) or s 52(2) (see the text to notes 5-9).
- 17 Patents Act 1977 s 52(5)(a) (as substituted: see note 3).
- 18 Patents Act 1977 s 52(5)(b) (as substituted: see note 3).
- 19 Patents Act 1977 s 52(5) (as substituted: see note 3). Where the whole of the proceedings are so referred, then, unless the parties otherwise agree before the arbitrator's award is made, an appeal lies from the award to the court: s 52(6) (as substituted: see note 3). Where a question or issue of fact is so referred, the arbitrator must report his findings to the comptroller: s 52(7) (as substituted: see note 3). As to arbitration generally see **ARBITRATION** vol 2 (2008) PARA 1201 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(3) COMPULSORY LICENCES/401. Licensing enemy patents in time of war.

401. Licensing enemy patents in time of war.

The comptroller¹ may grant to any person who is not an enemy or an enemy subject a licence under any patent of which the owner is an enemy or an enemy subject, or in which an enemy or enemy subject is entitled to any other interest, or in which an enemy or enemy subject² has previously been entitled to an interest, whenever the comptroller is satisfied:

193 (1) that the proposed licensee desires to exercise the rights conferred by the patent and is in a position to do so; and

194 (2) that it is in the interest of all or any of Her Majesty's subjects that those rights should be exercised³.

Such a licence may be exclusive⁴, may be made notwithstanding the existence of any other licence and so as to take away any right in relation to the patent held by any person which is inconsistent with the new licence, and may be made on any terms the comptroller thinks expedient⁵. The comptroller has a general discretion to vary and revoke such licences⁶. A wrong decision that a proprietor is an enemy or enemy subject does not invalidate the grant of a licence⁷. The licensee may sue for infringement⁸, even though he is only a non-exclusive licensee⁹.

There is provision for opposition to an application to the comptroller for such a licence¹⁰, but none for appeal from his decision.

1 As to the comptroller see PARA 577.

2 I.e., it would seem, a person who at the date of the grant is an enemy or enemy subject. Thus, although these provisions are permanently in force, the powers conferred only exist in time of war: see *Re IG Farbenindustrie AG's Agreement* [1941] Ch 147, [1940] 4 All ER 486, 58 RPC 31 (revsd on appeal [1944] Ch 41, [1943] 2 All ER 525, 60 RPC 193, CA); *Novello & Co Ltd v Hinrichsen Edition Ltd* [1951] Ch 1026 at 1031, [1951] 2 All ER 457 at 460, 68 RPC 243 at 245, 250-251, CA, per Sir Raymond Evershed MR.

3 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(1) (amended by the Statute Law (Repeals) Act 1995).

4 As to the meaning of 'exclusive licence' see PARA 380.

5 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(2)-(4), (6).

6 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(7), (8).

7 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 7(2). Entries in the register are prima facie evidence of the nationalities and places of residence there stated: s 7(1). As to the register see PARA 585 et seq.

8 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(5). Unless the court directs otherwise, any non-enemy patentee must be made a party to the proceedings in the usual way: s 2(5). As to the court's discretion see *Novello & Co Ltd v Ernst Eulenburg Ltd* [1950] 1 All ER 44, CA. As to proceedings for infringement see PARA 521 et seq.

9 *Novello & Co Ltd v Ernst Eulenburg Ltd* [1950] 1 All ER 44, CA.

10 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(7), (8). As to procedure see s 8.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(3) COMPULSORY LICENCES/402. EU compulsory licences.

402. EU compulsory licences.

A procedure for the grant of compulsory licences in relation to patents and supplementary protection certificates concerning the manufacture and sale of pharmaceutical products, when such products are intended for export to eligible importing countries in need of such products in order to address public health problems was established by European Regulation¹. Member states are required to grant an EU compulsory licence to any person making an application in accordance with the Regulation².

In the application to EU compulsory licences of certain provisions of the Patents Act 1977³: (1) references to a licence under a patent⁴; (2) references to a right under a patent⁵; and (3) references to a proprietary interest under a patent, include an EU compulsory licence⁶.

Any order for the grant of an EU compulsory licence, without prejudice to any other method of enforcement, has effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order⁷.

1. Issued by EC Regulation 816/2006 of the European Parliament and of the Council of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (OJ L157, 9.6.2006, p 1) (the 'Compulsory Licensing Regulation').

2. EC Regulation 816/2006 (OJ L157, 9.6.2006, p 1) art 1; Patents Act 1977 s 128A(1), (6) (s 128A added by SI 2007/3293). Such an application must be in accordance with EC Regulation 816/2006 (OJ L157, 9.6.2006, p 1) art 6 and subject to the conditions set out in arts 6-10: art 1.

3. The provisions referred to are: the Patents Act 1977 ss 32, 33 (registration of patents etc) (see PARAS 585-588), s 37 (determination of right to patent after grant) (see PARA 366), s 38 (effect of transfer etc of patent under s 37) (see PARA 368), apart from s 38(2) and s 38(3)-(5) so far as relating to s 38(2) (see PARA 368), s 41 (amount of compensation) (see PARA 371), s 46(2) (notice of application for entry that licences are available as of right) (see PARA 392), s 57(1), (2) (rights of third parties in respect of Crown use) (see PARA 408): s 128A(3) (as added: see note 2).

4. As to licences generally see PARA 378 et seq.

5. As to the meaning of 'right' see PARA 360 note 7.

6. Patents Act 1977 s 128A(2) (as added: see note 2). In the following provisions references to the Patents Act 1977 include the Compulsory Licensing Regulation: the Patents Act 1977 ss 97-99B, 101-103, 105, 107 (legal proceedings) (see PARA 517 et seq), s 119 (service by post) (see PARA 583), s 120 (hours of business and excluded days) (see PARA 579), s 121 (comptroller's annual report) (see PARA 578), s 123 (rules) (see PARA 580), s 124A (use of electronic communications) (see PARA 584), s 130(8) (disapplication of the Arbitration Act 1996 Pt 1) (see PARA 577): Patents Act 1977 s 128A(4) (as added: see note 2).

7. Patents Act 1977 ss 108, 128A(5) (as added: see note 2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(4) RESTRICTIONS ON CONTRACTS/403. Terms in restraint of trade.

(4) RESTRICTIONS ON CONTRACTS

403. Terms in restraint of trade.

Conditions in a licence which are in restraint of trade must be reasonable both as between the parties and in the interest of the public¹. A condition imposing penalties upon manufacture of more than a certain quantity of the patented article may be reasonable². A condition that the licensee is not to make goods or execute works competing with those the subject of the licence may be reasonable³, as may a condition that a licensee is only to sell the goods of the patentee⁴. A covenant to assign future patent rights may be good⁵, unless given by an employee⁶.

Any term in a patent licence which may affect trade between member states of the European Union must comply with the provisions of the EC Treaty relating to competition⁷. A block exemption is, however, granted⁸ on certain licensing agreements in respect of patent⁹.

1 The burden of showing that an agreement that is reasonable between the parties is unreasonable in the public interest is a heavy one. The rule stated is part of the general law, not special to patent licences: see *Tool Metal Manufacturing Co Ltd v Tungsten Electric Co Ltd* [1955] 2 All ER 657 at 662, 72 RPC 209 at 213, HL, per Viscount Simonds. As to the effect of conditions in restraint of trade generally see **COMPETITION** vol 18 (2009) PARA 377 et seq.

2 *Tool Metal Manufacturing Co Ltd v Tungsten Electric Co Ltd* [1955] 2 All ER 657, [1955] 1 WLR 761, 72 RPC 209, HL. Such a condition may, however, be contrary to the Treaty establishing the European Economic Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) ('EC Treaty') relating to the free movement of goods art 81 (renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ): see **COMPETITION** vol 18 (2009) PARA 61 et seq.

3 *Jones v Lees* (1856) 1 H & N 189; *Nordenfelt v Maxim Nordenfelt Guns and Ammunition Co* [1894] AC 535, HL; *Mouchel v Cubitt & Co* (1907) 24 RPC 194. Such a condition may, however, be contrary to the EC Treaty art 81 (see note 2): see *Association des Ouvriers en Instruments de Précision v Beyrard* [1976] 1 CMLR D14; and EC Commission and EC Commission Regulation 2349/84 (OJ 1984 L219, 16.8.84, p 15) art 3.5. See further **COMPETITION** vol 18 (2009) PARA 61 et seq.

4 Such a condition is probably contrary to the EC Treaty art 81 (see note 2): see EC Commission Regulation 2349/84 (OJ 1984 L219, 16.8.84, p 15) art 3.3; and **COMPETITION** vol 18 (2009) PARA 67.

5 *Printing and Numerical Registering Co v Sampson* (1875) LR 19 Eq 462; *Buchanan v Alba Diagnostics Ltd* [2004] UKHL 5, [2004] RPC 681, 2004 SLT 255 (assignment of future improvements not an unreasonable restraint of trade at common law). Such a covenant may, however, be contrary to the EC Treaty art 81 (see note 2): see EC Commission Regulation 2349/84 (OJ 1984 L219, 16.8.84, p 15) art 3.8.

6 See PARA 369.

7 Ie the EC Treaty arts 81-89: see **COMPETITION** vol 18 (2009) PARA 61 et seq.

8 Ie by EC Commission Regulation 2349/84 (OJ 1984 L219, 16.8.84, p 15) or EC Commission Regulation 240/96 (OJ L31, 9.2.96, p 2): see **COMPETITION** vol 18 (2009) PARA 61.

9 See **COMPETITION** vol 18 (2009) PARA 67 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/404. Effect of patents against the Crown; infringement and Crown use.

(5) CROWN USE OF PATENTED INVENTIONS

404. Effect of patents against the Crown; infringement and Crown use.

Subject to certain exceptions¹, a patent has the same effect against the Crown as it has against a subject². The rights of any government department to make use of patented inventions for the services of the Crown³ are not, however, affected by the statutory provisions⁴ which permit, in certain circumstances, claims against the Crown for infringement of a patent⁵.

Further, nothing in the Patents Act 1977 affects the right of the Crown or of any person deriving title directly or indirectly from the Crown to dispose of or use articles forfeited under the laws relating to customs and excise⁶.

¹ I.e the Patents Act 1977 ss 55-59: see PARAS 405-411.

² See the Patents Act 1977 s 129.

³ I.e the rights under the Patents Act 1977 s 55: see PARA 405.

⁴ I.e the Crown Proceedings Act 1947 s 3(1)(a): see PARA 525.

⁵ See the Crown Proceedings Act 1947 s 3(1), (2); and PARA 525.

⁶ Patents Act 1977 s 122. As to the Crown's rights to dispose of or use articles so forfeited see the Customs and Excise Management Act 1979 s 139(4), (5), Sch 3 para 16; and **CUSTOMS AND EXCISE** vol 12(3) (2007 Reissue) PARA 1158.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/405. Use of patented inventions for services of the Crown.

405. Use of patented inventions for services of the Crown.

Notwithstanding anything in the Patents Act 1977, any government department and any person authorised in writing by a government department may do any of the following acts in the United Kingdom¹ in relation to a patented invention² for the services of the Crown³, without the consent of the proprietor of the patent⁴:

- 195 (1) where the invention is a product:
11
- 18. (a) make, use, import or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing or keeping it⁵; or
- 19. (b) in any event, sell or offer to sell it for foreign defence purposes⁶ or for the production or supply of specified drugs and medicines⁷, or dispose or offer to dispose of it, otherwise than by selling it, for any purpose whatever⁸;
- 12
- 196 (2) where the invention is a process, use it or do in relation to any product obtained directly by means of the process anything mentioned in head (1) above⁹;
- 197 (3) without prejudice to the foregoing, where the invention or any product obtained directly by means of the invention is a specified drug or medicine, sell or offer to sell the drug or medicine¹⁰;
- 198 (4) supply or offer to supply to any person any of the means, relating to an essential element of the invention, for putting the invention into effect¹¹;
- 199 (5) dispose or offer to dispose of anything which was made, used, imported or kept in the exercise of the powers conferred by these provisions and which is no longer required for the purpose for which it was made, used, imported or kept, as the case may be¹².

Anything done by virtue of these provisions does not amount to an infringement of the patent concerned¹³.

The authority of a government department in respect of an invention may be given either before or after the patent is granted¹⁴ and either before or after the use in respect of which the authority is given is made, and may be given to any person whether or not he is authorised directly or indirectly by the proprietor of the patent to do anything in relation to the invention¹⁵.

Where any use of an invention is made by or with the authority of a government department, then, unless it appears to the department that it would be contrary to the public interest to do so, the department must notify the proprietor as soon as practicable after the second of the following events, that is to say, the use is begun and the patent is granted, and furnish him with such information as to the extent of the use as he may from time to time require¹⁶.

A person who acquires anything disposed of in the exercise of powers conferred by these provisions, and any person claiming through him, may deal with it in the same manner as if the patent were held on behalf of the Crown¹⁷.

1 As to the meaning of 'United Kingdom' see PARA 303 note 5.

2 As to the meaning of 'patented invention' see PARA 371 note 27. Any reference in the Patents Act 1977 s 55 to a patented invention, in relation to any time, is a reference to an invention for which a patent has before that time been, or is subsequently, granted: s 56(1).

3 Except so far as the context otherwise requires, 'services of the Crown' includes: (1) the supply of anything for foreign defence purposes; (2) the production or supply of specified drugs and medicines; and (3) such purposes relating to the production or use of atomic energy or research into matters connected with it as the Secretary of State thinks necessary or expedient: Patents Act 1977 ss 56(2), 130(1). Any reference to the services of the Crown includes, as respects any period of emergency, a reference to the purposes in s 59(1)(a)-(g) (see PARA 411 heads (1)-(7)): s 59(1). As to the meaning of 'period of emergency' see PARA 411 note 1. 'Use for the services of the Crown' is to be construed accordingly: ss 56(2), 130(1); and see note 13. Nothing in the National Health Service and Community Care Act 1990 s 60(1) (removal of Crown immunity from health service bodies: see **HEALTH SERVICES** vol 54 (2008) PARA 94) affects the extent of the expression 'services of the Crown' where it appears in the Patents Act 1977 ss 55-59; and accordingly services provided in pursuance of any power or duty of the Secretary of State under the National Health Service Act 2006 (see **HEALTH SERVICES** vol 54 (2008) PARA 6) continue to be regarded as included in that expression, whether the services are in fact provided by a health service body, a National Health Service Trust or any other person: National Health Service and Community Care Act 1990 s 60(4) (amended by the National Health Service (Consequential Provisions) Act 2006 s 2, Sch 1 paras 128, 131(b)). As to the Secretary of State see PARA 575. Use by a health authority exercising the functions of the Secretary of State, devolved through the provisions of the National Health Service Act 1977 and the regulations made thereunder, is Crown use: *Dory v Sheffield Health Authority* [1991] FSR 221.

4 Patents Act 1977 s 55(1). The power conferred by s 55(1) on a government department, or person authorised in writing by a government department, in relation to the use of patented inventions for the services of the Crown is exercisable for the purposes of a visiting force or headquarters to the extent that it would be exercisable if the visiting force or headquarters were a part of any of the home forces, but this does not authorise the doing of any act falling within s 55(1)(a)(ii) or (c) (see heads (1)(b), (3) in the text), or the doing of anything which is for a purpose relating to the production or use of atomic energy or research into matters connected therewith: Visiting Forces and International Headquarters (Application of Law) Order 1999, SI 1999/1736, art 6, Sch 4 para 2(1), (2). In relation to the exercise of these powers, the Patents Act 1977 ss 55-58 (apart from s 56(2)-(4)) have effect with any reference in those provisions to the use of a patented invention for the services of the Crown being construed as a reference to the use of such an invention for the purposes of a visiting force or headquarters: Visiting Forces and International Headquarters (Application of Law) Order 1999, SI 1999/1736, art 6, Sch 4 para 2(3). As to visiting forces and headquarters see **ARMED FORCES** vol 2(2) (Reissue) PARA 142 et seq.

5 Patents Act 1977 s 55(1)(a)(i).

6 For these purposes, references to a sale or supply of anything for foreign defence purposes are references to a sale or supply of the thing: (1) to the government of any country outside the United Kingdom, in pursuance of an agreement or arrangement between the United Kingdom government and the government of that country, where the thing is required for the defence of that country or of any other country whose government is party to any agreement or arrangement with the United Kingdom government in respect of defence matters; or (2) to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between the United Kingdom government and that organisation or government, where the thing is required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation: Patents Act 1977 s 56(3).

7 For these purposes, the Patents Act 1977 s 56(4) (amended by the National Health Service (Scotland) Act 1978 s 109, Sch 16 para 45; the National Health Service (Primary Care) Act 1997 s 41(10), Sch 2 para 2; the Health and Social Care Act 2001 s 67(1), Sch 5 para 4; the Health and Social Care (Community Health and Standards) Act 2003 ss 184, 196, Sch 11 para 6, Sch 14 Pt 4; the National Health Service (Consequential Provisions) Act 2006 s 2, Sch 1 paras 57, 58; SI 2004/957; SI 2006/1056) provides that specified drugs and medicines are drugs and medicines which are both:

1 (1) required for the provision of:

1. (a) primary medical services under the National Health Service Act 2006, the National Health Service (Wales) Act 2006, the National Health Service (Scotland) Act 1978 Pt 1 or any corresponding provisions of the law in force in Northern Ireland or the Isle of Man or primary dental services under the National Health Service Act 2006, the National Health Service (Wales) Act 2006, or any corresponding provisions of the law in force in Northern Ireland or the Isle of Man;
2. (b) pharmaceutical services, general medical services or general dental services under the National Health Service Act 2006 Pt 7 Ch 1 or the National Health Service (Wales) Act 2006 Pt 7 Ch 1 (in the case of pharmaceutical services), the National Health Service (Scotland) Act 1978 Pt II (in the case of

pharmaceutical services or general dental services), or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man;

2

3. (c) personal medical services or personal dental services provided in accordance with arrangements made under the National Health Service (Scotland) Act 1978 s 17C (in the case of personal dental services), or the corresponding provisions of the law in force in Northern Ireland or the Isle of Man;

3

4. (d) local pharmaceutical services provided under a pilot scheme established under the National Health Service Act 2006 s 134, or the National Health Service (Wales) Act 2006 s 92, or an LPS scheme established under the National Health Service Act 2006 Sch 12, or the National Health Service (Wales) Act 2006 Sch 7, or under any corresponding provision of the law in force in the Isle of Man; or

4

5. (e) pharmaceutical care services under the National Health Service (Scotland) Act 1978 Pt 1; and

5

2 (2) specified for these purposes in regulations made by the Secretary of State.

At the date at which this volume states the law no such regulations had been made.

8 Patents Act 1977 s 55(1)(a)(ii).

9 Patents Act 1977 s 55(1)(b).

10 Patents Act 1977 s 55(1)(c).

11 Patents Act 1977 s 55(1)(d).

12 Patents Act 1977 s 55(1)(e).

13 Patents Act 1977 s 55(1). Any act done in relation to an invention by virtue of these provisions is referred to as use of the invention, and 'use' is to be construed accordingly: s 55(2). See also note 3. As to compensation for such use see PARA 406; and as to infringement see PARA 500 et seq.

14 As to grant see PARA 338.

15 Patents Act 1977 s 55(6). Retrospective authority given under s 55(6) takes away any cause of action which the patentee might have had against the person before the authority was given and substitutes a right of remuneration under s 55(4) (see PARA 406): *Dory v Sheffield Health Authority* [1991] FSR 221.

16 Patents Act 1977 s 55(7).

17 Patents Act 1977 s 55(8).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/406. Compensation for Crown use.

406. Compensation for Crown use.

Any use by a government department of a patented invention¹ made after the publication of the application for the patent for the invention², or in consequence of a relevant communication³ made after the priority date⁴ of the invention otherwise than in confidence⁵, must be made on such terms as may be agreed, either before or after the use, by the government department and the proprietor of the patent, with Treasury approval, or, in default of such agreement, on such terms as may be determined⁶ by the court⁷.

Any such use of an invention which, before its priority date, has been duly recorded by or tried by or on behalf of a government department or the United Kingdom Atomic Energy Authority⁸ otherwise than in consequence of a relevant communication made in confidence may, however, be made free of any royalty⁹ or other payment to the proprietor¹⁰.

Where an invention is used at any time after publication of an application for a patent for the invention but before such a patent is granted¹¹, and the terms for its use as agreed or determined by the court include terms as to payment for the use, then, notwithstanding anything in those terms, any such payment is recoverable only after such a patent is granted¹², and if the use would¹³, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims (as interpreted by the description and any drawings referred to in the description or claims)¹⁴ in the form in which they were contained in the application immediately before the preparations for its publication were completed by the UK Intellectual Property Office¹⁵.

1 Ie any use made by virtue of the Patents Act 1977 s 55(1): see PARA 405. As to the meaning of 'patented invention' for the purposes of s 55 see PARA 405 note 2; and as to the meaning of 'use' see PARA 405 note 13.

2 Patents Act 1977 s 55(4)(a). As to the publication of patent applications see PARA 327.

3 For these purposes, 'relevant communication' means a communication of the invention directly or indirectly by the proprietor of the patent or any person from whom he derives title: Patents Act 1977 s 55(9).

4 As to the meaning of 'priority date' see PARA 311 note 6.

5 Patents Act 1977 s 55(4)(b).

6 Ie on a reference under the Patents Act 1977 s 58: see PARA 410.

7 Patents Act 1977 s 55(4). Section 55(4) is without prejudice to any rule of law relating to the confidentiality of information: s 55(10). As to the meaning of 'court' see PARA 637 note 1.

8 As to the United Kingdom Atomic Energy Authority see **FUEL AND ENERGY** vol 19(3) (2007 Reissue) PARA 1363 et seq.

9 As to royalties see PARA 389.

10 Patents Act 1977 s 55(3).

11 As to grant see PARA 338.

12 Patents Act 1977 s 55(5)(a).

13 Ie apart from the Patents Act 1977 s 55.

14 As to claims see PARAS 324-325; and as to proceedings for infringement see PARA 521.

15 Patents Act 1977 s 55(5)(b). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/407. Persons entitled to compensation.

407. Persons entitled to compensation.

Compensation for use of a patented invention¹ under Crown powers² is payable to the proprietor of the patent³, except in the following three cases when it is payable, wholly or in part, to a licensee or an assignor, as the case may be:

- 200 (1) where an exclusive licence⁴ granted otherwise than for royalties⁵ or other benefits determined by reference to the working of the invention is in force under the patent or the application concerned, then, in relation to anything done in respect of the invention which would, but for the provisions as to Crown powers of use⁶, be an infringement of the rights of the licensee, and compensation is payable to the licensee⁷;
- 201 (2) where there is any other exclusive licence, the licensee is entitled to recover from the proprietor of the patent or application such part of any compensation as they may agree to be just having regard to any expenditure incurred by the licensee in developing the invention, or in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention⁸; and in default of agreement the apportionment may be determined by the court⁹ accordingly¹⁰;
- 202 (3) subject to the entitlement under head (1) above, where the patent, or the right to the grant of the patent, has been assigned¹¹ to the proprietor in consideration of royalties or other benefits determined by reference to the working of the invention, the compensation must be divided between the proprietor and the assignor in such proportion as they may agree or, in default of agreement, as may be determined by the court¹².

1 I.e. any use made by virtue of the Patents Act 1977 s 55(1): see PARA 405. As to the meaning of 'patented invention' for the purposes of s 55(1), see PARA 405 note 2; as to the meaning of 'use' see PARA 405 note 13. As to compensation for use of information see PARA 408.

2 I.e. any use made by virtue of the Patents Act 1977 s 55(1).

3 See the Patents Act 1977 s 55(4); and PARA 406.

4 As to the meaning of 'exclusive licence' see PARA 380.

5 As to royalties see PARA 389.

6 I.e. the provisions of the Patents Act 1977 ss 55, 57.

7 See the Patents Act 1977 s 57(3)(a). If, however, the licensee uses the invention under Crown authority, there is no right of compensation: s 57(3)(b).

8 See the Patents Act 1977 s 57(5)-(7). Any agreement by the proprietor of the patent or application and the department concerned under s 55(4) as to the amount of compensation payable is of no effect unless the licensee consents to it; and any determination by the court under s 55(4) is of no effect unless the licensee has been informed of the reference to the court and is given an opportunity to be heard: s 57(8). As to the meaning of 'court' see PARA 637 note 1.

9 I.e. under the Patents Act 1977 s 58: see PARA 410.

10 Patents Act 1977 s 57(7). In making the apportionment the court will normally follow any agreement between the parties as to division of royalties: *Patchett's Patent* [1967] RPC 237, CA.

11 As to entitlement to a patent see PARA 307; and as to assignment see PARA 374.

12 Patents Act 1977 s 57(4)(a). Any act done in respect of the invention for the services of the Crown by the proprietor of the patent or application to the order of a government department attracts compensation as if done under Crown authority: s 57(4)(b). As to the meaning of 'services of the Crown' see PARA 405 note 3.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/408. Rights of third persons and use of information.

408. Rights of third persons and use of information.

In relation to any use made for the services of the Crown¹ of an invention by a government department or a person authorised by a government department² or anything done for the services of the Crown to the order of a government department by the proprietor of a patent in respect of a patented invention³ or by the proprietor of an application in respect of an invention for which an application for a patent has been filed⁴ and is still pending, the provisions of any licence⁵, assignment⁶ or agreement made⁷ between the proprietor of the patent or applicant for a patent, or any person who derives title from him or from whom he derives title, and any person other than a government department⁸ are of no effect, so far as those provisions restrict or regulate the working of the invention or the use of any model, document or information relating to the invention, or provide for the making of payments in respect of or calculated by reference to any such use⁹, and in connection with such working or use of an invention, the reproduction or publication of any model or document does not infringe any copyright¹⁰ or design right¹¹ subsisting in the model or document or any topography right¹². In such a case, the rules governing compensation for Crown use¹³ and procedure for determination of disputes as to Crown use¹⁴ apply as if the person entitled to the benefit of the contractual provision or copyright concerned was the proprietor of the patent¹⁵.

In addition, Crown contractors may be authorised to use technical information, other than that relating to a patented invention, discharged from restrictions imposed by, or obligations to make payments under, agreements with other persons¹⁶.

1 As to the meaning of 'services of the Crown' and 'use for the services of the Crown' see PARA 405 note 3.

2 I.e. anything done under the Patents Act 1977 s 55(1): see PARA 405.

3 As to the meaning of 'patented invention' see PARA 371 note 27.

4 As to the filing of an application see PARA 318.

5 As to licences see PARA 378 et seq.

6 As to assignment see PARA 374.

7 This applies to a licence, assignment or agreement whenever made: see the Patents Act 1977 s 57(2).

8 Patents Act 1977 s 57(2). As to the application of s 57 to EU compulsory licences see para 402.

9 This provision does not release a licensee from an obligation in normal form to pay minimum royalties: cf *No-Nail Cases Pty Ltd v No-Nail Boxes Ltd* [1944] KB 629 at 641, [1944] 1 All ER 528 at 531, 61 RPC 94 at 102, 107, CA, per Du Parc LJ; on appeal [1946] AC 447, [1946] 1 All ER 523, 63 RPC 44, HL.

10 As to copyright see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 54 et seq.

11 As to design right see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 501 et seq.

12 Patents Act 1977 s 57(1) (amended by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 20; and SI 1987/1497). Nothing in the Patents Act 1977 s 57 is to be construed as authorising the disclosure to a government department or any other person of any model, document or information to the use of which this provision applies in contravention of any such licence, assignment or agreement: s 57(10).

13 I.e. the Patents Act 1977 s 55(4): see PARA 406.

14 le the Patents Act 1977 s 58: see PARA 410.

15 See the Patents Act 1977 s 57(9).

16 See the Defence Contracts Act 1958 ss 2, 3, 4; and **WAR AND ARMED CONFLICT** vol 49(1) (2005 Reissue)
PARAS 588-589.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/409. Compensation for loss of profit.

409. Compensation for loss of profit.

Where use is made of an invention for the services of the Crown¹, the government department concerned² must pay:

- 203 (1) to the proprietor of the patent; or
- 204 (2) if there is an exclusive licence³ in force in respect of the patent, to the exclusive licensee⁴,

compensation for any loss resulting from his not being awarded a contract to supply the patented product⁵ or, as the case may be, to perform the patented process⁶ or supply a thing made by means of the patented process⁷.

Compensation is payable only to the extent that such a contract could have been fulfilled from his existing manufacturing or other capacity but is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract⁸.

In determining the loss, regard must be had to the profit which would have been made on such a contract and to the extent to which any manufacturing or other capacity was under-used⁹.

No compensation is payable in respect of any failure to secure contracts to supply the patented product or, as the case may be, to perform the patented process or supply a thing made by means of the patented process, otherwise than for the services of the Crown¹⁰.

The amount payable, if not agreed between the proprietor or licensee and the government department concerned with the approval of the Treasury, must be determined by the court¹¹ on a reference¹² and is in addition to any amount payable under the statutory provisions¹³ relating to the use of patented inventions by the Crown and the rights of third parties in respect of Crown use¹⁴.

1 As to the meaning of 'use for the services of the Crown' see PARA 405 note 3.

2 For these purposes, 'government department concerned', in relation to any use of an invention for the services of the Crown, means the government department by whom or on whose authority the use was made: Patents Act 1977 s 57A(6) (s 57A added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 16(1),(4)).

3 As to the meaning of 'exclusive licence' see PARA 380.

4 As to the meaning of 'exclusive licensee' see PARA 380 note 7.

5 As to the meaning of 'patented product' see PARA 372 note 11.

6 As to the meaning of 'patented process' see PARA 371 note 27.

7 Patents Act 1977 s 57A(1) (as added: see note 2).

8 Patents Act 1977 s 57A(2) (as added: see note 2).

9 Patents Act 1977 s 57A(3) (as added: see note 2).

10 Patents Act 1977 s 57A(4) (as added: see note 2).

- 11 As to the meaning of 'court' see PARA 637 note 1.
- 12 le on reference under the Patents Act 1977 s 58: see PARA 410.
- 13 le under the Patents Act 1977 s 55 (see PARAS 405-406) or s 57 (see PARAS 407-408).
- 14 Patents Act 1977 s 57A(5) (as added: see note 2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/410. Disputes as to Crown use.

410. Disputes as to Crown use.

Any dispute as to:

- 205 (1) the exercise by a government department or a person authorised by a government department of Crown powers¹;
- 206 (2) terms for the use of an invention for the services of the Crown² under those powers³;
- 207 (3) the right of any person to receive any part of a payment⁴ made or agreed to be made or determined by the court⁵; or
- 208 (4) the right of any person to receive a payment for compensation for loss of profit⁶,

may be referred to the court by either party to the dispute after a patent has been granted for the invention⁷. The court may at any time order the whole proceedings or any question or issue of fact arising in them to be referred, on such terms as it may direct, to a judge of the Technology and Construction Court appointed as an arbitrator or to an arbitrator⁸.

In determining any dispute between a government department and any person as to the terms for the use of an invention for the services of the Crown, the court must have regard:

- 209 (a) to any benefit or compensation which that person or any person from whom he derives title may have received or may be entitled to receive directly or indirectly from any government department in respect of the invention in question⁹;
- 210 (b) to whether that person or any person from whom he derives title has in the court's opinion without reasonable cause failed to comply with a request of the department to use the invention for the services of the Crown on reasonable terms¹⁰.

If in such proceedings any question arises as to whether an invention has been recorded or tried so as to exclude any right to compensation¹¹, and the disclosure of any document recording the invention, or of any evidence of its trial, would in the department's opinion be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon¹².

There are special provisions as to compensation in the case of restored lapsed patents¹³; where an amendment of the specification of a patent has been allowed¹⁴; where the validity of a patent¹⁵ is put in issue in the proceedings¹⁶; where there is a European patent (UK)¹⁷; and where an application for a patent has been published¹⁸ but the patent has not yet been granted¹⁹.

There are restrictions on the right of a new proprietor or exclusive licensee²⁰ of a patent under a transaction, instrument or event which is registrable²¹ to compensation in respect of Crown use of the invention before the transaction is registered²².

1 le the powers conferred under the Patents Act 1977 s 55: see PARA 405.

2 As to the meaning of 'use' see PARA 405 note 13; and as to the meaning of 'services of the Crown' see PARA 405 note 3.

3 le as provided for under the Patents Act 1977 s 55(4): see PARA 406.

4 le under the Patents Act 1977 s 57(3)-(7): see PARA 407.

5 le in pursuance of the Patents Act 1977 s 55(4): see PARA 406. As to the meaning of 'court' see PARA 637 note 1.

6 le a payment under the Patents Act 1977 s 57A: see PARA 409.

7 Patents Act 1977 s 58(1) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 16(2)). One of two or more joint proprietors of a patent or application for a patent may refer a dispute to the court without the concurrence of the others, but must not do so unless the others are made parties to the proceedings, but any of the others made a defendant is not liable for any costs or expenses unless he enters an appearance and takes part in the proceedings: Patents Act 1977 s 58(13). As to proceedings before the court see PARA 637 et seq.

In determining whether or not to grant any relief under the Patents Act 1977 s 58(1)(a)-(c) (see heads (1)-(3) in the text) and the nature and extent of the relief granted the court must, subject to s 58(5)-(13), apply the principles applied by the court to the granting of relief under the Patents Act 1949 s 48: Patents Act 1977 s 58(4) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 16(2)). See *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693, affd [1999] RPC 442, [1998] All ER (D) 545, where the Crown successfully resisted a claim to compensation by seeking revocation on the ground that it was the true owner or co-owner of the patent.

8 Patents Act 1977 s 58(12); CPR 60.1(4). References to the court in these provisions are to be construed accordingly: s 58(12). As to judges of the Technology and Construction Court see **ARBITRATION** vol 2 (2008) PARA 1226.

9 Patents Act 1977 s 58(3)(a).

10 Patents Act 1977 s 58(3)(b).

11 le under the Patents Act 1977 s 55(3): see PARA 406.

12 Patents Act 1977 s 58(2).

13 The court may refuse to grant relief by way of compensation in respect of the use of an invention for Crown services during any further period specified under the Patents Act 1977 s 25(4) (see PARA 340), but before the payment of the renewal fee and any prescribed additional fee: s 58(5). As to the restoration of lapsed patents see PARA 356.

14 Where an amendment of the specification of a patent has been allowed under any of the provisions of the Patents Act 1977, the court may not grant relief by way of compensation under s 58 in respect of any such use before the decision to allow the amendment unless the court is satisfied that: (1) the specification of the patent as published was framed in good faith and with reasonable skill and knowledge; and (2) the relief is sought in good faith: s 58(6) (amended by the Patents Act 2004 s 2(2)(a)). As to such amendments see PARA 347.

15 As to the validity of a patent see PARA 426 et seq.

16 If it is found that the patent is only partially valid, the court may grant relief to the proprietor of the patent in respect of that part which is found to be valid and to have been used for Crown services: Patents Act 1977 s 58(7).

Where in any such proceedings it is found that a patent is only partially valid, the court may not grant relief by way of compensation, costs or expenses except where the proprietor of the patent proves that: (1) the specification of the patent was framed in good faith and with reasonable skill and knowledge; and (2) the relief is sought in good faith, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses and as to the date from which compensation should be awarded: s 58(8) (amended by the Patents Act 2004 s 2(2)(b)). As a condition of any such relief the court may direct that the specification of the patent must be amended to its satisfaction upon an application made for that purpose under the Patents Act 1977 s 75 (see PARA 348), and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined: s 58(9).

17 The court may grant such relief in the case of a European patent (UK) on condition that the claims of the patent are limited to its satisfaction by the European Patent Office at the request of the proprietor: Patents Act 1977 s 58(9A) (added by the Patents Act 2004 s 3(2)). See also the Patents Act 1977 s 77(3); and PARA 675. As to the meaning of 'European patent (UK)' see PARA 675 note 1. As to European patents generally see PARA 668 et seq.

18 As to publication of the application see PARA 327.

19 In considering the amount of any compensation for the use of an invention for the services of the Crown after publication of an application for a patent for the invention and before such a patent is granted, the court must consider whether or not it would have been reasonable to expect, from a consideration of the application as published under the Patents Act 1977 s 16 (see PARA 327), that a patent would be granted conferring on the proprietor of the patent protection for an act of the same description as that found to constitute that use; and, if the court finds that it would not have been reasonable, it must reduce the compensation to such amount as it thinks just: s 58(10).

20 As to the meaning of 'exclusive licensee' see PARA 380 note 7.

21 Is a transaction, instrument or event to which the Patents Act 1977 s 33 applies: see PARAS 588-589.

22 No compensation is payable unless: (1) the transaction, instrument or event is registered within the period of six months beginning with its date; or (2) the court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter: Patents Act 1977 s 58(11) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 16(3)).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/5. LICENCES AND CROWN USE/(5) CROWN USE OF PATENTED INVENTIONS/411. Special provisions as to Crown use during emergency.

411. Special provisions as to Crown use during emergency.

During any period of emergency¹ the powers exercisable in relation to an invention by a government department or a person authorised by a government department² include power to use the invention³ for any purpose which appears to the department necessary or expedient:

- 211 (1) for the efficient prosecution of any war in which Her Majesty may be engaged;
- 212 (2) for the maintenance of supplies and services essential to the life of the community;
- 213 (3) for securing a sufficiency of supplies and services essential to the well-being of the community;
- 214 (4) for promoting the productivity of industry, commerce and agriculture;
- 215 (5) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;
- 216 (6) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
- 217 (7) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory outside the United Kingdom⁴ which is in grave distress as the result of war⁵.

¹ For these purposes, 'period of emergency' means any period beginning with such date as may be declared by Order in Council to be the commencement, and ending with such date as may be so declared to be the termination, of a period of emergency for the purposes of these provisions: Patents Act 1977 s 59(3). A draft of such an Order may not be submitted to Her Majesty unless it has been laid before, and approved by resolution of, each House of Parliament: s 59(4).

² ie under the Patents Act 1977 s 55: see PARA 405.

³ For these purposes, the use of an invention includes, in addition to any act constituting such use by virtue of the Patents Act 1977 s 55 (see PARAS 405-406), any act which would, apart from s 55 and s 59, amount to an infringement of the patent concerned (see PARA 500 et seq) or, as the case may be, give rise to a right under s 69 to bring proceedings in respect of the application concerned (see PARAS 548-549); and any reference in the Patents Act 1977 to 'use for the services of the Crown' is, as respects any period of emergency, to be construed accordingly: s 59(2).

⁴ As to the meaning of 'United Kingdom' see PARA 303 note 5.

⁵ Patents Act 1977 s 59(1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(1) THE SPECIFICATION/412. General rule.

6. CONSTRUCTION OF SPECIFICATION AND CLAIMS

(1) THE SPECIFICATION

412. General rule.

No special rules are applicable to the construction of the specification¹ of a patent². As the specification is addressed to the person skilled in the art³, the court must be instructed as to the meaning of technical terms and the background of the art, so as to read the specification with the understanding of the person skilled in the art⁴. The question of construction is necessarily antecedent to the determination of the issue of infringement⁵ and of all issues of validity⁶ depending upon the scope of the claims⁷.

1 As to the specification see PARA 319.

2 *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 at 185. As to the general rules for construction of documents see **DEEDS AND OTHER INSTRUMENTS** vol 13 (2007 Reissue) PARA 164 et seq.

3 *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 at 185. As to an addressee of a specification see PARA 492.

4 See *American Cyanamid Co v Ethicon Ltd* [1979] RPC 215; *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 at 185. When determining the meaning to be given to technical words in a patent specification, there is no rebuttable presumption that the words be given a technical meaning; *Hoechst Celanese Corp v BP Chemicals Ltd* [1999] FSR 319, CA.

5 As to proceedings for infringement see PARA 521 et seq.

6 As to the validity of patents see PARA 426 et seq.

7 In consequence, substantially all patent actions exemplify the practice of the courts in construing specifications. It has been stated that it is unnecessary and usually undesirable to refer to decisions prior to *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 237, HL: see *Codex Corp v Racal-Milgo Ltd* [1983] RPC 369, CA; *C Van der Lely NV v Ruston's Engineering Co Ltd* [1985] RPC 461, CA. The modern approach is to regard *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 as setting out the proper approach: see *Research in Motion UK Ltd v Inpro Licensing SARL* [2006] EWHC 70 (Pat), [2006] RPC 517, [2006] All ER (D) 150 (Feb); *Ranbaxy UK Ltd v Warner-Lambert Co* [2005] EWHC 2142 (Pat), [2006] IP & T 336, [2005] All ER (D) 124 (Oct) (affd [2006] EWCA Civ 876, [2007] RPC 65, [2006] All ER (D) 322 (Jun)); *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1040 (Pat), [2007] RPC 729, [2007] All ER (D) 87 (May) (affd [2008] EWCA Civ 311, 101 BMLR 52, [2008] All ER (D) 152 (Apr)). As to the construction of claims see PARA 415; and as to claims generally see PARAS 324-325.

UPDATE

412 General rule

NOTE 7--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] IP & T 496.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(1) THE SPECIFICATION/413. Construction.

413. Construction.

A specification¹ is construed neither in favour of nor against the proprietor of the patent². It should be so construed as not to lead to a foolish result or one which the proprietor could not have contemplated³; for example, the court will tend to avoid constructions which would make the claim⁴ cover what the specification admits to be old⁵ or is the negation of the whole point of the invention⁶.

1 As to the specification see PARA 319.

2 *Assidoman Multipack Ltd v Mead Corpn* [1995] RPC 321 at 332, CA; *BASF v Smithkline Beecham plc* [2003] EWCA Civ 872, [2003] RPC 855 at 881.

3 *Electric and Musical Industries Ltd v Lissen Ltd* [1938] 4 All ER 221 at 224, 56 RPC 23 at 39, HL, per Lord Russell of Killowen; *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331 at 342; *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369; *Wesley Jessen Corpn v Coopervision Ltd* [2003] RPC 355, Patents County Court.

4 As to claims generally see PARAS 324-325.

5 See *Tubes Ltd v Perfecta Seamless Steel Tube Co Ltd* (1902) 20 RPC 77 at 95, HL; *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1040 (Pat), [2007] RPC 729, [2007] All ER (D) 87 (May) (affd [2008] EWCA Civ 311, 101 BMLR 52, [2008] All ER (D) 152 (Apr)); but cf note 6. It must also be construed so as to avoid prior art: *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295, 55 RPC 31 at 39; *Glaverbel SA v British Coal Corpn* [1995] RPC 255 at 270, CA.

6 See *Ranbaxy UK Ltd v Warner-Lambert Co* [2006] EWCA Civ 876 at [49], [2007] RPC 65 at [49], [2006] All ER (D) 322 (Jun) at [49]. If, however, such a construction is the correct one, it must be adopted: *Cleveland Graphite Bronze Co and Vandervell Products Ltd v Glacier Metal Co Ltd* (1949) 66 RPC 157 at 161, CA, per Greene MR; approved (1950) 67 RPC 149 at 153, HL.

UPDATE

413 Construction

NOTE 5--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] IP & T 496.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(1) THE SPECIFICATION/414. Reading of specification as a whole.

414. Reading of specification as a whole.

The specification¹ is to be read as a whole, including any drawings²; the claims are only a part of the specification (although a part having a special function³), and in no sense comprise a separate document⁴. The body of the specification should be read first⁵. The title is part of the specification for the purposes of construction⁶. In reading a specification, a distinction must be drawn between introductory statements as to the purpose of the invention or the class of apparatus to which it relates and the description of the invention itself⁷.

1 As to the specification see PARA 319.

2 See the Patents Act 1977 s 125(1); and PARA 301 note 2. As to drawings see PARA 320.

3 In order to delineate the patentee's monopoly: *Rockwater v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 919 at 951, [2005] IP & T 304; *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 at 182; *Assidoman Multipack Ltd v Mead Corpn* [1995] RPC 321 at 332; *BASF v Smithkline Beecham plc* [2003] EWCA Civ 872, [2003] RPC 855 at 881; *Electric and Musical Industries Ltd v Lissen Ltd* (1937) 54 RPC 307 at 322, CA (on appeal [1938] 4 All ER 221, 56 RPC 23, HL).

4 *Electric and Musical Industries Ltd v Lissen Ltd* [1938] 4 All ER 221 at 224-225, 56 RPC 23 at 39, HL, per Lord Russell of Killowen.

5 *Arnold v Bradbury* (1871) 6 Ch App 706; *Tubes Ltd v Perfecta Seamless Steel Tube Co Ltd* (1900) 17 RPC 569.

6 See *Newton v Vaucher* (1852) 21 LJ Ex 305; *Oxley v Holden* (1860) 30 LJCP 68; *Mullard Radio Valve Co Ltd v Philco Radio and Television Corpn* [1936] 2 All ER 920, 53 RPC 323, HL. As to the title generally see PARA 319 note 3.

7 *Dudgeon v Thomson* (1877) 3 App Cas 34 at 40, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/415.
Construction of claims.

(2) THE CLAIMS

415. Construction of claims.

The scope of protection conferred by a patent is, unless the context otherwise requires, that specified in a claim¹ of the specification of the patent². The specification must, however, be read as a whole, through the eyes of the person skilled in the art³, because thereby the necessary background of the words used in the claims may be affected or defined by what is said in the body of the specification⁴. The specification should be given a purposive construction rather than a purely literal one derived from the application of meticulous verbal analysis⁵. The specification is concerned with what the skilled person would have understood the patentee to mean. What the patentee would have been understood to mean depends not only on the words he has chosen but also on the identity of the audience he is taken to have been addressing and the knowledge and assumptions attributed to that audience. The skilled person comes to a reading of the specification with the common general knowledge of the art and reads the specification on the assumption that its purpose is both to describe and to demarcate an invention. Purposive construction does not mean that there is an extension of or a going beyond the definition of the technical matter for which the patentee sought protection in the claims. The question is always what the person skilled in the art would have understood the patentee to mean⁶.

The aim of purposive construction is to determine which features were put forward by the patentee, by the language of the claims, as the essential features of the invention and, in particular, whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used would understand that strict compliance with particular words or phrases of the claim was intended by the proprietor of the patent to be essential; only where this is the intention will the patent be avoided by variants having no material effect on the way the invention works⁷.

A guideline as to interpretation is provided by the Protocol on the Interpretation of Article 69 of the European Patent Convention 2000⁸. The Protocol declares, in its English text⁹, that the corresponding provision of the convention¹⁰ is not to be interpreted in the sense that the extent of protection conferred by the patent is that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the proprietor of the patent has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the proprietor with a reasonable degree of certainty for third parties. The purposive construction now applied by the court¹¹ is the same approach to construction as set out in the Protocol¹². The Protocol, in its English text, also states that for the purpose of determining the protection conferred by a European patent, due account must be taken of any element which is equivalent to an element specified in the claims¹³.

Where there is a statement in the specification of the advantages of an invention¹⁴, or of the difficulties which it overcomes¹⁵, a claim may be read as limited to forms having these advantages or adapted to meet these difficulties¹⁶.

- 1 As to claims generally see PARAS 324-325.
- 2 See the Patents Act 1977 s 125(1); and PARA 301 note 2.
- 3 As to persons skilled in the art see PARA 492.
- 4 See eg *Insituform Technical Services Ltd v Inliner UK plc* [1992] RPC 83 at 90; *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369 at 385; *M-Systems Flash Disk Pioneers Ltd v Trek 2000 International Ltd* [2008] EWHC 102 (Pat), [2008] RPC 18, [2008] All ER (D) 201 (Jan).
- 5 *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 243, HL.
- 6 *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46 at [32]-[34], [2005] 1 All ER 667 at [32]-[34], [2005] RPC 169 at 185-186 per Lord Hoffmann.
- 7 *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 237, HL. It has been stated, however, that it is unnecessary and usually undesirable to refer to decisions prior to *Catnic Components Ltd v Hill & Smith Ltd*: see *Codex Corp v Racal-Milgo Ltd* [1983] RPC 369, CA; *C Van der Lely NV v Ruston's Engineering Co Ltd* [1985] RPC 461, CA. The modern view is to regard *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 as setting out the proper approach: see PARA 412 note 7.
- 8 Patents Act 1977 s 125(3), which applies the Protocol for the purposes of s 125. See the Protocol art 1. The Protocol to Article 69 of the European Patent Convention 2000 came into effect on 13 December 2007. It applied prospectively and also to European patent applications pending at that date and to European patents already granted at that date: [2007] OJ EPO Special Edition 1, p 197. As to the European Patent Convention see PARA 668 et seq.
- 9 See the Protocol art 1; and note 8. The French and German texts seem broadly equivalent.
- 10 Ie the European Patent Convention art 69, with which the Patents Act 1977 s 125(1) largely corresponds.
- 11 Ie that in *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 237, HL; *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169.
- 12 See the Protocol art 1; and note 8. *Improver Corp v Remington Consumer Products Ltd* [1989] RPC 69 at 76, CA; *Southco Inc v Dzus Fastener Europe Ltd* [1992] RPC 299 at 312, CA, per Purchas LJ; *Horne Engineering Co Ltd v Reliance Water Controls Ltd* [2000] RPC 9, [2000] FSR 90; *Assidoman Multipack Ltd v Mead Corp* [1995] RPC 321, CA; *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169.
- 13 See the Protocol art 2; and note 8. It is not clear to what extent the Protocol art 2 will result in an alteration of the approach of the English courts to infringement but *Rockwater v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 919 at 951, [2005] IP & T 304 is no longer good law on this point. See also *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 at 190, where it was held that equivalence might be an important part of the background of facts known to the skilled addressee which would affect what he understood the claims to mean.
- 14 See *M-Systems Flash Disk Pioneers Ltd v Trek 2000 International Ltd* [2008] EWHC 102 (Pat), [2008] RPC 18, [2008] All ER (D) 201 (Jan). These advantages must, however, be distinctly set out: see *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 259 at 291, CA; on appeal (1935) 52 RPC 171 at 193, HL.
- 15 *Jackson v Wolstenhulmes* (1884) 1 RPC 105, CA; *Clay v Allcock & Co Ltd* (1906) 23 RPC 745 at 750, CA.
- 16 Cf *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 133-138, CA; affd [1948] 1 All ER 308, 65 RPC 141, HL.

UPDATE

415 Construction of claims

NOTES--See *Ancon Ltd v ACS Stainless Steel Fixings Ltd* [2009] EWCA Civ 498, [2009] All ER (D) 148 (Jun).

NOTE 6--See also *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd* [2009] EWCA Civ 1062, [2009] All ER (D) 235 (Oct).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/416. Unworkable embodiments.

416. Unworkable embodiments.

It is uncertain to what extent a claim which is clear in its terms may be read as excluding forms of the invention which the addressee would know to be unworkable¹. A claim should be read so as to avoid if possible an absurd result².

¹ See eg *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331. Cf the cases cited in PARA 415 notes 2-3.

² *Henriksen v Tallon Ltd* [1965] RPC 434, HL; *Wesley Jessen Corp v Coopervision Ltd* [2003] RPC 355, Patents County Court.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/417. Specification its own dictionary.

417. Specification its own dictionary.

To a large extent the specification¹ is treated as supplying its own dictionary², that is to say, where it is clear from the body of the specification that the proprietor of a patent has used a term in his claims in a particular sense, it will be interpreted in that sense, even if it is not the ordinary sense of the term³. The question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean⁴.

1 As to the specification see PARA 319.

2 *Electric and Musical Industries Ltd v Lissen Ltd* (1937) 54 RPC 307 at 322, CA; on appeal [1938] 4 All ER 221 at 227, 56 RPC 23 at 41, CA, per Lord Russell of Killowen.

3 *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183, HL (meaning of 'vertical'); *Rockwater v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 919 at 950, [2005] IP & T 304.

4 *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46 at [34], [2005] 1 All ER 667 at [34], [2005] RPC 169 at 186 per Lord Hoffmann. As to persons skilled in the art see PARA 492.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/418. Admissions in specification.

418. Admissions in specification.

It is uncertain to what extent the proprietor of a patent is bound by erroneous admissions in his specification¹ as to what is old². It is also uncertain whether the description of an invention as 'relating to' devices of a certain sort amounts to an admission that such devices are old³. To claim an invention as consisting in the presence of certain additional features in articles of a certain 'type' does not debar the proprietor from asserting that the invention is a combination of all the features together, including those of the 'type'⁴. Reference to an integer of a combination as being 'of the kind known per se in which . . . ' admits that things of that kind are well known⁵.

1 As to the specification see PARA 319.

2 *Sonotone Corpn v Multitone Electric Co Ltd* (1955) 72 RPC 131 at 140, CA, discussing *Chapman and Cook and Lectro Linx Ltd v Deltavis Ltd* (1930) 47 RPC 163 at 173. A patentee is not estopped from contradicting an erroneous statement in a specification on which another party has not relied: *Gerber Garment Technology Inc v Lectra Systems Ltd* [1995] FSR 492, CA.

3 *Sonotone Corpn v Multitone Electric Co Ltd* (1955) 72 RPC 131 at 139-140, CA.

4 *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 140, HL.

5 *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63 at 71, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/419. Reference to original specification.

419. Reference to original specification.

The full history of the specification¹ from the version originally filed is available for inspection². Statements made to the UK Intellectual Property Office³ during prosecution may amount to admissions against interest⁴.

1 As to the specification see PARA 319.

2 See the Patents Act 1977 s 118; and PARA 581.

3 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 *Furr v CD Truline (Building Products) Ltd* [1985] FSR 553 at 563; *Wesley Jessen Corpn v Coopervision Ltd* [2003] RPC 355 at 382, Patents County Court. However, it is not permissible to have regard to arguments before the European Patent Office in opposition proceedings: *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169. As to the relevance of file history see *Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals Inc* [2000] IP & T 908, [1999] RPC 253 at 274, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/420. Effect of claims 'for' a particular use or purpose.

420. Effect of claims 'for' a particular use or purpose.

Claims¹ to an article 'for' a particular use or purpose may give rise to considerable difficulty. Such a claim cannot have novelty over a disclosure of the same article 'for' another purpose² except where the article is invented for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body³. It is, however, uncertain to what extent such a claim covers articles intended to be used for a different purpose or in a different way⁴. 'For' may mean 'suitable for'⁵. A claim 'for use in' is a mere statement of intent and does not clearly define the invention as required⁶.

1 As to claims generally see PARAS 324-325.

2 *Adhesive Dry Mounting Co Ltd v Trapp & Co* (1910) 27 RPC 341; *Furr v CD Truline (Building Products) Ltd* [1985] FSR 553.

3 See the Patents Act 1977 s 4A; and PARA 433.

4 See *Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496 at 505, 7 RPC 292 at 306, HL; *Lyon v Goddard* (1894) 11 RPC 113; *Re l'Air Liquide SA's Application* (1932) 49 RPC 428; *Berkeley and Young Ltd and Goodman Ltd v Stillwell, Darby & Co Ltd and Konig* (1940) 57 RPC 291. Cf *Mullard Radio Valve Co Ltd v Philco Radio and Television Corpn* [1936] 2 All ER 920, 53 RPC 323, HL (claim to process to be carried out with certain apparatus).

5 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 137, CA (on appeal [1948] 1 All ER 308, 65 RPC 141, HL); *Insituform Technical Services Ltd v Inliner UK plc* [1992] RPC 83.

6 Ie under the Patents Act 1977 s 14(5)(a), (b) (see PARA 319 heads (a), (b)): *El du Pont de Nemours & Co (Buege's) Application* [1984] RPC 17.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/421. Claims in different language.

421. Claims in different language.

The ordinary rule is to construe claims¹ couched in different language as not being co-extensive². This is, however, by no means an absolute rule³, and there have been cases in which, by reason of the wording of the specification or the subject matter of the patent, each of a series of claims has been construed as being practically identical⁴.

¹ As to claims see PARAS 324-325.

² *Multiform Displays Ltd v Whitmarley Displays Ltd* [1956] RPC 143 at 161, CA (per Romer LJ dissenting; upheld [1957] RPC 260, HL), citing *Parkinson v Simon* (1894) 11 RPC 493, CA (affd (1895) 12 RPC 403 at 407, HL).

³ It is not a ground for invalidating a specification that it claims the same thing over again in different language: *Van Berkel v RD Simpson Ltd* (1906) 24 RPC 117 at 137. See also *Wenham Gas Co Ltd v Champion Gas Lamp Co* (1891) 9 RPC 49 at 55, CA; *Edison-Bell Phonograph Corp Ltd v Smith* (1894) 10 TLR 522, 11 RPC 389, CA; *New Vacuum Heating Co Ltd v Steel and Wilson* (1915) 32 RPC 162 at 171; *S Parkes & Co Ltd v Cocker Bros Ltd* (1929) 46 RPC 241 at 247, CA.

⁴ See eg *Thompson & Co v American Braided Wire Co* (1888) 5 TLR 537, 6 RPC 518, HL; *Duckett Ltd v Whitehead* (1895) 12 RPC 187 (affd 12 RPC 376, CA, where the whole of the claims were interpreted as for the special combination); *Brown v Sperry Gyroscope Co Ltd* (1925) 42 RPC 111 (affd 43 RPC 1, CA); *Mergenthaler Linotype Co v Intertype Co Ltd* (1926) 42 TLR 682, 43 RPC 239, CA; *Submarine Signal Co v Henry Hughes & Son Ltd* (1931) 49 RPC 149; *British Hartford-Fairmont Syndicate Ltd v Jackson Bros (Knottingley) Ltd* (1932) 49 RPC 495 at 525, CA (affd (1934) 51 RPC 254 at 261-262, HL); *Cowper v Paper Sacks Pty Ltd* [1932] AC 709, 49 RPC 601, PC. As to the competing languages of the patent and its translation see *Siemens Schweiz AG v Thorn Security Ltd* [2007] EWHC 2242 (Ch) at [10]-[12], [2007] All ER (D) 61 (Oct) at [10]-[12], [2008] RPC 58 at [10]-[12] per Mann J.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/422. Effect of the expression 'substantially as described'.

422. Effect of the expression 'substantially as described'.

It was formerly customary to end claims¹ with such phrases as 'substantially as described' or 'substantially as and for the purpose described'. In such a case, these words will be read as importing into the claims the limitation, upon the features listed in the claim, that they should have those characteristics set out as essential for them in the body of the specification². The modern practice is, however, to include only one or at most a few such claims, following upon broad claims without such words; and to include in them express references to the drawings or examples in the specification, if any. In such cases, the presumption is that the claim to the invention 'substantially as described' is meant to be a narrow claim, limited to things possessing all the features set out in the specification as essential or important to the invention³. Not every limitation found in earlier claims is necessarily to be imported into a claim to the drawings⁴, and a feature only to be found in the drawings⁵, or said in the body of the specification to be preferable only⁶, will seldom be so imported.

1 As to claims see PARAS 324-325.

2 See *Parkinson v Simon* (1894) 11 RPC 493, CA; affd (1895) 12 RPC 403, HL.

3 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* [1948] 1 All ER 308 at 320-321, 65 RPC 141 at 157-158, HL, per Lord Moreton of Henryton; cf *Daikin Kogyo Co Ltd (Shingu's) Application* [1974] RPC 559, CA (where a claim to a process 'substantially as hereinbefore described, with particular reference to examples 2 and 3' was construed as a claim to a single process capable of being carried out within certain limits of variation and not as a claim to a number of alternate processes). See also *Rotocrop International Ltd v Genbourne Ltd* [1982] FSR 241.

4 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* [1948] 1 All ER 308 at 323, 65 RPC 141 at 160, HL, per Lord Moreton of Henryton.

5 *Clark v Adie* (1877) 2 App Cas 315 at 342, HL; *Hinks & Son v Safety Lighting Co* (1876) 4 ChD 607; *Crosthwaite v Moorwood, Sons & Co* (1894) 11 RPC 555 at 561; *Tolson and Tolson v John Speight & Sons* (1896) 13 RPC 718; *Palmer Tyre Ltd v Pneumatic Tyre Co Ltd* (1899) 16 RPC 451 at 480; *British Motor Traction Co Ltd v Friswell* (1901) 18 RPC 497; *Re Scott's Patent* (1903) 20 RPC 257, CA; *Rhodes and Edmondson v British Cotton and Wool Dyers Association Ltd* (1910) 28 RPC 67. In *George Hattersley & Sons Ltd v George Hodgson Ltd* (1906) 23 RPC 192, HL, it was held that the invention should be confined to the exact form shown in the drawings in order to meet the objection of non-utility.

6 *Gammons v Battersby* (1904) 21 RPC 322, CA; *Clay v Allcock & Co Ltd* (1906) 23 RPC 745, CA; *Walsh v Albert Baker & Co* (1898) Ltd (1930) 47 RPC 458, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/423. Single claims.

423. Single claims.

Generally a single claim¹ is construed as comprising a single invention, unless it is clear from the specification that the contrary is intended². In chemical cases a claim to a generic class of compounds may be construed as a claim to a number of sub-classes or indeed as a set of claims to specific individual compounds falling within the class³.

¹ As to claims see PARAS 324-325.

² Eg it is a matter of construction whether a claim is directed to a racemate, one or more enantiomers, or both: *Ranbaxy UK Ltd v Warner-Lambert Co* [2006] EWCA Civ 876, [2007] RPC 65, [2006] All ER (D) 322 (Jun); *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1040 (Pat), [2007] RPC 729, [2007] All ER (D) 87 (May) (affd [2008] EWCA Civ 311, 101 BMLR 52, [2008] All ER (D) 152 (Apr)). A patent may relate to a group of inventions which are linked to form a single inventive concept: see the Patents Act 1977 s 14(5)(d); and PARA 319 head (d). Where more than one invention is specified in a claim, each invention may have a different priority date: see the Patents Act 1977 s 125(2); and PARA 309.

³ See *Merck & Co (Macek's) Patent* [1967] RPC 157; *Ethyl Corpn (Cook's) Patent* [1970] RPC 227; *Imperial Chemical Industries Ltd (Howe's) Application* [1977] RPC 121; *Allen and Hanburys (Hayes') Application* [1977] RPC 113.

UPDATE

423 Single claims

NOTE 2--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] IP & T 496.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/424. Interpretation of 'or'.

424. Interpretation of 'or'.

The word 'or' is generally interpreted as disjunctive¹. In a number of cases the word has, however, been interpreted as merely introducing another definition of a technical term².

¹ *Elliott v Turner* (1845) 15 LJCP 49; *Simpson v Holliday* (1866) LR 1 HL 315. In *British United Shoe Machinery Co Ltd v Standard Rotary Machine Co Ltd* (1916) 33 RPC 373, CA (on appeal (1917) 35 RPC 33, HL), a claim for certain integers 'with or without' another integer was held bad, although it was admittedly obvious that the apparatus could not act without this integer or its equivalent. Cf *Higginson and Arundel v Pyman* (1926) 43 RPC 291 at 298, CA.

² *Hills v London Gas Light Co* (1860) 29 LJ Ex 409; *Hills v Liverpool United Gaslight Co* (1862) 32 LJ Ch 28 ('hydrated or precipitated oxides of iron'); *Kaye v Chubb & Sons Ltd* (1886) 5 RPC 641, HL; *White v Bertrams Ltd* (1897) 14 RPC 735 ('in line with or parallel to'); *Patent Exploitation Ltd v Siemens Bros & Co Ltd* (1904) 21 RPC 541 at 547; *Patent Exploitation Ltd v American Electrical Novelty and Manufacturing Co Ltd* (1905) 22 RPC 316, CA ('semi-solid or plastic'); *Flour Oxidizing Co Ltd v Hutchinson* (1909) 26 RPC 597 ('conditioning or improving').

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/6. CONSTRUCTION OF SPECIFICATION AND CLAIMS/(2) THE CLAIMS/425. Effect of former decisions.

425. Effect of former decisions.

A court is bound by a decision of a court of equal or superior status on the construction of a specification¹ and the breadth of the claims made in it² except, possibly, where that decision turns in a material respect on evidence which was either lacking in a previous case or which was materially different in the case before it³. It has also been held that such decisions are binding with respect to the question whether a specification is too vague or unintelligible to be construed by the court, but that they are not binding with respect to the question whether the proprietor of the patent has sufficiently described the nature of and the manner in which the invention is to be performed⁴ or anticipation by specific documents not before the court when the earlier decision was given⁵. A decision of the comptroller⁶ or on appeal from him⁷ does not estop any party to civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the available grounds of revocation⁸ whether or not any of the issues involved were decided in that decision⁹.

1 As to the specification see PARA 319.

2 *Hills v Liverpool United Gaslight Co* (1862) 32 LJ Ch 28; *Otto v Steel* (1885) 3 RPC 109; *Edison and Swan United Electric Light Co Ltd v Holland* (1889) 41 ChD 28, 6 RPC 243, CA; *British Vacuum Co Ltd v Exton Hotels Co Ltd* (1908) 25 RPC 617.

3 *Novartis AG v Dexcel-Pharma Ltd* [2008] EWHC 1266 (Pat), [2008] All ER (D) 97 (Jun).

4 *Edison and Swan United Electric Light Co Ltd v Holland* (1889) 41 ChD 28, CA.

5 *Higginson and Arundel v Pyman* (1926) 43 RPC 291, CA. See also *Coflexip SA v Stolt Offshore MS Ltd (No 2)* [2004] EWCA Civ 213, [2004] FSR 708. As to judicial decisions as authorities generally see **CIVIL PROCEDURE** vol 11 (2009) PARA 91 et seq.

6 As to the comptroller see PARA 577.

7 As to appeals generally see PARA 572 et seq.

8 I.e. under the Patents Act 1977 s 72 (see PARA 564).

9 Patents Act 1977 s 72(5).

UPDATE

425 Effect of former decisions

NOTE 3--*Novartis*, cited, reported at [2008] FSR 773.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(1) INTRODUCTION/426. Validity of patents generally.

7. VALIDITY

(1) INTRODUCTION

426. Validity of patents generally.

The grounds on which patents may be revoked¹ are listed in the Patents Act 1977². A patent may be revoked on the application of any person³. The Patents Act 1977 refers to patents as 'valid' or 'invalid', assuming, without so stating, that an 'invalid' patent is one that may be so revoked and a 'valid' patent is one that may not⁴. The grounds of invalidity of a patent are that the invention is not new⁵, is obvious⁶, is incapable of industrial application⁷, is not an invention as defined by the Patents Act 1977⁸, is socially objectionable⁹, is a method of treatment or diagnosis¹⁰, the specification is insufficient¹¹, the matter disclosed in the specification extends beyond that disclosed in the application for the patent as filed¹² or the protection conferred by the patent has been extended by an unallowable amendment¹³.

1 As to proceedings for revocation see PARA 564 et seq.

2 See the Patents Act 1977 s 72(1); and PARA 430.

3 See the Patents Act 1977 s 72(1); and PARA 430. See *Oystertec's Patent* [2002] EWHC 2324 (Pat), [2003] RPC 559.

4 The additional ground of revocation open only to the comptroller under the Patents Act 1977 s 73(2) (see PARA 571) is not in general within the expression 'invalidity'. As to the comptroller see PARA 577. Further, by reason of s 74(4) (see PARA 520), a patent may be invalid only as against particular persons with a better title to it than its proprietor.

5 See PARA 435 et seq.

6 See PARA 452 et seq.

7 See PARA 488.

8 See PARA 301 et seq.

9 See PARA 431.

10 See PARA 433.

11 See PARA 490 et seq.

12 See PARA 498.

13 See PARA 499.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(1) INTRODUCTION/427. Partial invalidity.

427. Partial invalidity.

Most of the objections to the validity of patents are objections to particular claims of the specification¹. A patent may thus be partially invalid because one or more claims are open to objection, although other claims are valid².

1 As to the specification generally see PARA 319. As to claims and their function see PARAS 324-325.

2 As to the consequences of invalidity of some claims see the Patents Act 1977 s 63 (see PARA 552) and s 72(4) (see PARA 564).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(1) INTRODUCTION/428. Curing invalidity.

428. Curing invalidity.

Invalidity of patents may be curable by amendment of the specification¹, either before, during or after proceedings for infringement, or for revocation of the patent².

¹ As to the amendment of specifications see PARA 346 et seq.

² As to the effect of amendment on the relief obtainable in proceedings for infringement see PARA 549. However, post-trial amendments by way of claim rewriting are not normally permitted as the validity of the new claims could be the subject of significant further debate which could necessitate a new trial: *Nikken Kosakusho Works v Pioneer Trading Co* [2005] EWCA Civ 906, [2005] All ER (D) 350 (Jun), [2006] FSR 41; *Vector Corp v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(1) INTRODUCTION/429. Grant does not warrant validity.

429. Grant does not warrant validity.

The examination of specifications¹ and investigation of the novelty² of the inventions claimed by them, and of the inventive step³ claimed by the specification, carried out by the UK Intellectual Property Office⁴ before granting a patent, do not warrant the validity of the patent, but a granted patent is prima facie valid⁵.

1 As to the specification see PARA 319.

2 As to novelty see PARA 435 et seq.

3 As to the inventive step see PARA 452 et seq.

4 I.e. under the Patents Act 1977 ss 17, 18 (see PARAS 328-329). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

5 *American Cyanamid Co v Ethicon Ltd* [1975] AC 396, [1975] 1 All ER 504, [1975] RPC 513, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(i) In general/430. Grounds of invalidity.

(2) VALIDITY AND INVALIDITY

(i) In general

430. Grounds of invalidity.

A patent may be revoked on any of the following grounds¹:

- 218 (1) that there is no patentable invention², that is say:
13
 - 20. (a) that the invention was not new³;
 - 21. (b) that the invention did not involve an inventive step⁴;
 - 22. (c) that the invention was incapable of industrial application⁵;
 - 23. (d) that it was not an invention as defined by the Patents Act 1977⁶;
 - 24. (e) that it was contrary to public policy or morality⁷;
- 14
- 219 (2) that the patent specification is insufficient⁸;
- 220 (3) that the patent specification has been amended⁹ so as to extend either the disclosure¹⁰ in it or the protection conferred by it¹¹.

A patent may be revoked on the application of particular persons on the ground that the patent was granted to a person not entitled to be granted that patent¹². These grounds of invalidity are exclusive¹³.

Further, a patent may be liable to revocation by the comptroller¹⁴ of his own motion on the ground that there is also a European patent (UK)¹⁵ for the same invention¹⁶.

1 Patents Act 1977 s 74(3).

2 See the Patents Act 1977 s 72(1)(a); and PARA 431. 'Patentable invention' means any invention in which the conditions specified in s 1(1)(a)-(d) are satisfied: s 1(1).

3 See the Patents Act 1977 ss 1(1)(a), 2; and PARA 435.

4 See the Patents Act 1977 ss 1(1)(b), 3; and PARA 452.

5 See the Patents Act 1977 ss 1(1)(c), 4; and PARA 488.

6 See the Patents Act 1977 s 1(1)(d), (2); and PARA 431.

7 See the Patents Act 1977 s 1(1)(d), (3), (4); and PARA 431.

8 See the Patents Act 1977 s 72(1)(c); and PARA 490.

9 As to the amendment of specifications see PARA 346 et seq.

10 See the Patents Act 1977 s 72(1)(d); and PARA 498.

11 See the Patents Act 1977 s 72(1)(e); and PARA 499.

12 See the Patents Act 1977 s 72(1)(b); and PARA 489.

13 Patents Act 1977 s 74(3). In particular a patent cannot be revoked on the ground that the claims are not supported by the description as required by s 14(5) (see PARA 319): *Genentech Inc's Patent* [1989] RPC 147 at 198, CA, per Purchas LJ, at 236 per Dillon LJ and at 260 per Mustill LJ.

14 As to the comptroller see PARA 577.

15 As to the meaning of 'European patent (UK)' see PARA 675 note 1.

16 See the Patents Act 1977 s 73(2); and PARA 571.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(ii) Patentable Subject Matter/431. Exclusions from patentability.

(ii) Patentable Subject Matter

431. Exclusions from patentability.

A patent is invalid if the invention for which it has been granted¹ is not patentable². Anything which consists of the following (among other things) is declared not to be an invention for the purposes of the Patents Act 1977³:

- 221 (1) a discovery, scientific theory or mathematical method⁴;
- 222 (2) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever⁵;
- 223 (3) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer⁶;
- 224 (4) the presentation of information⁷.

However, these exclusions prevent anything from being treated as an invention only to the extent that a patent or application for a patent relates to that thing as such⁸.

When considering the question of patentability, the court has regard to the substance of what is being claimed and not to the form of the words used⁹. Thus, for example, claims to a conventional computer containing a novel computer program or to a process for programming such a computer with a novel program have been regarded as claims to a computer program as such and hence unpatentable¹⁰. Whether an alleged invention is patentable depends upon what technical contribution the invention as a whole makes to the known art¹¹. There must be some technical advance on the prior art in the form of a new result¹². Whilst a discovery as such cannot be patented¹³, an inventor who on the basis of that discovery tells people how it can usefully be employed is entitled to a patent even though, once the discovery has been made, the way it can be so employed is obvious¹⁴. The ascription of a hitherto unknown property to a known substance is a discovery and as such unpatentable¹⁵. A claim to a method embracing a discovery which is speculative as to the method by which the discovery is to be embraced or which refers to developments in the art which are neither direct or immediate is a claim to a discovery as such¹⁶.

In addition, a patent may not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality¹⁷ or for a method of treatment or diagnosis¹⁸.

The Secretary of State¹⁹ may by order vary the list of things excluded from patentability for the purpose of maintaining them in conformity with developments in science and technology²⁰.

1 For the purposes of the Patents Act 1977, an invention for a patent for which an application has been made or for which a patent has been granted is taken, unless the context otherwise requires, to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification; and the extent of the protection conferred by a patent or application for a patent is to be determined accordingly: s 125(1).

2 Patents Act 1977 ss 72(1)(a), 74(3).

3 This is not an exhaustive list: see the Patents Act 1977 s 1(2). A method of controlling traffic flow is not patentable: Case T-16/83 *Christian Francheries/Traffic regulation* [1988] EPOR 65, Technical Board of Appeal; *Lux Traffic Controls Ltd v Pike Signals Ltd, Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107 at 138.

4 Patents Act 1977 s 1(2)(a). The following have been held unpatentable under s 1(2)(a): discovery of an amino acid sequence in human tissue plasminogen activator (t-PA) and claims based on t-PA per se, when not occurring naturally (*Genentech Inc's Patent* [1989] RPC 147, CA); method of calculating square roots with the aid of a computer and claims to a ROM characterised by the computer program stored in it (*Gale's Application* [1991] RPC 305 at 317, CA).

5 Patents Act 1977 s 1(2)(b). Original literary, dramatic, musical and artistic works and some other aesthetic creations are protected by copyright (see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 54 et seq) or design right (see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 501 et seq). See also Case T-119/88 *Fuji/Coloured disk jacket* [1990] EPOR 615, Technical Board of Appeal.

6 Patents Act 1977 s 1(2)(c). The following have been held to be unpatentable under s 1(2)(c): a data processing system for making a market in securities (*Merrill Lynch's Application* [1989] RPC 561, CA); a compiler which maximised the use of vector instructions (*Hitachi Ltd's Application* [1991] RPC 415); a computer so programmed that an expert could store his knowledge in a hierarchical form resulting in a system from which expert advice could be obtained (*Wang Laboratories Inc's Application* [1991] RPC 463); a method of matching silhouettes of unknown objects (eg ships) with those of known objects by digitally measuring the image of unknown object obtained by an imaging device and comparing it with the images of known objects stored in a computer memory (*Raytheon Co's Application* [1993] RPC 427); a computer program for modelling a synthetic crystal structure which allowed combined crystal structure to be portrayed more quickly than was otherwise possible (*Re Patent Application No 9204959.2 by Fujitsu Ltd* [1997] RPC 608, CA); a computer apparatus configured to provide a lottery playable via the Internet (*Shopalotto.com Ltd v Comptroller General of Patents, Designs and Trade Marks* [2005] EWHC 2416 (Pat), [2006] IP & T 396); the coordination of transport processes (*Cappellini v Comptroller of Patents; Bloomberg LP v Comptroller of Patents* [2007] EWHC 476 (Pat), [2007] FSR 663, [2007] All ER (D) 200 (Mar)). See also Case T-38/86 *IBM/Text clarity processing* [1990] EPOR 606, Technical Board of Appeal; Case T-65/86 *IBM/Text processing* [1990] EPOR 181, Technical Board of Appeal. See, however, *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371, [2007] 1 All ER 225, [2007] RPC 117; *Astron Clinica Ltd v Comptroller General of Patents, Designs and Trade Marks* [2008] EWHC 85 (Pat), [2008] 2 All ER 742, [2008] RPC 339, where it was held that claims to computer programs were not necessarily excluded from patentability and in a case where claims to a method performed by running a suitably programmed computer or to a computer programmed to carry out the method were allowable, then, in principle, a claim to the program itself should also be allowable, provided that the claim was drawn in such a way so as to reflect the features of the invention which would ensure the patentability of the method which the program was intended to carry out when it was run. See *Autonomy Corp Ltd v Comptroller General of Patents Trade Marks and Designs* [2008] EWHC 146 (Pat), [2008] All ER (D) 81 (Feb). See also PARA 432.

7 Patents Act 1977 s 1(2)(d). See *Raytheon Co v Comptroller General of Patents, Designs and Trade Marks* [2007] EWHC 1230 (Pat), [2007] All ER (D) 360 (May).

8 Patents Act 1977 s 1(2).

9 *Lux Traffic Controls Ltd v Pike Signals Ltd, Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107 at 139.

10 *Gale's Application* [1991] RPC 305 at 317, CA; *Wang Laboratories Inc's Application* [1991] RPC 463; *Raytheon Co's Application* [1993] RPC 427. But see *Astron Clinica Ltd v Comptroller General of Patents, Designs and Trade Marks* [2008] EWHC 85 (Pat), [2008] 2 All ER 742, [2008] RPC 339; and UK IPO *Practice Note* [2008] RPC 356. The correct approach to patentability is set out in *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371, [2007] 1 All ER 225, [2007] RPC 117 (see PARA 432).

11 Case T-204/84 *Vicom/Computer-related invention* [1987] EPOR 74, Technical Board of Appeal, cited with approval in *Genentech Inc's Patent* [1989] RPC 147 at 208, CA, per Purchas LJ; *Merrill Lynch's Application* [1989] RPC 561 at 569, CA; *Raytheon Co's Application* [1993] RPC 427 at 449. The correct approach to determining whether material is excluded is to take the claims of the patent, correctly construed, and consider what the claimed invention contributes to the art outside the excluded subject matter: *Research in Motion UK Ltd v Inpro Licensing SARL* [2006] EWHC 70 (Pat), [2006] RPC 517, [2006] All ER (D) 150 (Feb); affd [2007] EWCA Civ 51, [2007] All ER (D) 88 (Feb).

12 *Merrill Lynch's Application* [1989] RPC 561 at 569, CA (giving as an example a substantial increase in processing speed brought about by the use of a novel computer program). See also *Lux Traffic Controls Ltd v Pike Signals Ltd, Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107 at 139.

13 This was also the case under the previous legislation: see eg *Hickton's Patent Syndicate v Patents and Machine Improvements Co* (1909) 26 RPC 339, CA.

14 *Genentech Inc's Patent* [1987] RPC 553 at 566, cited with approval in *Genetech Inc's Patent* [1989] RPC 147 at 208, CA, per Purchas LJ and at 240 per Dillon LJ; *Gale's Application* [1991] RPC 305 at 324, CA.

15 *Genentech Inc's Patent* [1989] RPC 147 at 248, CA, per Dillon LJ and at 263 per Mustill LJ (discovery of amino acid sequence of human tissue plasminogen activator (t-PA) leading to process for its production; claims to t-PA per se, other than naturally occurring t-PA, and to t-PA produced by recombinant DNA technology were claims to discoveries and as such not claims for the practical application of the discovery of the sequences).

16 *Genentech Inc's Patent* [1989] RPC 147 at 227, CA, per Purchas LJ.

17 Patents Act 1977 s 1(3) (substituted by SI 2000/2037). The corresponding provision of the European Patent Convention (see PARA 668) refers to inventions contrary to 'ordre public' or morality: art 53(a). Exploitation is not to be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the United Kingdom or any part of it: Patents Act 1977 s 1(4) (substituted by SI 2000/2037). The purpose of the Patents Act 1977 s 1(4) is to enable eg the manufacture for export of devices which may offend against United Kingdom law, such as certain gaming machines, but which do not offend against the law of the country to which they are to be exported. As to the meaning of 'United Kingdom' see PARA 303 note 5. See eg *Harvard/Onco-mouse* [1991] EPOR 525, Examining Division. Plant varieties are protected under the Plant Varieties Act 1997: see **AGRICULTURAL PRODUCTION AND MARKETING** vol 1 (2008) PARA 1175 et seq. As to methods of treatment or diagnosis see PARA 433. As to biotechnological inventions see PARA 434.

18 Patents Act 1977 s 1(1)(d) (amended by the Patents Act 2004 s 16, Sch 2 para 2). See PARA 433.

19 As to the Secretary of State see PARA 575.

20 Patents Act 1977 s 1(5). No order may, however, be so made unless a draft of it has been laid before, and approved by resolution of, each House of Parliament: s 1(5). At the date at which this volume states the law no such order had been made. As to orders generally see s 124; and PARA 576.

UPDATE

431 Exclusions from patentability

NOTE 6--As to the approach of the court when considering the scope of the exclusion of methods of performing mental acts, see *Kapur v Comptroller General of Patents, Designs and Trade Marks* [2008] EWHC 649 (Pat), [2008] All ER (D) 142 (Apr).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(ii) Patentable Subject Matter/432. Test for patentability.

432. Test for patentability.

A four-step test to decide whether inventions are patentable subject matter has been suggested by the UK Intellectual Property Office¹ and approved by the Court of Appeal². The following steps must be followed:

- 225 (1) the claim must be properly construed³;
- 226 (2) the actual contribution must be identified⁴;
- 227 (3) the question whether the invention falls within the excluded subject matter⁵ must be determined⁶; and
- 228 (4) it must be decided if the actual or alleged contribution is technical in nature⁷.

¹ The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

² See *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371 at [39]-[49], [2007] 1 All ER 225 at [39]-[49], [2007] RPC 117 at [39]-[49] per Jacob LJ, giving the judgment of the court. See also *Autonomy Corpn Ltd v Comptroller General of Patents Trade Marks and Designs* [2008] EWHC 146 (Pat), [2008] All ER (D) 81 (Feb). The UK Intellectual Property Office is of the view that this case provides a definitive statement of the law and it is now rarely necessary to refer back to previous case law: see UK IPO *Practice Notice* dated 2 November 2006 [2007] RPC 162, as modified by UK IPO *Practice Notice* dated 7 February 2008 [2008] RPC 356.

³ See *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371 at [42], [2007] 1 All ER 225 at [42], [2007] RPC 117 at [42] per Jacob LJ, giving the judgment of the court.

⁴ This is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are and looking at what the inventor has added to human knowledge; the formulation involves looking at substance not form: see *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371 at [43], [2007] 1 All ER 225 at [43], [2007] RPC 117 at [43] per Jacob LJ, giving the judgment of the court.

⁵ As to excluded subject matter see PARA 431.

⁶ See *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371 at [45], [2007] 1 All ER 225 at [45], [2007] RPC 117 at [45] per Jacob LJ, giving the judgment of the court.

⁷ See *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371 at [46], [2007] 1 All ER 225 at [46], [2007] RPC 117 at [46] per Jacob LJ, giving the judgment of the court. Following the decision in *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application*, the UK Intellectual Property Office decided that computer programs or programs on a carrier were not patentable. The position was clarified in *Astron Clinica Ltd v Comptroller General of Patents, Designs and Trade Marks* [2008] EWHC 85 (Pat) at [51], [2008] 2 All ER 742 at [51], [2008] RPC 339 at [51] per Kitchen J (claims to computer programs are not necessarily excluded . . . in a case where claims to a method performed by running a suitably programmed computer or to a computer programmed to carry out the method are allowable, then, in principle, a claim to the program itself should also be allowable). This ruling has been accepted by the UK Intellectual Property Office: see UK IPO *Practice Notice* dated 7 February 2008 [2008] RPC 356.

A claim to a computer program or computer based system which survived step three of the test in *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* (see head (3) in the text) could never be rejected as excluded matter under step four (see head (4) in the text) on the basis that it did not involve a substantive technical contribution; they were, in reality, a single question: *Symbian Ltd v Comptroller General of Patents* [2008] EWHC 518 (Pat), [2008] All ER (D) 253 (Mar). See also *Autonomy Corpn Ltd v Comptroller General of Patents Trade Marks and Designs* [2008] EWHC 146 (Pat), [2008] All ER (D) 81 (Feb).

UPDATE

432 Test for patentability

NOTE 7--*Symbian*, cited, affirmed: [2008] EWCA Civ 1066, [2009] IP & T 214. See also *Blacklight Power Inc v Comptroller-General of Patents* [2008] EWHC 2763 (Pat), [2009] BLR 748, [2008] All ER (D) 183 (Nov) (hearing officer identified three criteria for considering whether scientific theory was true); and *AT & T Knowledge Ventures LP's Patent Application* [2009] EWHC 343 (Pat), [2009] FSR 743, [2009] All ER (D) 27 (Mar).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(ii) Patentable Subject Matter/433. Methods of treatment or diagnosis.

433. Methods of treatment or diagnosis.

A patent may not be granted for the invention¹ of:

- 229 (1) a method of treatment of the human or animal body by surgery or therapy²;
or
- 230 (2) a method of diagnosis practised on the human or animal body³.

This exclusion does not apply to an invention consisting of a substance or composition for use in any such method⁴. In the case of an invention consisting of a substance or composition for use in any such method, the fact that the substance or composition forms part of the state of the art⁵ does not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art⁶.

In the case of an invention consisting of a substance or composition for a specific use in any such method, the fact that the substance or composition forms part of the state of the art does not prevent the invention from being taken to be new if that specific use does not form part of the state of the art⁷. A new dosing regime may be enough to confer novelty⁸.

1 As to the extent of an invention see PARA 431 note 1.

2 'Therapy' includes prophylactic as well as curative treatment: *Unilever Ltd (Davis's) Application* [1983] RPC 219. See also Case T-81/84 *Rorer/Dysmenorrhea* [1988] EPOR 297, Technical Board of Appeal; Case T-290/86 *ICI/Cleaning plaque* [1991] EPOR 157, Technical Board of Appeal. Cosmetic use is not a form of therapy: Case T-36/83 *Roussel Uclaf/Thenoyl peroxide* [1987] EPOR 1, Technical Board of Appeal. See also Case T-144/83 *Du Pont/Appetite suppressant* [1987] EPOR 6, Technical Board of Appeal. Dosing regimes are methods of treatment and are not patentable: *Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals Inc* [2001] RPC 1, CA; *Merck & Co Inc's Patents* [2003] EWCA Civ 1545, [2004] FSR 330.

3 Patents Act 1977 s 4A(1) (s 4A added by the Patents Act 2004 s 1). The exclusion does not prohibit other methods of treating animals, eg a method, which is industrially applicable, of preventing a sow from overlying her piglets: Case T-58/87 *Salminen/Pigs III* [1989] EPOR 125, Technical Board of Appeal.

4 Patents Act 1977 s 4A(2) (as added: see note 3).

5 See PARA 435.

6 Patents Act 1977 s 4A(3) (as added: see note 3). This allows claims of the type 'compound x for use in the treatment of diabetes' provided no prior use of or suggestion to use x as a pharmaceutical is known: *John Wyeth & Brother Ltd's Application, Schering AG's Application* [1985] RPC 545 at 558. Where a second medical use for a known compound has been discovered, a claim in the 'Swiss form' is allowable, that is a claim in the form 'the use of compound x or a pharmaceutically acceptable salt thereof in the preparation of a medicament for the therapeutic and/or prophylactic treatment of diabetes'. This type of claim was approved by the Patents Court sitting in banc in *John Wyeth & Brother Ltd's Application, Schering AG's Application* [1985] RPC 545. Such claims are also allowed by the European Patent Office: see Case G-05/83 *Eisai/Second medical indication* [1979-1985] EPOR 241, Enlarged Board of Appeal. See *Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals Inc* [2000] IP & T 908, CA. See also *Teva Pharmaceutical Industries Ltd v Merrell Pharmaceuticals Inc* [2007] EWHC 2276 (Ch), [2007] All ER (D) 170 (Oct). See also *Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals Inc* [2001] RPC 1, CA. See, however, note 7.

7 Patents Act 1977 s 4A(4) (as added: see note 3). This allows claims in the form 'compound X for use in the treatment of condition Y' and obviates the need for 'Swiss form' claims.

8 *Actavis UK Ltd v Merck & Co Inc* [2008] EWCA Civ 444, [2008] All ER (D) 290 (May). In this case it was held that the Court of Appeal was free to depart from the ratio decidendi of its own earlier decision if it was satisfied that the European Patent Office Boards of Appeal had formed a settled view of European patent law which was inconsistent with that earlier decision. See also PARA 675.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(ii) Patentable Subject Matter/434. Biotechnological developments.

434. Biotechnological developments.

An invention¹ is not to be considered unpatentable solely on the ground that it concerns: (1) a product consisting of or containing biological material; or (2) a process by which biological material is produced, processed or used².

Biological material which is isolated from its natural environment or produced by means of a technical process may be the subject of an invention even if it previously occurred in nature³.

The following are not patentable inventions:

- 231 (a) the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene⁴;
- 232 (b) processes for cloning human beings⁵;
- 233 (c) processes for modifying the germ line genetic identity of human beings⁶;
- 234 (d) uses of human embryos for industrial or commercial purposes⁷;
- 235 (e) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes⁸;
- 236 (f) any variety of animal or plant⁹ or any essentially biological process¹⁰ for the production of animals or plants, not being a micro-biological¹¹ or other technical process or the product of such a process¹².

The protection conferred by a patent on a biological material possessing specific characteristics as a result of the invention extends to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics¹³.

The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention extends to biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics¹⁴.

The protection conferred by a patent on a product containing or consisting of genetic information extends to all material, save as provided for in head (c) above, in which the product is incorporated and in which the genetic information is contained and performs its function¹⁵.

This protection¹⁶ does not extend to biological material obtained from the propagation or multiplication of biological material placed on the market by the proprietor of the patent or with his consent, where the multiplication or propagation necessarily results from the application for which the biological material was marketed, provided that the material obtained is not subsequently used for other propagation or multiplication¹⁷.

¹ As to the meaning of 'invention' see PARA 301 note 2. Any provision of, or made under, the Patents Act 1977 is to have effect in relation to a patent or an application for a patent which concerns a biotechnological invention, subject to the provisions of s 76A, Sch A2: s 76A(1) (s 76A, Sch A2 added by SI 2000/2037). 'Biotechnological invention' means an invention which concerns a product consisting of or containing biological

material or a process by means of which biological material is produced, processed or used; and 'biological material' means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system: Patents Act 1977 s 130(1) (definitions added by SI 2000/2037). Nothing in the Patents Act 1977 s 76A or Sch A2 is to be read as affecting the application of any provision in relation to any other kind of patent or application for a patent: s 76A(2) (as so added).

2 Patents Act 1977 Sch A2 para 1 (as added: see note 1).

3 Patents Act 1977 Sch A2 para 2 (as added: see note 1).

4 Patents Act 1977 Sch A2 para 3(a) (as added: see note 1). An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element: Sch A2 para 5 (as added: see note 1). The industrial application of a sequence or partial sequence of a gene must be disclosed in the patent application as filed: Sch A2 para 6 (as added: see note 1). As to references to an application for a patent as filed see PARA 317 note 2.

5 Patents Act 1977 Sch A2 para 3(b) (as added: see note 1).

6 Patents Act 1977 Sch A2 para 3(c) (as added: see note 1).

7 Patents Act 1977 Sch A2 para 3(d) (as added: see note 1).

8 Patents Act 1977 Sch A2 para 3(e) (as added: see note 1).

9 'Plant variety' means a plant grouping within a single botanical taxon of the lowest known rank, which grouping can be: (1) defined by the expression of the characteristics that results from a given genotype or combination of genotypes; (2) distinguished from any other plant grouping by the expression of at least one of the said characteristics; and (3) considered as a unit with regard to its suitability for being propagated unchanged: Patents Act 1977 Sch A2 para 11 (as added: see note 1).

10 'Essentially biological process' means a process for the production of animals and plants which consists entirely of natural phenomena such as crossing and selection: Patents Act 1977 Sch A2 para 11 (as added: see note 1).

11 'Microbiological process' means any process involving or performed upon or resulting in microbiological material: Patents Act 1977 Sch A2 para 11 (as added: see note 1).

12 Patents Act 1977 Sch A2 para 3(f) (as added: see note 1). Inventions which concern plants or animals may be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety: Sch A2 para 4 (as added: see note 1).

13 Patents Act 1977 Sch A2 para 7 (as added: see note 1).

14 Patents Act 1977 Sch A2 para 8 (as added: see note 1).

15 Patents Act 1977 Sch A2 para 9 (as added: see note 1).

16 In the protection referred to in the Patents Act 1977 Sch A2 paras 7-9 (see the text to notes 13-15).

17 Patents Act 1977 Sch A2 para 10 (as added: see note 1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/435. Invention not new.

(iii) Lack of Novelty

435. Invention not new.

A patent for an invention may be granted only if the invention is new¹. An invention² is taken to be new if it does not form part of the state of the art³. The state of the art in the case of an invention is taken to comprise all matter (whether a product, a process, information about either, or anything else) which, at any time before the priority date⁴ of that invention has been made available to the public⁵, whether in the United Kingdom⁶ or elsewhere, by written or oral description, by use or in any other way⁷. In addition, the state of the art in the case of an invention to which an application for a patent or a patent relates is taken to comprise matter contained in an application for another patent⁸ which was published on or after the priority date of that invention, if the matter was contained in the application for that other patent both as filed and as published⁹ and that the priority date of the matter is earlier than that of the invention¹⁰. Thus matter contained in a co-pending application is 'deemed' to be part of the prior art and can be used to attack the patent on the ground of lack of novelty¹¹.

For information to be 'made available to the public' the disclosure must be what has been called an 'enabling disclosure'¹², that is a disclosure which is sufficient to enable those skilled in the art to put the innovation into effect¹³. Disclosure and enablement are distinct concepts, each of which must be satisfied and each of which has different rules¹⁴. Thus, cases decided prior to the coming into force of the Patents Act 1977 where prior use alone could invalidate both product and process claims may no longer be good law¹⁵. In particular, prior secret use, whether by the patentee himself or by others, does not invalidate a patent¹⁶.

1 Patents Act 1977 s 1(1)(a).

2 As to the extent of an invention see PARA 431 note 1.

3 Patents Act 1977 s 2(1).

4 As to the meaning of 'priority date' see PARA 311 note 6.

5 'Made available to the public' is accorded the same meaning as under the Patents Act 1949 (see the cases cited in PARA 446 et seq), namely that the requirement is satisfied if before its priority date the invention has been made known to at least one person other than its proprietor free in law and equity to deal with it as he pleases: see *Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83; *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 226; *Lux Traffic Controls Ltd v Pike Signals Ltd*, *Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107. See also PARA 447.

6 As to the meaning of 'United Kingdom' see PARA 303 note 5.

7 Patents Act 1977 s 2(2).

8 This applies: (1) to an application for a patent under the Patents Act 1977 ss 14, 15 (see PARA 315 et seq) (see s 2(3); and PARA 435); (2) to an application for a European Patent (UK) (see s 78(1), (2); and PARA 676); and (3) to an international application for a patent (UK) (see s 89(1); and PARA 664). As to the meaning of 'European patent (UK)' see PARA 675 note 1; and as to the meaning of 'international application for a patent (UK)' see PARA 664 note 1.

The occurrence of any of the events mentioned in the Patents Act 1977 s 78(5)(a) or (b) (see PARA 676) does not affect the continued operation of s 2(3) in relation to matter contained in an application for a European patent (UK) which by virtue of that provision has become part of the state of the art as regards other inventions; and the withdrawal of the designation of the United Kingdom in the application does not prevent matter contained in

an application for a European patent (UK) becoming part of the state of the art by virtue of s 2(3) as regards other inventions where the event occurs before the publication of that application: s 78(5A) (added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 22; and amended by the Patents Act 2004 s 5, Sch 1 paras 1, 3(1), (2)), reversing the effect of *L'Oreal's Application* [1986] RPC 19.

9 Patents Act 1977 s 2(3)(a). Any application made in relation to a patent in respect of which a prior application has been abandoned and published after it was abandoned is exempt from the state of art under s 2(3): *Woolard's Patent Application* [2002] EWHC 535 (Ch), [2002] RPC 767, overruling *Zbinden's Application* [2002] RPC 310.

10 Patents Act 1977 s 2(3)(b).

11 This is bare novelty only, not lack of inventive step: see PARA 452. The co-pending application must be construed as if it had been made available to the public just before the priority date of the patent in suit and in the light of the common general knowledge in the art at that time: *Genentech Inc's (Human Growth Hormone) Patent* [1989] RPC 613 at 644. The comptroller may of his own motion revoke a patent appearing to him to lack novelty only in this respect: see the Patents Act 1977 s 73(1); and PARA 571. As to the comptroller see PARA 577.

12 *Asahi Kasei Kogyo KK's Application* [1991] RPC 485 at 539, HL, per Lord Oliver of Aylmerton; *Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83 at 108.

13 In the case of a claim to a product to enable the skilled man to make it (*Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83 at 108; *Genentech Inc's (Human Growth Hormone) Patent* [1989] RPC 613 at 634; Case T-206/83 *ICI/Pyridine herbicides* [1986] EPOR 232, Technical Board of Appeal (but see [1987] EPOR 112 (editors' note)), and in the case of a process to enable him to operate the process (*PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 225; *Lux Traffic Controls Ltd v Pike Signals Ltd, Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107 at 134). The standard of proof is that set out in *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 485, CA: *Lux Traffic Controls Ltd v Pike Signals Ltd, Lux Traffic Controls Ltd v Faronwise Ltd* at 129.

14 *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323. The matter relied upon as prior art must disclose subject matter which, if performed, would necessarily result in an infringement of the patent (see at [22] per Lord Hoffmann); enablement means that the ordinary skilled person would have been able to perform the invention which satisfies the requirement of disclosure (see at [26] per Lord Hoffmann).

15 In particular these cases where prior use of a product which did not reveal the nature or composition of a product nor the process by which it was made may not now be good law: see PARA 451. If, however, the prior art gives clear and unmistakable directions which enable a product to be made, that product forms part of the prior art even though nobody knew the product existed: *Merrell Dow Pharmaceuticals Ltd v NH Norton & Co Ltd* [1994] RPC 1 at 14 (metabolite produced in the human body as a result of taking a pharmaceutical as described in a prior patent). See also *Kavanagh Balloons Proprietary Ltd v Cameron Balloons Ltd* [2003] RPC 87 (revsd on other grounds [2003] EWCA Civ 1952, [2003] All ER (D) 212 (Dec)).

16 This follows from the phrase 'made available to the public'. The Patents Act 1977 s 64 provides a special defence to infringement for such third parties: see PARA 514.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/436. Non-prejudicial disclosures.

436. Non-prejudicial disclosures.

The disclosure of matter constituting an invention¹ is to be disregarded in the case of a patent or an application for a patent if occurring later than six months immediately preceding the date of filing² the application for the patent and³:

- 237 (1) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person:
- 15
25. (a) from the inventor⁴ or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed he was entitled to obtain it; or
26. (b) from any other person to whom the matter was made available in confidence by any person mentioned in head (a) above or in this head or who obtained it from any such person because he or the person from whom he obtained it believed that he was entitled to obtain it⁵;
- 16
- 238 (2) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor⁶; or
- 239 (3) the disclosure was due to, or made in consequence of⁷, the inventor displaying the invention at an international exhibition⁸ and the applicant states, on filing the application, that the invention has been so displayed and also, within four months of filing the application, files written evidence in support of the statement complying with any prescribed conditions⁹.

1 As to the extent of an invention see PARA 431 note 1.

2 As to the meaning of 'date of filing' see PARA 316.

3 Patents Act 1977 s 2(4).

4 For these purposes, references to 'the inventor' include references to any proprietor of the invention for the time being: Patents Act 1977 s 2(5).

5 Patents Act 1977 s 2(4)(a).

6 Patents Act 1977 s 2(4)(b).

7 Publication before the exhibition, but in connection with it, is not 'in consequence' of display at the exhibition: *Re W Steel & Co Ltd's Application* [1958] RPC 411 (cited in PARA 753 note 7).

8 For these purposes, 'international exhibition' means an official or officially recognised international exhibition falling within the terms of the Convention relating to International Exhibitions (Paris, 22 November 1928; TS 9 (1931); Cmd 3776), as amended and supplemented by any Protocol to that convention which is in force or falling within the terms of any subsequent treaty or convention replacing that convention: Patents Act 1977 s 130(1). The convention has been supplemented by Protocols, all signed at Paris, dated 10 May 1948 (TS 57 (1951); Cmd 8311), 16 November 1966 (TS 14 (1968); Cmd 3557); 30 November 1972 (Misc 14 (1973); Cmd 5317); 24 June 1982 (TS 82 (1983); Cmd 9107); and 31 May 1988 (TS 4 (2003); Cm 5740). The convention applies to all international exhibitions (ie exhibitions where more than one state is invited to take part) except exhibitions lasting less than three weeks, fine arts exhibitions and exhibitions of an essentially commercial nature. Such official international exhibitions are rare. Rules may provide for stating in the Official Journal (Patents) (see PARA 580) that an exhibition is an international exhibition as defined by the Patents Act

1977 s 130(1); and any statement so published is conclusive evidence that the exhibition falls within the definition: s 130(2); Patents Rules 2007, SI 2007/3291, r 5(6).

9 Patents Act 1977 s 2(4)(c); Patents Rules 2007, SI 2007/3291, r 5(2). The statement that an invention has been displayed at an international exhibition must be in writing: r 5(1). However, where an applicant, on filing an international application for a patent (UK), states in writing to the receiving office that the invention has been displayed at an international exhibition then the prescribed period is two months beginning with the date on which the national phase begins: rr 5(3), 67. As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1.

The written evidence required by the Patents Act 1977 s 2(4)(c) must be in the form of: (1) a certificate issued by the authority responsible for the international exhibition; and (2) a statement, duly authenticated by that authority, identifying the invention as being the invention displayed at the exhibition: Patents Rules 2007, SI 2007/3291, r 5(4). The certificate must include the opening date of the exhibition (or if later, the date on which the invention was first displayed): r 5(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/437. Relevance of decided cases.

437. Relevance of decided cases.

Apart from the specific matters already noted¹, there is nothing to suggest that the Patents Act 1977 was intended to alter the concept of novelty in patent law, and reference may accordingly be made to earlier cases concerning novelty². Cases decided by the European Patent Office³ and the courts of member states of the European Patent Convention⁴ are of persuasive authority⁵.

1 See PARAS 431-436.

2 See PARA 438 et seq; and see in particular PARA 435 where 'enabling disclosure' and 'prior user' are discussed as to the differences over the cases decided before the Patents Act 1977.

3 See PARA 668.

4 See PARA 668 et seq.

5 See the Patents Act 1977 s 130(7) (amended by the Copyright, Designs and Patents Act 1988 s 30(2), Sch 8). The cases in the European Patent Office cited in PARAS 431-436, 452-499 have been referred to by the English courts.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/438. Test for novelty.

438. Test for novelty.

To anticipate a patent¹, a prior publication² or activity must contain the whole of the invention impugned³, that is, all the features by which the particular claim attacked is limited. Thus, if a prior publication contains a clear description of, or clear instructions to do or make, something which would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim is bad for lack of novelty⁴. So also if, although it cannot be seen from a mere reading of a prior publication that a claim is anticipated, carrying out the directions contained in that prior publication will inevitably result in something being made or done which would infringe that claim⁵. The prior disclosure must be construed as it would have been understood by a person skilled in the art⁶ at the date of the disclosure and not at the date of the subsequent patent⁷.

Further, in order for the prior disclosure to constitute an anticipation, it must be an enabling disclosure in the sense that, if specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication⁸. Enablement means that the ordinary skilled person would have been able to perform the invention which satisfies the requirements of disclosure⁹. The concepts of disclosure and enablement are separate concepts and must be kept distinct¹⁰. If the prior disclosure is a written description, the skilled person is to be taken to be trying to understand what the author of the description meant, with his common general knowledge¹¹ forming the background to this exercise. Once the meaning of the prior disclosure has been ascertained, the disclosure is either of an invention which, if performed, would infringe the patent, or it is not. The person skilled in the art has no further part to play. For the purpose of enablement, the question is not what the skilled person would think the disclosure meant but whether he would be able to work the invention which the court has held it to disclose¹².

In particular, where what is claimed is a combination of integers so placed together that by their working interrelation they produce a new or improved result, the claim is not anticipated merely because the separate integers are old¹³. Thus a claim to such a combination cannot be shown to lack novelty by finding part of the combination in one prior document and part in another¹⁴. Equally, if any one or more of the features of the claim are new by themselves, or by themselves form a new combination, in the above sense, then the claim has novelty whatever other features may be present; it is no objection to the claim that it may be unnecessarily limited in scope¹⁵.

1 'Anticipate' has come to mean specifically 'deprive of novelty' and it is used here in that sense. In older cases it often has the wider meaning of 'either deprive of novelty or render obvious'; it was so used in *British Thomson-Houston Co Ltd v Tungstelite Ltd* (1940) 57 RPC 271 at 289.

2 As to the meaning of 'publication' see PARA 446.

3 *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63 at 68, CA, citing *Otto v Linford* (1882) 46 LT 35, CA. As to sufficiency of prior publication see PARA 442.

4 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 485, CA; *Letraset Ltd v Rexel Ltd* [1976] RPC 51, CA. See also *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295 at 298, 55 RPC 31 at 40, CA.

5 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 486, CA. The notional infringement must be necessarily entailed: *Synthon BV v Smithkline Beecham* [2005] UKHL 59 at [23], [2006] 1 All ER 685 at [23], sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323 at [23].

6 See PARA 442.

7 *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323.

8 *Asahi Kasei Kogyo KK's Application* [1991] RPC 485 at 538-539, HL.

9 *Synthon BV v Smithkline Beecham* [2005] UKHL 59 at [26], [2006] 1 All ER 685 at [26], sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323 at [26].

10 *Synthon BV v Smithkline Beecham* [2005] UKHL 59 at [28], [2006] 1 All ER 685 at [28], sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323 at [28].

11 See PARA 443.

12 *Synthon BV v Smithkline Beecham* [2005] UKHL 59 at [32], [2006] 1 All ER 685 at [32], sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323 at [32]. In testing the adequacy of the enablement, it may be assumed that the skilled man will have to use his skill and may have to learn by his mistakes: see *Synthon BV v Smithkline Beecham*, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* at [64]. It may be necessary to repeat any experiments or examples described in the prior document to demonstrate anticipation by actual result: see *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568, [2005] FSR 524; *Mayne Pharma Pty Ltd v Debiopharm SA* [2006] EWHC 164 (Pat), [2006] FSR 656; *Synthon BV v Smithkline Beecham*, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent*.

13 *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 132, HL, citing *British Celanese Ltd v Courtaulds Ltd* (1935) 52 RPC 171, HL; and *Clark v Adie* (1877) 2 App Cas 315 at 321, HL. If what is claimed is not a combination in this sense, but a 'mere collocation' of old integers without special working interrelation, the claim will be bad; but this objection is best put as 'not an invention within the meaning of the Act'.

14 The documents may not be 'mosaiced'. See *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63 at 68, CA; and *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 138, HL.

15 *British United Shoe Machinery Co Ltd v A Fussell & Sons Ltd* (1908) 25 RPC 631 at 639, CA; *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295 at 301, 55 RPC 31 at 43, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/439. Width of claim.

439. Width of claim.

A patent may be bad for want of novelty notwithstanding that something described in the specification, for example the embodiment of the invention described in detail and illustrated in the drawings, is new, for the claims will ordinarily be of such width as to cover other things besides a single embodiment, and a claim is bad if anything within it is old¹. In particular, an anticipation² is nonetheless an anticipation because it fails to serve the purpose of the later invention³, or is the work of an 'ignoramus'⁴.

1 A clear example is *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295, 55 RPC 31, CA.

2 As to the meaning of 'anticipate' see PARA 438 note 1.

3 *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295, 55 RPC 31, CA. See also *Re Andrews' Patent* (1907) 24 RPC 349 at 371, CA, per Farwell LJ.

4 *Cleveland Graphite Bronze Co and Vandervell Products Ltd v Glacier Metal Co Ltd* (1949) 66 RPC 157 at 169, CA, per Greene MR.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/440. Claim to method of use.

440. Claim to method of use.

There may be a valid patent for a new method of using an old machine or other article, or for an old article adjusted in a particular way¹. Consequently, a claim to such a method of use² is not anticipated by a description of the article unless accompanied by clear and unmistakable instructions to use or adjust it in the manner claimed³.

¹ This proposition is clearly established by the cases cited in note 3 and in PARA 438 note 13, notwithstanding that the contrary proposition may be found in a number of decisions of inferior courts and tribunals.

² See as distinct from a claim to the article itself, or to the article 'for' the new use: *Adhesive Dry Mounting Co Ltd v Trapp & Co* (1910) 27 RPC 341.

³ *Flour Oxidising Co Ltd v Carr & Co Ltd* (1908) 25 RPC 428, approved in *British Thomson-Houston Co Ltd v Metropolitan-Vickers Electrical Co Ltd* (1928) 45 RPC 1, HL; *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295, 55 RPC 31, CA, explaining *British Thomson-Houston Co Ltd v Metropolitan-Vickers Electrical Co Ltd*.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/441. Selection patents.

441. Selection patents.

Since prima facie disclosure of a class involves disclosure of each of its members¹, a claim in the specification of a selection patent² to such a selected group prima facie lacks novelty³, but such a claim may have not only novelty but also inventive subject matter if the members of the selected group have some special property not possessed by the class as a whole⁴. This property must be stated in the specification⁵ as being a property in some sense peculiar to the selected class⁶.

A mere statement of the properties which a substance must possess in order to serve the purpose for which the subjects of the later claim are required will not be regarded as a broad disclosure of the class of substances which possess those properties so as to make the claim a selection claim⁷. Beyond this, however, there is no reason to suppose that any special standard of disclosure is required⁸. The practice is to regard a general disclosure of substituted chemical compounds as disclosing only compounds having classes of substituents of which the specific examples given are fairly representative⁹. A document containing two lists of starting materials does not amount to a specific technical teaching of the combination of any two starting materials¹⁰ and the disclosure of a racemate does not in itself amount to disclosure of each of its enantiomers¹¹.

A selection patent may be obtained even where the members of the selected class have been specifically disclosed and made provided that the alleged prior disclosure does not indicate that the selected class has the advantages predicted for the class¹². Prior knowledge of the materials from which a substance may be synthesised, and of the method of synthesis, is not prior knowledge of the substance¹³.

1 *Shell Refining and Marketing Co Ltd's Patent* [1959] RPC 154; on appeal [1960] RPC 35, CA.

2 As to the meaning of 'selection patent' see PARA 321.

3 As to the objection of lack of novelty generally, and as to the test to be applied, see PARA 438.

4 *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289; *Re May and Baker Ltd and Ciba Ltd's Letters Patent* (1948) 65 RPC 255 at 281; *Shell Refining and Marketing Co Ltd's Patent* [1960] RPC 35 at 53-57, CA.

5 *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289; *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195 at 218, CA.

6 *Shell Refining and Marketing Co Ltd's Patent* [1960] RPC 35 at 53, 57, CA, citing *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289. In what sense the property must be peculiar to the class is not clear. For a chemical case in which the general class was too small to admit a valid selection see *Beecham Group Ltd's (Amoxycillin) Application* [1980] RPC 261, CA.

7 *Re Dreyfus, Moncrieff and Sammons' Application* (1945) 62 RPC 125.

8 *Shell Refining and Marketing Co Ltd's Patent* [1960] RPC 35 at 54, CA, doubting *Re Kendall and Fry's Applications* (1948) 65 RPC 323 on this point. In particular, the truth of the statements in the prior documents would seem to be immaterial.

9 *Re Kendall and Fry's Applications* (1948) 65 RPC 323.

10 *Decision T12/81 BAYER/Diastereomers* [1979-85] EPOR Vol B 308.

11 *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311, (2008) 101 BMLR 52, [2008] All ER (D) 152 (Apr).

12 *El du Pont de Nemours & Co (Witsiepe's) Application* [1982] FSR 303, HL (claim to polyesters based on 1,4-butane diol and having a specific property held valid over prior disclosure of a class of polyesters based on diols of which 1,4-butane diol was named as one of the diols suitable).

13 *Re May and Baker Ltd and Ciba Ltd's Letters Patent* (1948) 65 RPC 255 at 281.

UPDATE

441 Selection patents

NOTE 11--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] 2 All ER 955.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/442. The skilled addressee.

442. The skilled addressee.

To anticipate a later invention, a publication must contain an enabling disclosure¹. The notional 'person skilled in the art' to whom the prior publication and the specification are deemed to be addressed is the skilled man reasonably versed in the art in question and who has the common general knowledge in relation to that art². He is assumed to be of standard competence, well acquainted with workshop technique, but without being of an imaginative or inventive turn of mind and who has carefully read the relevant literature³. It is well established that the skilled addressee may not be an individual but a team who combine a variety of skills⁴. In the case of inventions at the cutting edge of science and technology, the skilled person or team may, in fact, be very highly skilled indeed⁵.

1 See PARA 438.

2 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 482, CA. As to the attributes of the skilled person in relation to inventive step see PARA 456.

3 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 504, CA, citing *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346, HL. See also *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 at 72, CA; *Pfizer's Patent* [2001] FSR 201 at 226-227; *Rockwater v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 919, [2004] All ER (D) 63 (Apr); *Nichia Corp v Argos Ltd* [2007] EWCA Civ 741 at [10], [2007] FSR 895 at [10].

4 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 482, CA. See also *Genentech Inc's Patent* [1989] RPC 147 at 278, 280, CA. The notional skilled person is a legal construct and should not be equated to the lowest common denominator of all the persons skilled in the art at the time: *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat) at [39], [2006] RPC 25 at [39].

5 See eg *Genentech Inc's (Human Growth Hormone) Patent* [1989] RPC 613 at 619-620 (skilled person a team of persons of PhD standard including microbiologists versed in recombinant DNA techniques and chemists skilled in the synthesis of biochemical compounds). See also *Genentech Inc's Patent* [1989] RPC 147 at 246, 278, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/443. Common general knowledge.

443. Common general knowledge.

Common general knowledge is the sort of knowledge which would in fact be known by the appropriately skilled addressee¹. It is the mental equipment that is necessary for competency in the field of endeavour in question and in that sense is knowledge over and above the general knowledge which an ordinary member of the public would possess². It is different from 'public' knowledge which includes matter which has been publicly disclosed but which may be unknown to the skilled addressee³. Common general knowledge may include the contents of the standard textbooks that the skilled addressee would have⁴ but a published patent specification would not usually be something which is common general knowledge although in a rapidly developing art the position may be different if it is proved that such specifications are commonly widely read⁵.

1 See PARA 442.

2 *Vector Corpn v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct).

3 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 482, CA; *Beloit Technologies Inc v Valmet Paper Machinery Inc* [1997] RPC 489, CA; *Re Richardson-Vicks Inc's Patent* [1997] RPC 888, CA; *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568, [2005] FSR 524 at 533; *Ivax Pharmaceuticals UK Ltd v Akzo Nobel NV* [2006] EWHC 1089 (Ch), [2007] RPC 45, [2006] All ER (D) 308 (May).

4 *Vector Corpn v Glatt Air Techniques Inc* [2007] EWCA Civ 805, [2008] RPC 243, [2007] All ER (D) 297 (Oct).

5 See *Bridgestone/Rubber Composition* [1990] EPOR 483.

UPDATE

443 Common general knowledge

NOTE 1--If information is part of common general knowledge then it forms part of stock of knowledge which can inform and guide from the outset the skilled persons approach to the problem to which the patent in question provides a solution: *Generics (UK) Ltd v Daiichi Pharmaceutical Co Ltd* [2008] EWHC 2413 (Pat), [2009] FSR 397, [2008] All ER (D) 124 (Oct) (affd [2009] EWCA Civ 646, (2009) 109 BMLR 78). See also *FNM Corpn Ltd v Drammock International Ltd* [2009] EWHC 1294 (Pat), [2009] All ER (D) 192 (Aug).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/444. Drawings.

444. Drawings.

A drawing alone may constitute an anticipation¹ provided that the whole invention is made clear by it. The question is what the skilled addressee² would see in a technical drawing and this is a matter of evidence³.

¹ *Herrburger Schwander & Cie v Squire* (1889) 6 RPC 194, CA; *Electric Construction Co Ltd v Imperial Tramways Co Ltd* (1900) 17 RPC 537 at 550, CA. In many cases drawings with or without short descriptions have been held insufficient to amount to disclosure: see *Plimpton v Spiller* (1877) 6 ChD 412, CA; *Bray v Gardner* (1887) 4 RPC 400; *Watson, Laidlaw & Co Ltd v Pott, Cassels and Williamson* (1909) 26 RPC 349 (on appeal (1911) 28 RPC 565, HL). As to the meaning of 'anticipate' see PARA 438 note 1.

² As to the skilled addressee see PARA 442.

³ *BSH Industries Ltd's Patent* [1995] RPC 183 at 190.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/445. Errors in publication.

445. Errors in publication.

Errors in a prior publication¹, or the drawings attached to it, do not destroy its effect unless they would prevent the skilled addressee² from grasping what it purports to disclose³. So, too, an error in theory may not prevent a prior publication from being an anticipation⁴ unless the error conceals the meaning of the prior publication⁵, even though the reader can see it to be the work of an 'ignoramus'⁶.

1 As to the meaning of 'publication' see PARA 446.

2 As to the skilled addressee see PARA 442.

3 *Barlow v Baylis* (1870) Griffin's Patent Cases (1884-1886) 44 at 45; *Amalgamated Carburettors Ltd v Bowden Wire Ltd* (1931) 48 RPC 105 at 119.

4 As to the meaning of 'anticipate' see PARA 438 note 1.

5 *Re Andrews' Patent* (1907) 24 RPC 349 at 366, CA; on appeal (1908) 25 RPC 477, HL. See also *Thomson v Macdonald & Co* (1891) 8 RPC 5.

6 *Cleveland Graphite Bronze Co and Vandervell Products Ltd v Glacier Metal Co Ltd* (1949) 66 RPC 157 at 175, CA, per Greene MR; affd (1950) 67 RPC 149, HL (if, however, the question is one of obviousness, the weight to be given to such a publication will ordinarily be small).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/446. Meaning of 'published' and 'publication'.

446. Meaning of 'published' and 'publication'.

In the Patents Act 1977, 'published' means made available to the public¹. Publication of a document is established by showing that it was exposed in such a way that the public in general, or some section of it, had access to it, for example, in a bookshop², or a room in a library to which the public had access³. Any document which can be inspected as of right, at any place in the United Kingdom⁴ by members of the public, whether on payment of a fee or otherwise, is deemed to be published⁵. Alternatively, publication may be established by proving, either directly⁶ or by inference⁷, that some member of the public saw and read it⁸.

How soon after receipt a document may be presumed to have been published will normally be a question of fact⁹. A document in a foreign language is an effective publication¹⁰.

1 See the Patents Act 1977 s 130(1); and PARA 327 note 7. 'Published' had the same meaning in the Patents Act 1949: see s 101 (repealed). See *Re Monsanto Co (Brignac's) Application* [1971] RPC 153, Patents Appeal Tribunal (where salesmen were given a limited number of copies of a bulletin and there was no fetter on them as regards information contained in it, there was held to be prior publication to the public).

2 *Lang v Gisborne* (1862) 31 Beav 133; *Pickard and Currey v Prescott* [1892] AC 263, 9 RPC 195, HL.

3 *United Telephone Co v Harrison, Cox-Walker & Co* (1882) 21 ChD 720; *Harris v Rothwell* (1887) 35 ChD 416 at 431, 4 RPC 225 at 232, CA; *Rucker v London Electric Supply Corp Ltd* (1900) 17 RPC 279 at 295; *VD Ltd v Boston Deep Sea Fishing and Ice Co Ltd* (1935) 52 RPC 303.

4 As to the meaning of 'United Kingdom' see PARA 303 note 5.

5 Patents Act 1977 s 130(1). Identical provision was made in the Patents Act 1949: see s 101(1) (repealed). Documents in the library of the UK Intellectual Property Office, including in particular many foreign patent specifications and convention applications open to public inspection, fall into this category. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 *Re Crowther's Application for a Patent* (1933) 51 RPC 72.

7 *Pickard and Currey v Prescott* [1892] AC 263, 9 RPC 195, HL (where it was inferred that British subscribers to a foreign periodical would read it soon after receipt).

8 *Pickard and Currey v Prescott* [1892] AC 263, 9 RPC 195, HL; *Plimpton v Malcolmson* (1876) 3 ChD 531; *Humpherson v Syer* (1887) 4 RPC 407, CA. See also *Bristol-Myers Co's Application* [1969] RPC 146, DC.

9 *Harris v Rothwell* (1887) 35 ChD 416, 4 RPC 225, CA.

10 *Harris v Rothwell* (1887) 35 ChD 416, 4 RPC 225, CA. For all practical purposes, publication in any language counts.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/447. Confidential disclosure.

447. Confidential disclosure.

A document disclosed only to persons under a legal or moral obligation of confidence, so that they are not free to make use of the information acquired for their own purposes, is not published¹, for such persons are not members of the public². A document sufficiently widely circulated may, however, be published, even though purporting to be confidential³. A document disclosed to persons under a public duty to publish the information acquired is published even though they agree to keep it confidential⁴.

1 As to the meaning of 'published' see PARA 446.

2 *Humpherson v Syer* (1887) 4 RPC 407, CA; *Pilkington v Yeakley Vacuum Hammer Co* (1901) 18 RPC 459, CA; *Fomento Industrial SA, Biro Swan Ltd v Mentmore Manufacturing Co Ltd* [1956] RPC 87 at 89, CA; *Bristol-Myer Co's Application* [1969] RPC 146. See also *Re Underfeed Stoker Co Ltd and Robey's Application* (1924) 41 RPC 622; *Re G and J Weir Ltd's Application* (1925) 43 RPC 39; *Re Mooney's Application* (1927) 44 RPC 294; *Re Gallay's Application* [1959] RPC 141; *Re Monsanto Co (Brignac's) Application* [1971] RPC 153, Patents Appeal Tribunal; *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 225-226; *Cameron Balloons Ltd v Kavanagh Balloons Propriety Ltd* [2003] EWCA Civ 1952, [2003] RPC 87; *Visx Inc v Nidex Co* [1999] FSR 405 at 440.

3 *Re Williams' Application, Re Young's Application* (1943) 60 RPC 51; *Re Dalrymple's Application* [1957] RPC 449.

4 *Patterson v Gas Light and Coke Co* (1887) 3 App Cas 239, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/448. Publication by sale, exhibition or samples.

448. Publication by sale, exhibition or samples.

Similar considerations as in the case of written publication¹ apply to publication by sale², exhibition or the use of samples of an article previously made. If the article relied on has been placed in the hands of the public and examination or analysis would afford sufficient information for its preparation³, or if it has been exhibited or used in public so that its construction is apparent⁴, the publication is effective so far as a later patent is concerned.

1 See PARAS 446-447. As to the meaning of 'publication' see PARA 446.

2 *Strachan and Henshaw Ltd v Pakcel Ltd* (1948) 66 RPC 49 at 68. See also *Re Wikmanshytte Bruks AB's Application* [1961] RPC 180 (sale for export and delivery fob London held not to be prior use).

3 *Re Miller's Patent* (1898) 15 RPC 205, CA; *Re Stahlwerk Becker AG's Patent* (1918) 36 RPC 13, HL; *Re Monsanto Co (Brignac's) Application* [1971] RPC 153; *Bristol-Myers Co v Beecham Group Ltd* [1974] AC 646, [1974] 1 All ER 333; sub nom *Bristol-Myers Co (Johnson's) Application* [1975] RPC 127, HL.

4 *JD Insulating and Refrigerating Co Ltd v Thos Anderson Ltd* (1923) 41 RPC 1 at 31. See also *Carpenter v Smith* (1841) 1 Web Pat Cas 530; *Brereton v Richardson* (1883) 1 RPC 165; *Lifeboat Co Ltd v Chambers Bros & Co* (1891) 8 RPC 418; *Re Taylor's Patent* (1896) 13 RPC 482; *Stohwasser and Winter v Humphreys and Crook* (1900) 18 RPC 116; *Re Poulton's Patent* (1906) 23 RPC 506 at 508, CA; *Woodrow v Long, Humphreys & Co Ltd* (1933) 50 RPC 203 (affd 51 RPC 25, CA).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/449. Oral disclosure.

449. Oral disclosure.

Prior oral disclosure of an invention is sufficient to invalidate a later patent for it¹. The only question is whether any member of the public in the United Kingdom², not being one who himself invented it³, has come into possession of it otherwise than in confidence⁴.

1 *Humpherson v Syer* (1887) 4 RPC 407, CA.

2 As to the meaning of 'United Kingdom' see PARA 303 note 5.

3 *Dolland's Case* (1766) 1 Web Pat Cas 43.

4 See PARA 447 text and note 1.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/450. Publication by use.

450. Publication by use.

An invention will be published¹, so as to invalidate a subsequent patent, even though there is no deliberate display of it and it never comes into the hands of the public, by its use in a public place, so as to enable members of the public to see and understand it². Use on private premises, in a place where members of the public in fact penetrate so as to see the invention, will suffice³. The fact that the use excited no interest and created no public demand is immaterial⁴.

1 As to the meaning of 'published' see PARA 446.

2 *Carpenter v Smith* (1841) 1 Web Pat Cas 530 at 534 per Lord Abinger CB; *Stead v Williams* (1843) 2 Web Pat Cas 126 at 136; *Croysdale v Fisher* (1884) 1 RPC 17; *Young and Neilson v Rosenthal & Co* (1884) 1 RPC 29; *Humpherson v Syer* (1887) 4 RPC 407, CA; *Lifeboat Co Ltd v Chambers Bros & Co* (1891) 8 RPC 418; *Re Taylor's Patent* (1896) 13 RPC 482; *Gramophone Co Ltd v Ruhl* (1910) 27 RPC 629 (on appeal (1911) 28 RPC 20, CA); *Woodrow Long, Humphreys & Co Ltd* (1933) 50 RPC 203 at 207 (on appeal (1934) 51 RPC 25, CA); *Re Monsanto Co (Brignac's) Application* [1971] RPC 153, Patent Appeals Tribunal; *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA. See also *Lux Traffic Controls Ltd v Pike Signals Ltd, Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107 at 134 (where it was said that what was made available was that which the skilled addressee would write down if asked to describe its construction and operation); *Cameron Balloons Ltd v Kavanagh Balloons Propriety Ltd* [2003] EWCA Civ 1952, [2003] RPC 87.

3 *Lewis v Marling* (1829) 1 Web Pat Cas 493; *Bentley v Fleming* (1844) 1 Car & Kir 587; *Moss v Malings* (1886) 33 ChD 603, 3 RPC 373; *Moseley v Victoria Rubber Co* (1887) 57 LT 142, 4 RPC 241; *Electrolytic Plating Apparatus Co Ltd v Holland* (1901) 18 RPC 521 at 527.

4 *Losh v Hague* (1837) 1 Web Pat Cas 200 at 205; *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iii) Lack of Novelty/451. Abandoned or accidental user.

451. Abandoned or accidental user.

The fact that the user has long been abandoned does not prevent invalidation unless the art is in fact lost¹.

It is probable that a user which was fortuitous, and from which the person using it gained no real knowledge of the invention, and would not have been led to adopt it, is insufficient to invalidate a subsequent patent².

1 In *Re Wright's Patent* (1843) 1 Web Pat Cas 736, PC, an extension of term was granted for a patent which admittedly was for the rediscovery of a process known in the Middle Ages but was since lost.

2 *Harwood v Great Northern Rly Co* (1860) 29 LJQB 193 at 202 per Blackburn J; on appeal (1862) 31 LJQB 198 at 200. Cf *Spilsbury and Abbott v Clough* (1842) 1 Web Pat Cas 255 at 259n and the cases there referred to; *Rockliffe v Priestman & Co* (1898) 15 RPC 155; *Boyce v Morris Motors Ltd* (1926) 44 RPC 105 at 134, CA; *John Wright and Eagle Range Ltd v General Gas Appliances Ltd* (1928) 46 RPC 169 at 176, 183, CA. A different view seems to have been taken in *British Thomson-Houston Co Ltd v Duram Ltd* (1917) 34 RPC 117 at 148 per Astbury J, although this point is not referred to in the judgments in the higher courts. See also *Technic Inc's Application* [1973] RPC 383, CA (user not fortuitous); *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 at 77, CA (user not trivial or fortuitous).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/452. Invention obvious.

(iv) Obviousness

452. Invention obvious.

An invention¹ is unpatentable, as involving no inventive step², if it is obvious to a person skilled in the art³ having regard to any matter, whether a product, a process, information about either or anything else, which has at any time before the priority date⁴ of the invention been made available to the public⁵, whether in the United Kingdom or elsewhere⁶, by written or oral description, by use or in any other way⁷. Unlike the scope of the prior art when considering the novelty of an invention⁸, the prior art for testing obviousness does not include the contents of unpublished co-pending applications⁹. Apart from the lack of geographical and temporal limitations on the prior art there is no clear indication¹⁰ that the Patents Act 1977 was intended to alter the accepted concept of obviousness. Reference may accordingly be made to earlier decided cases concerning obviousness¹¹.

1 As to the extent of an invention see PARA 431 note 1.

2 See the Patents Act 1977 s 1(1)(b); and PARA 430.

3 As to persons skilled in the art see PARAS 442, 456.

4 As to the meaning of 'priority date' see PARA 311 note 6.

5 As to the meaning of 'made available to the public' see PARA 435 notes 5, 12-16.

6 As to the meaning of 'United Kingdom' see PARA 303 note 5.

7 Patents Act 1977 ss 2(2), 3.

8 As to novelty see PARA 435 et seq.

9 For these purposes, the Patents Act 1977 s 2(3) is to be disregarded: s 3.

10 Whilst the test is a statutory test, the guidelines in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA (see PARA 455) are widely regarded as useful: see *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588 at [14], [2007] FSR 872 at [14]. As to the effect of decisions of the European Patent Office and the courts of other countries which are parties to the European Patent Convention see PARA 668.

11 See PARA 453 et seq.

UPDATE

452 Invention obvious

NOTE 10--*Pozzoli*, cited, applied in *Belvac Production Machinery Incorporated v Carnaudmetalbox Engineering Ltd* [2009] EWHC 292 (Ch), [2009] All ER (D) 266 (Feb).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/453. Relation to novelty.

453. Relation to novelty.

Not everything that is new is inventive¹ and it is necessary to distinguish between the questions of obviousness and of lack of novelty².

1 See *Gadd and Mason v Manchester Corpn* (1892) 67 LT 576 at 578, 9 RPC 516 at 524, CA, and the cases there cited. See also *Harwood v Great Northern Rly Co* (1864) 11 HL Cas 654; *Riekmann v Thierry* (1897) 14 RPC 105, HL.

2 The approach of the appellate court to the issues of novelty and of obviousness may well be different as the former involves a precise legal standard whereas the latter does not: *Rockwater v Technip France SA* [2004] EWCA Civ 381 at [71]-[74], [2004] RPC 919 at [71]-[74].

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/454. Relation to width of claim.

454. Relation to width of claim.

Everything falling within the claim concerned must have inventive subject matter, or the claim will be invalid, even though it also covers things that are inventive¹.

¹ *Woodrow v Long, Humphrey & Co Ltd* (1933) 51 RPC 25, CA. The typical case is that where what is described and illustrated in the specification is inventive, but most of the claims are wider than the invention: see eg *Raleigh Cycle Co Ltd v H Miller & Co Ltd* [1948] 1 All ER 308, 65 RPC 141, HL. See also *Halliburton Energy Service Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat) at [174], [2006] RPC 25 at [174].

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/455. Test of obviousness.

455. Test of obviousness.

The statutory question is whether the invention is obvious to the notional person skilled in the art. A four-stage test for obviousness has been established by the courts¹:

- 240 (1) identify the notional 'person skilled in the art'² and identify the relevant common general knowledge³ of that person;
- 241 (2) identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- 242 (3) identify what, if any, differences exist between the matter cited as forming part of the 'state of the art' and the inventive concept of the claim or the claim as construed; and
- 243 (4) decide whether, viewed without any knowledge of the alleged invention⁴ as claimed, those differences constitute steps which would have been obvious to the person skilled in the art or whether they require any degree of invention⁵.

The European Patent Office has adopted the so-called 'problem and solution' approach in order to assess inventive step. This approach requires: (a) determining the closest prior art; (b) establishing the objective technical problem to be solved; and (c) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person. In most cases, this approach is unlikely to produce a different result from that produced by the adoption of the guidelines in heads (1) to (4) above, and where the results do differ this is likely to be due to the importance accorded by those guidelines to the common general knowledge of the skilled addressee⁶.

1 See *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588, [2007] FSR 872, [2007] All ER (D) 275 (Jun), recasting the test established in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 at 73, CA. The structured approach to deciding obviousness is useful, but not essential: *David J Instance Ltd v Denny Bros Printing Ltd* [2001] EWCA Civ 939, [2002] RPC 321, [2001] All ER (D) 201 (Jun). See also *Haberman v Jackel International Ltd* [1999] FSR 683; *PLG Research Ltd v Ardon International Ltd* [1995] RPC 287, CA; *Reckitt & Colman Products Ltd v Richardson-Vicks Ltd*; *Smith Kline Beecham v Richardson-Vicks Inc* (1995) 25 BMLR 63; *Palmaz's European Patents (UK)* [2000] RPC 631, CA; *Minnesota Mining and Manufacturing Co v ATI Atlas Ltd* [2001] FSR 514; *Panduit Corp v Band-It Co Ltd* [2002] EWCA Civ 465, [2003] FSR 127; *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568, [2005] FSR 524; *Novartis AG v Ivax Pharmaceuticals UK Ltd* [2006] EWHC 2506 (Pat), [2006] All ER (D) 172 (Oct); *Sabaf SpA v MFI Furniture Centres Ltd* [2004] UKHL 45, [2005] RPC 209; *Ultraframe (UK) Ltd v Eurocell Building Plastics Ltd* [2005] EWCA Civ 761, [2006] IP & T 222; *Ivax Pharmaceuticals UK Ltd v Akzo Nobel NV* [2006] EWHC 1089 (Ch), [2007] RPC 45; *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc* [2008] UKHL 49, [2008] All ER (D) 107 (Jul); *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1040 (Pat), [2007] RPC 729 (affd [2008] EWCA Civ 311, (2008) 101 BMLR 52, [2008] All ER (D) 152 (Apr)).

2 As to who is the skilled addressee see PARA 456.

3 As to the extent of common general knowledge see PARA 457.

4 The courts have consistently warned against ex post facto analysis of the invention: *British Westinghouse Electric and Manufacturing Co v Braulik* (1910) 27 RPC 209 at 230, CA; *Samuel Parkes & Co Ltd v Cocker Bros Ltd* (1929) 46 RPC 241 at 249, CA; *Non-Drip Measure Co Ltd v Stranger's Ltd* (1943) 60 RPC 135 at 142, HL, per Lord Russell of Killowen; *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346 at 362, HL, per Lord Diplock; *Hickman v Andrews* [1983] RPC 147 at 193, CA; *Fichera v Flogates Ltd* [1984] RPC 257 at 274, CA; *C Van der Lely NV v Ruston's Engineering Co Ltd* [1985] RPC 461 at 498, CA; *Fairfax (Dental*

Equipment) Ltd v SJ Filhol Ltd [1986] RPC 499 at 511, CA; *T Bonzel v Intervention Ltd (No 3)* [1991] RPC 553 at 579.

5 *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588 at [23], [2007] FSR 872 at [23], [2007] All ER (D) 275 (Jun) at [23] per Jacob LJ, giving the judgment of the court. See also *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA; *Fairfax (Dental Equipment) Ltd v SJ Filhol Ltd* [1986] RPC 499, CA; *Procter & Gamble Co v Peaudouce (UK) Ltd* [1989] FSR 180 at 189, CA; *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195 at 213, CA; *Helitune Ltd v Stewart Hughes Ltd* [1991] FSR 171 at 190; *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331 at 350; *Shoketsu Kinzoku Kogyo KK's Patent* [1992] FSR 184 at 189; *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 231; *Mölnlycke AB v Procter & Gamble Ltd (No 5)* [1994] RPC 49 at 115, CA; *Ivax Pharmaceuticals UK Ltd v Akzo Nobel NV* [2006] EWHC 1089 (Ch), [2007] RPC 45; *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc* [2008] UKHL 49, [2008] All ER (D) 107 (Jul); *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1040 (Pat), [2007] RPC 729 (affd [2008] EWCA Civ 311, (2008) 101 BMLR 52, [2008] All ER (D) 152 (Apr)).

6 *Ranbaxy UK Ltd v Warner-Lambert Co* [2005] EWHC 2142 (Pat) at [66]-[69], [2006] FSR 209 at [66]-[69].

UPDATE

455 Test of obviousness

NOTES 1, 5--*Conor Medsystems*, cited, reported at [2008] 4 All ER 621. *Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] 2 All ER 955.

See *Ratiopharm GmbH v Napp Pharmaceutical Holdings Ltd; Sandoz Ltd v Napp Pharmaceutical Holdings Ltd* [2008] EWHC 3070 (Pat), [2009] RPC 283, [2008] All ER (D) 170 (Dec) (reversed in part [2009] EWCA Civ 252, [2009] RPC 539, [2009] All ER (D) 20 (Apr)); *Dyson Technology Ltd v Samsung Gwangju Electronics Co Ltd* [2009] EWHC 55 (Pat), [2009] FSR 608, [2009] All ER (D) 164 (Jan); *Schlumberger Holdings Ltd v Electromagnetic Geoservices AS* [2009] EWHC 58 (Ch), [2009] All ER (D) 228 (Feb).

NOTE 5--See also *Buhler AG v FP Spomax SA* [2008] EWHC 823 (Ch), [2008] FSR 670.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/456. The skilled addressee.

456. The skilled addressee.

The notional person against whom the obviousness of an invention must be tested is the uninventive person skilled in the art, capable of assimilating the contents of scores of specifications, but incapable of a scintilla of invention¹. Where the relevant art is highly technical, the notional addressee may be a team as opposed to a single individual²; and, where the subject matter covers more than one discipline, the notional addressee may be expected to consult others or be a team³.

1 *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346 at 355, HL, per Lord Reid. See also PARA 443 and the cases there cited.

2 *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 RPC 369, HL; *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 482, 485, CA; *Genentech Inc's (Human Growth Hormone) Patent* [1989] RPC 613 at 619. Where a notional addressee has to consult others, the test for obviousness must be based on the common knowledge of all and not on the narrow area of knowledge of each individual consulted: *Inhale Therapeutic Systems Inc v Quadrant Healthcare plc* [2002] RPC 419. See also *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat) at [39], [2006] RPC 25 at [39].

3 *Tetra Moletric Ltd v Japan Imports Ltd* [1976] RPC 547 at 583, CA; *Hickman v Andrews* [1983] RPC 147 at 189, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/457. Common general knowledge.

457. Common general knowledge.

The skilled addressee has the common general knowledge relevant to the art in question¹. Common general knowledge includes not only the information that those engaged in the particular art concerned are likely to remember², but also the contents of those standard text books that those people would normally refer to on the particular topic concerned. In particular cases, a wider range of documents may form part of common general knowledge; thus patent specifications are not ordinarily common knowledge, but there are undoubtedly industries where specifications coming from leading research organisations are commonly read and referred to in the same way as a textbook³.

Common general knowledge need not extend to all those engaged in the art concerned, but it certainly includes what is known to most of them⁴. However, not every widely circulated document becomes part of common general knowledge; to do so, it must also be generally accepted⁵.

1 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 482, CA; approving *British Acoustic Films Ltd v Nettlefold Productions Ltd* (1935) 53 RPC 221, CA. See also PARA 443 and the cases there cited.

2 Eg what is taught to students: *Automatic Coil Winder and Electrical Equipment Co Ltd v Taylor Electrical Instruments Ltd* (1943) 61 RPC 41 at 43, CA; *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1951) 68 RPC 227 (affd (1952) 69 RPC 63, CA).

3 This was said to be so in chemistry in *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245, CA. It appears still to be true over much of the chemical industry, and in other industries where practice is changing too fast for text books to keep up.

4 *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 259 at 280, CA; *British Acoustic Films Ltd v Nettlefold Productions Ltd* (1935) 53 RPC 221 at 250, CA.

5 *British Acoustic Films Ltd v Nettlefold Productions Ltd* (1935) 53 RPC 221, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/458. Mindset of skilled person.

458. Mindset of skilled person.

In addition to his common general knowledge¹, the skilled addressee will approach the prior art with the perspective and expectations of those in the relevant field as at the priority date of the invention. For example, there may be an established prejudice that something will not work or that something ought not to be done and the fact that the patentee has demonstrated that, contrary to the mistaken prejudice, something will work and is successful, points to there being an inventive step². The prejudice must, however, be of a technical rather than a commercial nature³.

¹ See PARA 457.

² *Union Carbide Corp v BP Chemicals Ltd* [1998] RPC 1 at 13; *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588 at [25], [2007] FSR 872 at [25]. In such cases, the prior art can be said to comprise both the teaching of the prior document and the prejudice that it would not work or be impractical: see *Pozzoli SPA v BDMO SA* at [27]. See also *Angiotech's Patent* [2006] EWHC 260 (Pat) at [72], [2006] RPC 665 at [72] (whether safety concerns about a drug would lead to it being rejected out of hand); *Vector Corp v Glatt Air Techniques Inc* [2006] EWHC 1638 (Ch) at [134], [2007] RPC 255 at [134] (skilled addressee would be very wary of modifying fluidised bed designs on paper in the prior art).

³ *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195 at 213, CA; *Re Richardson-Vicks Inc's Patent* [1997] RPC 888 at 896 (difficulties of obtaining regulatory approval for a pharmaceutical).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/459. Identification of the inventive concept.

459. Identification of the inventive concept.

The inventive concept is not some generalised concept to be derived from the specification as a whole but the inventive concept of the claim in question¹. The first stage is likely to be a question of construction to ascertain the meaning of the claim. The second stage is to identify the essence of the claim by distinguishing between the portions of the claim which matter and those portions which, although limitations on the ambit of the claim, do not². The identification of the inventive concept requires a consideration of what the invention is³. The invention may be the idea of using established techniques to do something which no one had previously thought of doing, or it might be the way of achieving the goal or of how to overcome a problem which stands in the way of achieving the goal⁴.

An invention may thus involve three stages:

- 244 (1) the definition of the problem to be solved or the difficulty to be overcome⁵;
- 245 (2) the choice of the general principle to be applied in solving the problem or overcoming the difficulty⁶; and
- 246 (3) the choice of the particular means to be used⁷.

Merit in any one of these stages, or in the whole combined, may support the invention.

1 *Brugger v Medic-Aid Ltd* [1996] RPC 635 at 656.

2 *Unilever plc v Chefaro Proprietaries Ltd* [1994] RPC 567 at 580; *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588, [2007] FSR 872. It is 'the subject matter of the claim, shorn of immaterial verbiage': *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat), [2006] RPC 25. Appeals in obviousness cases frequently turn on whether the appellate court agrees or disagrees with the judge's assessment of what constituted the inventive step: see eg *Biogen Inc v Medeva plc* [1997] RPC 1 at 45, HL; *Technip France SA* [2004] EWCA Civ 381 at [125]-[130], [2004] RPC 919 at [125]-[130]; *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc* [2007] EWCA Civ 5, [2007] RPC 487 (revsd [2008] UKHL 49, [2008] All ER (D) 107 (Jul)).

3 *Biogen Inc v Medeva plc* [1997] RPC 1 at 34; *Vector Corp v Glatt Air Techniques Inc* [2006] EWHC 1638 (Ch), [2007] RPC 255.

4 *Biogen Inc v Medeva plc* [1997] RPC 1 at 34.

5 *Fawcett v Homan* (1896) 12 TLR 507, 13 RPC 398 at 405 per Lindley LJ. See also *Hickton's Patent Syndicate v Patents and Machine Improvements Co* (1909) 26 RPC 339, CA; *W and T Avery Ltd v H Pooley & Son Ltd* (1913) 30 RPC 160; *Teste v Coombes* (1924) 41 RPC 88 at 105, CA; *Benton and Stone Ltd v T Denston & Son* (1925) 42 RPC 284 at 297; *C Van der Lely NV v Ruston's Engineering Co Ltd* [1985] RPC 461 at 499, CA, per May LJ; *Vector Corp v Glatt Air Techniques Inc* [2006] EWHC 1638 (Ch), [2007] RPC 255.

6 See *Hayward v Hamilton* (1881) Griffin's Patent Cases (1884-1886) 115, CA; *Hickton's Patent Syndicate v Patents and Machine Improvements Co Ltd* (1909) 26 RPC 339, CA.

7 All these stages need not exist separately. Sometimes the discovery of the result and the means is simultaneous (eg the discovery of water tabbies referred to in *Liardet v Johnson* (1778) 1 Web Pat Cas 53), or the choice of the principle renders the means obvious: see *Hickton's Patent Syndicate v Patents and Machine Improvements Co Ltd* (1909) 26 RPC 339, CA; *Benton and Stone Ltd v T Denston & Son* (1925) 42 RPC 284.

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459 Identification of the inventive concept

NOTE 2--See also *Ratiopharm (UK) Ltd v Alza Corpn; Alza Corpn v Sandoz Ltd* [2009] EWHC 213 (Pat), [2009] All ER (D) 123 (Feb).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/460. Prior art.

460. Prior art.

The philosophy behind the doctrine of obviousness is that the public should not be prevented from doing anything which was merely an obvious extension or workshop variation of what was already known at the priority date. The skilled person is, therefore, treated as having access to every example of prior art and must be considered as sufficiently interested in the information, which he is deemed to have, to consider its practical application whether or not he would have done so in practice¹.

The fact that a document is old does not, per se, mean that it cannot be the basis of an obviousness attack². Each pleaded piece of prior art has to be interpreted as at its date³, but it has to be assessed for relevance as if it was being considered afresh at the priority date⁴. Nor can a piece of prior art be rejected simply because of its obscurity⁵. However, the significance to be accorded to different items of prior art may vary⁶ and it must not be assumed that the significance of existing published material in relation to the problem the patentee seeks to solve will necessarily be apparent to the notional skilled person⁷. Less significance may be attached to documents which are in a technical field remote from that of the invention⁸ or antiquarian interest only but the mere fact that the core pieces of prior art are old does not mean that the skilled addressee would have assumed that there were no valuable modifications worth trying out⁹. Where there is a vast literature of similar documents none of which points directly to the invention, a finding of obviousness is unlikely¹⁰.

1 *PLG Research Ltd v Ardon International Ltd* [1995] RPC 287 at 313, CA. See also *Brugger v Medic-Aid Ltd* [1996] RPC 635 at 653.

2 *Brugger v Medic-Aid Ltd* [1996] RPC 635 at 653.

3 *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568 at [88], [2005] FSR 524 at [88].

4 *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568 at [88], [2005] FSR 524 at [88].

5 *PLG Research Ltd v Ardon International Ltd* [1995] RPC 287 at 313, CA, citing as an example *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA. See also PARA 457.

6 *Beloit Technologies Inc v Valmet Paper Machinery Inc* [1995] RPC 705 at 749 ('spectrum between documents mouldering on obscure shelves in a library and those to which ordinarily attention would be paid').

7 *Sandoz Ltd (Frei's Application)* [1976] RPC 449; *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA; *PLG Research Ltd v Ardon International Ltd* [1995] RPC 287 at 313, CA.

8 *Dow Chemical Co (Mildner's) Patent* [1975] RPC 165, CA (where there was an unsuccessful objection that the cited document was only in the packaging field and not in the cable field); *Imperial Chemical Industries Ltd (Pointer's) Application* [1977] FSR 434. In *Woven Plastic Products Ltd v British Ropes Ltd* [1970] FSR 47, CA, a Japanese utility model was not regarded as too obscure.

9 *Brugger v Medic-Aid Ltd* [1996] RPC 635 at 655.

10 *Olin Mathieson Chemical Corp v Biorex Laboratories Ltd* [1970] RPC 157 at 184; *Hughes Tool Co v Ingersoll-Rand Co Ltd* [1977] FSR 406 at 409. A long list of prior art similar documents is sometimes referred to as a 'Simkins list' after Simkins who produced such a list in *Olin Mathieson Chemical Corp v Biorex Laboratories Ltd*.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/461. Mosaic of publications.

461. Mosaic of publications.

If, in order to arrive at the alleged invention, it is necessary to make a mosaic of extracts from documents published over a period of years¹, taking suggestions from one with suggestions from others independent of it², there can be little doubt that the claim has inventive subject matter³. This does not mean, however, that, in considering obviousness, prior documents must always be taken one at a time; the prior art must be considered as a whole⁴ but any 'mosaic' of the relevant documents must be one which could be put together by the skilled man with no inventive capacity⁵. Nor can there be any objection to reading documents together where the later refers to the earlier⁶. Furthermore, where the claim is to a mere collocation, it is legitimate to cite separate documents against separate integers or steps of a process⁷. The sort of mosaic that can be put together by an unimaginative person with no inventive capacity will not found a valid patent⁸.

¹ *Von Heyden v Neustadt* (1880) as reported in 50 LJ Ch 126 at 128, CA. See also *Pfizer's Patent* [2001] FSR 201 at 228.

² *Pope Appliance Corpn v Spanish River Pulp and Paper Mills Ltd* [1929] AC 269 at 278-279, 46 RPC 23 at 54, PC, citing *British Ore Concentration Syndicate Ltd v Minerals Separation Ltd* (1908) 26 RPC 124 at 147, CA; on appeal (1909) 27 RPC 33, HL.

³ *Huddart v Grimshaw* (1803) Dav Pat Cas 265 at 278; *Lancashire Explosives Co Ltd v Roburite Explosives Co Ltd* (1895) 12 TLR 35 at 36, 12 RPC 470 at 483, CA; *Fawcett v Homan* (1896) 12 TLR 507, 13 RPC 398 at 405; *British Thomson-Houston Co Ltd v Metropolitan-Vickers Electrical Co Ltd* (1928) 45 RPC 1, HL; *Lektophone Corpn v S G Brown Ltd* (1929) 46 RPC 203 at 230; *Dow Chemical Co (Mildner's) Patent* [1975] RPC 165, CA. See, however, *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63 at 68-70, CA (British and German specification of differing dates combined); *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568 at [96], [2005] FSR 524 at [96].

⁴ *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 133, HL, affirming the law on this matter as stated by Jenkins LJ in *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63, CA.

⁵ *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346 at 355, HL.

⁶ *Wilson v Wilson Bros Bobbin Co Ltd* (1911) 28 RPC 733 at 739, CA; *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1928) 45 RPC 153, CA.

⁷ *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1928) 45 RPC 153, CA, possibly exemplifies this: see generally PARA 483.

⁸ *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346 at 355, HL, per Lord Reid. See also *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568 at [96], [2005] FSR 524 at [96].

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/462. Effect of subsequent knowledge.

462. Effect of subsequent knowledge.

In interpreting a prior document it must be read as at the date of its publication¹. Technical terms contained in an earlier publication must be given the meaning which they had at the date of that publication², and all knowledge, whether general, or as to the meaning of an earlier publication, acquired since the date of application for a later patent, must be excluded³.

¹ *Ore Concentration Co (1905) Ltd v Sulphide Corpn Ltd* (1914) 31 RPC 206 at 224, PC; *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 485, CA. The question whether the date should be that of publication or of writing of the document was not material to either of these cases.

² *Betts v Menzies* (1862) 10 HL Cas 117; *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 485, CA. The publication must also be considered as directed to the problem at that date: *British Thomson-Houston Co Ltd v Metropolitan-Vickers Electrical Co Ltd* (1928) 45 RPC 1, HL.

³ *Bray v Gardner* (1887) 4 RPC 400 at 406, CA; *Ehrlich v Ihlee and Sankey* (1888) 5 RPC 437 at 452, CA; *Re Lewis and Stirckler's Patent* (1896) 14 RPC 24; *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245 at 277, CA; *British Thomson-Houston Co Ltd v Metropolitan-Vickers Electrical Co Ltd* (1928) 45 RPC 1, HL; *Pope Appliance Corpn v Spanish River Pulp and Paper Mills Ltd* [1929] AC 269 at 272, 46 RPC 23 at 50, PC; *Stelos Re-Knit Ltd v Ladda-Mend Co Ltd* (1931) 48 RPC 435 at 444. See also *Unwin v Heath* (1855) 5 HL Cas 505 at 523.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/463. Assessment of obviousness.

463. Assessment of obviousness.

The modern practice in relation to the issue of inventive step is to identify a relatively small number of items of prior art and then to identify the differences between those core items of prior art and the alleged invention. The crucial question whether the difference between the inventive concept of the patent and the state of the art represents an obvious step is one on which expert evidence is essential¹. The primary evidence is that of properly qualified expert witnesses² who will say whether or not in their opinions the relevant step would have been obvious to the skilled person having regard to the state of the art³. All other evidence is secondary to that primary evidence. Such secondary evidence may include what the inventor and others in the art actually thought and did⁴, whether the invention satisfied a long-felt want⁵ or whether the invention has been a commercial success⁶.

It has been said that the question of whether an alleged invention is obvious or not cannot be further refined and that because it is a multi-factorial question it is impossible to devise a more detailed question which is suitable for all cases⁷. Nevertheless, courts have found it useful to pose the question in different ways: 'was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned?'⁸; 'would the man skilled in the art be alerted to the possibilities?'⁹; 'so obvious that it would at once occur to anyone acquainted with the subject, and desirous of accomplishing the end?'¹⁰; 'would the person versed in the art assess the likelihood of success as sufficient to warrant actual trial?'¹¹. It is possible to find the question posed as either 'was it obvious that a skilled man should' or 'was it obvious that a skilled man could' make the invention? and the correct question may depend upon whether the invention lies in ascertaining the problem to be solved or in the way in which the problem is solved¹².

1 *Molnlycke AB v Proctor & Gamble Ltd (No 5)* [1994] RPC 49 at 113, CA; *Angiotech's Patent* [2006] EWHC 260 (Pat) at [32], [2006] RPC 665 at [32]; *Nichia Corpn v Argos Ltd* [2007] EWCA Civ 741 at [31], [2007] FSR 895 at [31].

2 The expert witness should equate, as far as possible, to the skilled addressee (see PARA 492). A witness who lacks expertise in the particular area with which the patent is concerned may still be of assistance to the court even if he lacks contemporary experience because he may be able to read himself into the state of the art at the priority date and his general knowledge would provide a framework for his analysis: *Research in Motion UK Ltd v Inpro Licensing SARL* [2006] EWHC 70 (Pat) at [6], [2006] RPC 517 at [6].

3 *Molnlycke AB v Proctor & Gamble Ltd (No 5)* [1994] RPC 49 at 113, CA; *Nichia Corpn v Argos Ltd* [2007] EWCA Civ 741 at [31], [2007] FSR 895 at [31].

4 *SKM SA v Wagner Spraytech (UK) Ltd* [1982] RPC 497 at 508, CA; *Pfizer's Patent* [2001] FSR 201 at 227. In *Nichia Corpn v Argos Ltd* [2007] EWCA Civ 741, [2007] FSR 895, the court considered the application of the rules of standard disclosure to such secondary evidence.

5 See eg *Pfizer's Patent* [2001] FSR 201 at 227. See also PARA 465.

6 *Pfizer's Patent* [2001] FSR 201 at 227. See also PARA 465.

7 *Nichia Corpn v Argos Ltd* [2007] EWCA Civ 741 at [22], [2007] FSR 895 at [22]. See also the warning against over-elaboration in *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc* [2007] EWCA Civ 5 at [44], [2007] RPC 487 at [44] (revsd [2008] UKHL 49, [2008] All ER (D) 107 (Jul)) approved in *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311, (2008) 101 BMLR 52, [2008] All ER (D) 152 (Apr). It is not incumbent on a patentee to demonstrate in the specification that the invention will work or how it works, although he runs the

risk of insufficiency if it does not work: *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc* [2008] UKHL 49, [2008] All ER (D) 107 (Jul).

8 *Killick v Pye Ltd* [1958] RPC 366 at 377, CA. The question was originally formulated by counsel (Sir Stafford Cripps) in *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1928) 45 RPC 153 at 163, CA.

9 *Johns-Manville Corpn's Patent* [1967] RPC 479 at 494, CA.

10 *Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496, 7 RPC 292 at 304, HL, cited with approval in *PLG Research Ltd v Ardon International Ltd* [1995] RPC 287 at 314, CA.

11 *Johns-Manville Corpn's Patent* [1967] RPC 479 at 494, CA; *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346 at 355, HL; *Tetra Molectric Ltd v Japan Imports Ltd* [1976] RPC 547 at 581, CA. The skilled man is not, however, expected to try all solutions unless he has a problem in mind and particular combinations might assist him in solving it: *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195 at 213, CA.

12 *Hallen Co v Brabantia (UK) Ltd* [1989] RPC 307 at 326; affd [1991] RPC 195 at 212, CA.

UPDATE

463 Assessment of obviousness

NOTE 3--See *Actavis UK Ltd v Novartis AG* [2009] EWHC 41 (Ch), [2009] All ER (D) 131 (Jan) (necessary for court to consider matter from perspective of relevant skilled person).

NOTE 7--*Lundbeck*, cited, affirmed: [2009] UKHL 12, [2009] 2 All ER 955. *Conor Medsystems*, cited, reported at [2008] 4 All ER 621.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/464. Hindsight.

464. Hindsight.

When assessing obviousness it is always necessary to guard against an ex post facto analysis because once the invention has been established, it may be easy to show how it might be arrived at by starting from something known and taking a series of apparently easy steps¹. Where the prior art offers many possible starting points for further development it may not be obvious, without hindsight, to choose the one which leads to the alleged invention².

¹ *British Westinghouse Electric and Manufacturing Co v Braulik* (1910) 27 RPC 209 at 230, CA; *Non-Drip Measure Co Ltd v Stranger's Ltd* (1943) 60 RPC 135 at 142, HL; *Technograph Printed Circuits Ltd v Mills and Rockley (Electronics) Ltd* [1972] RPC 346, HL; *Van der Lely NV v Ruston's Engineering Co Ltd* [1985] RPC 461 at 498, CA; *T Bonzel v Intervention Ltd (No 3)* [1991] RPC 553 at 579; *Wheatley v Drillsafe Ltd* [2001] RPC 133 at 147, CA. See also *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1040 (Pat) at [70], [2007] RPC 729 at [70].

² *PLG Research Ltd v Ardon International Ltd* [1995] RPC 287 at 313-314, CA.

UPDATE

464 Hindsight

NOTE 1--*Lundbeck*, cited, reversed in part, [2008] EWCA Civ 311, 101 BMLR 52, affirmed: [2009] UKHL 12, [2009] 2 All ER 955.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/465. Whether the development required inventive skill.

465. Whether the development required inventive skill.

The question whether a development which in fact has been made required inventive skill or was the natural development of the particular art is one of considerable difficulty. Sometimes the intrinsic nature of the discovery itself may be sufficient to establish the inventive skill¹, but the general tendency of the human mind is to minimise a discovery after it has been made², and it is often necessary to have recourse to extrinsic evidence to show that what has been done by the patentee was not obvious.

If it can be shown that the particular development is one of great utility and has satisfied a long-felt want in the trade, the inference that it required inventive ingenuity is strong³ and may be almost irresistible⁴. Commercial success is not in itself necessarily conclusive⁵, and any inference from it may be displaced by evidence of material change in the conditions of the trade, creating a new demand⁶. In particular, commercial success not co-extensive with the claim⁷, that is, due to matters or features other than the features to which the claim concerned is limited, such as superior workmanship or convenience⁸, or features resulting from subsequent research work⁹, tends to be of little weight. Invention may, however, be established by showing that the patented features played a part, in conjunction with other inventions, in enabling a long-felt want to be satisfied¹⁰.

1 The court may be impressed by the discovery as surprising and meritorious on its face, but there seems to be no modern instance of this. See, however, *Cleveland Graphite Bronze Co v Glacier Metal Co Ltd* (1950) 67 RPC 149 at 156, HL.

2 *Murray v Clayton* (1872) 7 Ch App 570 at 583 per James LJ; *Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496 at 500, 7 RPC 292 at 304, HL, per Lord Herschell; *Incandescent Gas Light Co Ltd v De Mare Incandescent Gas Light System Ltd* (1896) 13 RPC 301 at 323 (affd 12 TLR 495, 13 RPC 559, CA); *Re Waterhouse's Patent* (1906) 23 RPC 470 at 476 per Romer LJ; *British Westinghouse Electric and Manufacturing Co v Braulik* (1910) 27 RPC 209 at 230, CA (approved in *Non-Drip Measure Co Ltd v Stranger's Ltd* (1943) 60 RPC 135 at 142, HL); *Pope Appliance Corp v Spanish River Pulp and Paper Mills Ltd* [1929] AC 269 at 280, 46 RPC 23 at 55, PC; *Canadian General Electric Co Ltd v Fada Radio Ltd* [1930] AC 97 at 100, 47 RPC 69 at 88, PC.

3 *Murray v Clayton* (1872) 7 Ch App 570; *Von Heyden v Neustadt* (1880) 14 ChD 230, CA; *Haslam & Co Ltd v Hall* (1887) 5 RPC 1 (on appeal (1888) 20 QBD 491, CA); *American Braided Wire Co v Thomson* (1888) 4 TLR 279, 5 RPC 113, CA (affd sub nom *Thompson & Co v American Braided Wire Co* (1889) 5 TLR 537, 6 RPC 518, HL); *Boyd v Horrocks* (1888) 5 RPC 557 at 576; *Pirrie v York Street Flax Spinning Co Ltd* (1894) 11 RPC 429, CA; *Taylor and Scott v Annand and Northern Press and Engineering Co Ltd* (1900) 18 RPC 53 at 63, HL; *British Vacuum Cleaner Co Ltd v Suction Cleaners Ltd* (1904) 21 RPC 303 at 312; *Van Berkel v RD Simpson Ltd* 1907 SC 165, 24 RPC 117; *Benton and Stone Ltd v T Denston & Son* (1925) 42 RPC 284 at 297; *British United Shoe Machinery Co Ltd v Lambert Howarth & Sons Ltd and Gimson Shoe Machinery Co Ltd* (1927) 44 RPC 511 at 524; *Pope Appliance Corp v Spanish River Pulp and Paper Mills Ltd* [1929] AC 269, 46 RPC 23, PC; *Douglas Packing Co Inc, Douglas Pectin Corp and Postum Co Inc v Evans & Co (Hereford and Devon) Ltd* (1929) 46 RPC 493 at 508, CA; *British United Shoe Machinery Co Ltd v Albert Pemberton & Co* (1930) 47 RPC 134; *Rheostatic Co Ltd v Robert Maclaren & Co Ltd* (1935) 53 RPC 109 at 117; *Sonotone Corp v Multitone Electric Co Ltd* (1955) 72 RPC 131 at 145, CA; *Re Kromschroder AG's Patent (Revocation)* [1959] RPC 309 (revsd on another point [1960] RPC 75, CA). Cf *C Van der Lely NV v Bamfords Ltd* [1960] RPC 169 at 193; affd [1961] RPC 296, CA. See also *Re Inventa AG für Forschung und Patentverwertung's Application* [1956] RPC 45 at 49; *Tetra Moletric Ltd v Japan Imports Ltd* [1976] RPC 547, CA.

4 *S Parkes & Co Ltd v Cocker Bros Ltd* (1929) 46 RPC 241 at 248, CA, often approved: see eg *Non-Drip Measure Co Ltd v Stranger's Ltd* (1943) 60 RPC 135 at 143, HL; *Cleveland Graphite Bronze Co v Glacier Metal Co Ltd* (1950) 67 RPC 149 at 156, HL; *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 139, HL; *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 143, CA (affd [1948] 1 All ER 308, 65 RPC 141, HL).

5 *Haberman v Jackel International Ltd* [1999] FSR 683 at 699-701; *Longbottom v Shaw* (1891) 8 RPC 333, HL. See also *Riekmann v Thierry* (1896) 14 RPC 105, HL; *Cooper & Co (Birmingham) Ltd v Baedeker* (1900) 17 RPC 209, CA; *Thermos Ltd v Isola Ltd* (1910) 27 RPC 388; *Wilson v Wilson Bros Bobbin Co Ltd* (1911) 28 RPC 733, CA; *Lang Wheels (Manufacturing) Ltd and Bland v Wilson* (1938) 55 RPC 295 at 318; *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 503, CA; but see PARA 466. User by the defendant is often appealed to by the claimant as establishing inventive merit: see eg *Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496, 7 RPC 292, HL; *Deeley v Perkes* [1896] AC 496 at 497, 13 RPC 581 at 589, HL; but as to this see *Clark v Adie* (1877) 2 App Cas 315 at 337, HL.

6 *Re Gaulard and Gibbs' Patent* (1890) 7 RPC 367 at 380, HL; *Heginbotham Bros Ltd v Burne* (1939) 56 RPC 399, CA. An example is a change of fashion: see *Gosnell v Bishop* (1888) 4 TLR 397 at 398, 5 RPC 151 at 158, CA; *Savage v DB Harris & Sons* (1896) 12 TLR 332, 13 RPC 364 at 374, CA; *Bowen v EJ Pearson & Sons Ltd* (1924) 42 RPC 101.

7 *Colburn v FD Ward Ltd* (1950) 67 RPC 73. See also eg *Surface Silos Ltd v Beal* [1960] RPC 154 at 161, CA.

8 *British United Shoe Machinery Co Ltd v EA Johnson & Co Ltd* (1925) 42 RPC 243 at 254, CA; *British Hartford-Fairmont Syndicate Ltd v Jackson Bros (Knottingley) Ltd* (1932) 49 RPC 495 at 552, CA; *Paper Sacks Pty Ltd v Cowper* (1935) 53 RPC 31, PC; *Wilkey and Whites Manufacturing Co Ltd v H Freeman and Letrik Ltd* (1931) 48 RPC 405; *Dow Chemical Co (Mildner's) Patent* [1975] RPC 165, CA.

9 *British Celanese Ltd v Courtaulds Ltd* (1935) 152 LT 537 at 542, 52 RPC 171 at 194, HL. See also *Tetra Molelectric Ltd v Japan Imports Ltd* [1976] RPC 547, CA (where commercial success was in part due to later inventions); and *Rado v John Tye & Son Ltd* [1967] RPC 297, CA (affd [1968] FSR 563, HL) (availability of new material).

10 *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 139, HL. See also *Haberman v Jackel International Ltd* [1999] FSR 683 at 699-701.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/466. Unfelt want.

466. Unfelt want.

Where there was no felt want, but resigned acceptance of the defects of what was made before, commercial success of the thing patented may still create a prima facie case that it cannot have been obvious, or it would have been done before¹.

¹ *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd* [1959] RPC 189 at 213; on appeal [1960] RPC 59, CA. See also *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457 at 503, CA; *Beloit Technologies Inc v Valmet Paper Machinery Inc* [1995] RPC 705 at 754; *Dyson Appliances Ltd v Hoover Ltd* [2001] RPC 473 at 527.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/467. Invention the result of experiments.

467. Invention the result of experiments.

The fact that an alleged invention was arrived at only after a series of experiments may carry weight¹. It is not necessary that an inventor should have laboured, for an invention may well be the result of a happy thought²; but, if the inventor, being equipped with the proper knowledge of his art³, has been unable to arrive at the result claimed without a series of experiments, the inference is that the result was not obvious. Such an inference is, however, easily displaced, for even a fully qualified person may be unaware of particular documents or practices, especially those not forming part of the common general knowledge of the art⁴, or he may have been inhibited from carrying out experiments due to the existence of a competitor's patents⁵. Nevertheless evidence of what the inventor actually did⁶ or what others in field were doing at the priority date may be relevant⁷.

1 *Nichia Corpn v Argos Ltd* [2007] EWCA Civ 741, [2007] FSR 895.

2 *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289 at 322; cf PARA 459.

3 *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1951) 68 RPC 227 at 241; on appeal (1952) 69 RPC 63 at 70, CA. See also *Riekmann v Thierry* (1896) 14 RPC 105 at 122, HL; *Beecham Group Ltd's (Amoxycillin) Application* [1980] RPC 261, CA.

4 See PARA 457.

5 See *Beecham Group Ltd's (Amoxycillin) Application* [1980] RPC 261, CA.

6 *SKM SA v Wagner Spraytech (UK) Ltd* [1982] RPC 497 at 505, CA; *Procter & Gamble Ltd v Peaudouce (UK) Ltd* [1989] FSR 180 at 190, CA.

7 See *Fichera v Flogates Ltd* [1984] RPC 257 at 277, CA; *Shoketsu Kinzoku Kogyo KK's Patent* [1992] FSR 184 at 190; *Chiron Corpn v Organon Technika Ltd (No 3)*, *Chiron Corpn v Murex Diagnostics Ltd (No 3)* [1994] FSR 202 at 238. Such evidence is secondary in nature: see *Nichia Corpn v Argos Ltd* [2007] EWCA Civ 741, [2007] FSR 895; and PARA 463.

UPDATE

467 Invention the result of experiments

NOTE 4---See also *Leo Pharma A/S v Sandoz Ltd* [2009] EWHC 996 (Pat), [2009] All ER (D) 140 (May) (consideration of whether experimental repetition of example given in former patent would lead to discovery of subject matter of patent claim) (affd: [2009] EWCA Civ 1188, [2009] All ER (D) 230 (Nov)).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/468. Evidence as to the invention.

468. Evidence as to the invention.

Evidence that the opinion generally received before the alleged invention was made was that success could not be attained by the methods adopted by the inventor is permissible and is often relied on to establish inventiveness¹, as is evidence directed to explain the nature of the advance made, and the difference between the problem dealt with, the conditions obtaining, or the means employed, in the patentee's invention and in the alleged anticipations. Surprise among those in the industry concerned, either at the time the invention was made or subsequently, that the invention could achieve its purpose, is useful evidence².

1 See *British Liquid Air Co Ltd v British Oxygen Co Ltd* (1908) 25 RPC 577 at 601, CA; *Douglas Packing Co Inc, Douglas Pectin Corp and Postum Co Inc v Evans & Co (Hereford and Devon) Ltd* (1929) 46 RPC 493 at 508, CA; cf *John Wright and Eagle Range Ltd v General Gas Appliances Ltd* (1928) 46 RPC 169 at 179, CA.

2 See eg *Mullard Radio Valve Co Ltd v Philco Radio and Television Corp* [1936] 2 All ER 920, 53 RPC 323, HL; *Cleveland Graphite Bronze Co v Glacier Metal Co Ltd* (1950) 67 RPC 149, HL; *J Lucas (Batteries) Ltd v Gaedor Ltd* [1978] RPC 297 (affd [1978] RPC 389, CA).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/469. Relevance of decided cases.

469. Relevance of decided cases.

The approach to the assessment of inventive step has changed since the coming into force of the Patents Act 1977, with reliance being placed on the structured four-step test set out by the Court of Appeal¹. However, many of the basic principles laid down by earlier cases have been retained and reference may accordingly be made to earlier case law². Cases decided by the European Patent Office³ and the courts of the member states of the European Patent Convention⁴ are of persuasive authority⁵.

1 See *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA; and PARA 455.

2 See PARAS 470-472.

3 See PARA 668. As to the approach to obviousness adopted by the European Patent Office see PARA 455.

4 See PARA 668 et seq.

5 See the Patents Act 1977 s 130(7) (amended by the Copyright, Designs and Patents Act 1988 s 303(2), Sch 8). See also PARA 437.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/470. Distinction between discovery and invention.

470. Distinction between discovery and invention.

The difference between discovery and invention has been often emphasised¹, and it has been held that a patent cannot be obtained for a discovery in the strict sense². If, however, the patented article or process has not actually been anticipated³, so that the effect of the claims is not to prevent anything being done which has been done or proposed previously, the discovery which led to the patentee's devising a process or apparatus may supply the necessary element of invention required to support a patent⁴. This is certainly the case if it can be shown that, apart from the discovery, there would have been no apparent reason for making any variation in the former practice⁵.

1 See eg *Reynolds v Herbert Smith & Co Ltd* (1903) 20 RPC 123 at 126.

2 *Lane Fox v Kensington and Knightsbridge Electric Lighting Co* [1892] 3 Ch 424, 9 RPC 413, CA. See also the Patents Act 1977 s 1(2)(a); and PARA 431 head (1).

3 As to the meaning of 'anticipate' see PARA 438 note 1.

4 *Hickton's Patent Syndicate v Patents and Machine Improvements Co Ltd* (1909) 26 RPC 339 at 347, CA; *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 139, CA (affd [1948] 1 All ER 308, 65 RPC 141, HL); *Genentech Inc's Patent* [1989] RPC 147 at 239, CA, per Dillon LJ. A claim to a physical product, or process for making it, is not a claim to a discovery as such by reason only that the product is not defined by reference to its physical or chemical structure: *Chiron Corp v Murex Diagnostics Ltd* [1996] RPC 535 at 605.

5 *Muntz v Foster* (1844) 2 Web Pat Cas 96 at 103 per Tindal CJ, discussed in *Pirrie v York Street Flax Spinning Co Ltd* (1894) 11 RPC 429 at 449, CA, and in *Dick v Ellam's Duplicator Co* (1900) 17 RPC 196, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/471. Verification does not involve an inventive step.

471. Verification does not involve an inventive step.

Where the subject matter of an alleged invention has actually been proposed before, the verification of the fact that the earlier proposal works, or that it works commercially, will not be patentable¹, even if the claims can be so limited as not to lack novelty².

¹ *Acetylene Illuminating Co Ltd v United Alkali Co Ltd* (1904) 22 RPC 145 at 155, HL; *Mouchel v Coignet* (1907) 24 RPC 229, CA (affd sub nom *Hennebique v W Cowlin & Sons* (1909) 26 RPC 280, HL); *Re Alsop's Patent* (1907) 24 RPC 733 at 759; *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1927) 44 RPC 367 (affd (1928) 45 RPC 153, CA); *Samuel Heap & Son Ltd v Bradford Dyers' Association Ltd* (1929) 46 RPC 254. Nor will the ascertainment of the properties of a known substance be patentable: *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289 at 322. See also *Beecham Group Ltd's (Amoxycillin) Application* [1980] RPC 261 at 303, CA.

² Any claim which actually covers the prior proposal is necessarily invalid for want of novelty: see PARA 435 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/472. Importance of new result.

472. Importance of new result.

In judging the presence of invention it may broadly be said that the result is more important than the means; sometimes the greatest inventive skill is shown by the smallest alteration¹. Thus a machine which enables an important new result² to be obtained may be proper subject matter for a patent, although the difference between it and what went before is small, provided that the difference is such that without it the new result could not be obtained³. Similarly, a slight alteration or new direction in a process may lead to such important results as to constitute good subject matter for the grant of a patent⁴. An added benefit, however great, will not, however, found a valid patent if the claimed invention is obvious for another purpose⁵.

1 *Electrolytic Plating Apparatus Co Ltd v Evans & Sons* (1900) 17 RPC 733 at 741. See also *Day v Davies* (1904) 22 RPC 34 at 42; *Giusti Patents and Engineering Works Ltd v Rees* (1923) 40 RPC 206 at 215.

2 As to the necessary amount of improvement see *Gramophone and Typewriter Ltd v Ullmann* (1906) 23 RPC 752 at 757, CA, approved in *Gramophone Co Ltd v Ruhl* (1910) 28 RPC 20 at 37, CA.

3 *Hinks & Son v Safety Lighting Co* (1876) 4 ChD 607; *Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496, 7 RPC 292, HL; *Gammons v Battersby* (1904) 21 RPC 322, CA; *Re Brown's Patent* (1907) 25 RPC 86, CA. The improvement must be due to the change: see *R v Arkwright* (1785) 1 Web Pat Cas 64 at 72; *Pow v Taunton* (1845) 9 Jur 1056; *Edison and Swan United Electric Light Co Ltd v Holland* (1889) 5 TLR 294 at 298, 6 RPC 243 at 283, CA.

4 Among cases illustrating this point in which the patents have been upheld are *Re Hall's Patent* (1817) 1 Web Pat Cas 97; *Elliott v Aston* (1840) 1 Web Pat Cas 222; *Betts v Menzies* (1862) 10 HL Cas 117; *Betts v Neilson* (1868) 3 Ch App 429 (affd sub nom *Neilson v Betts* (1871) LR 5 HL 1); *Murray v Clayton* (1872) 7 Ch App 570; *Frearson v Loe* (1878) 9 ChD 48; *Hayward v Hamilton* (1881) Griffin's Patent Cases (1884-1886) 115, CA; *Edison and Swan Electric Light Co v Woodhouse and Rawson* (1887) 3 TLR 327, 4 RPC 79, CA; *Lyon v Goddard* (1893) 10 RPC 121 (affd sub nom *Goddard v Lyon* (1894) 11 RPC 354, HL); *English and American Machinery Co Ltd v Union Boot and Shoe Machine Co Ltd* (1894) 11 RPC 367, CA; *Edison-Bell Phonograph Corp Ltd v Smith* (1894) 10 TLR 522, 11 RPC 389, CA; *Shrewsbury and Talbot Cab Co Ltd v Sterckx* (1895) 12 TLR 122, 13 RPC 44, CA; *Riekman v Thierry* (1896) 14 RPC 105, HL; *Scott v Hamling & Co Ltd* (1896) 14 RPC 123; *Innes v Short and Beal* (1898) 15 RPC 449 at 451; *Day v Davies* (1904) 22 RPC 34; *Jandus Arc Lamp and Electric Co Ltd v Arc Lamps Ltd* (1905) 92 LT 447, 22 RPC 277; *Watson, Laidlaw & Co Ltd v Pott, Cassels and Williamson* (1911) 28 RPC 565, HL; *British Vacuum Cleaner Co Ltd v London and South Western Rly Co* (1912) 29 RPC 309, HL; *Simplex Concrete Piles Ltd v Stewart* (1913) 30 RPC 205; *Marine Torch Co v Holmes Marine Life Protection Association* (1913) 30 RPC 631 at 649, CA; *Roth v Cracknell* (1921) 38 RPC 120; *Re Merk-Wirz's Patent* (1923) 40 RPC 270; *Turner v Bowman* (1924) 42 RPC 29; *Boyce v Morris Motors Ltd* (1926) 44 RPC 105, CA; *Stelos Re-Knit Ltd v Ladda-Mend Co Ltd* (1931) 48 RPC 435. For chemical patents of this class see *Benno Jaffé and Darmstaedter Lanolin Fabrik v John Richardson & Co (Leicester) Ltd* (1894) 10 TLR 398, 11 RPC 261, CA; *Saccharin Corp Ltd v Chemicals and Drugs Co Ltd* (1899) 17 RPC 28; *Re Max Müller's Patent* (1907) 24 RPC 465 at 469.

5 *Morgan & Co Ltd v Windover & Co* (1890) 7 RPC 131 at 134, HL; *Drysdale and Sidney Smith & Blyth Ltd (in liquidation) v Davey Paxman & Co (Colchester) Ltd* (1937) 55 RPC 95 at 113; *Parks-Cramer Co v G W Thornton & Sons Ltd* [1969] RPC 112 at 127, HL, per Lord Morris of Borth-y-Gest; *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195 at 216, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/473. Possession of new functions.

473. Possession of new functions.

The presence of invention may often be established by showing that an article has unexpected and valuable uses, or that a process produces unexpected and valuable results; but in such a case, although a court will in general take into consideration all the advantages arising from the invention, and not merely those pointed out in the specification, it is necessary that the claim should be strictly limited to things or processes possessing the new functions¹.

¹ *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 136-137, CA, per Lord Greene MR; upheld [1948] 1 All ER 308, 65 RPC 141, HL. In the older cases, where the claims were limited (or deemed to be limited) to the invention 'as and for the purpose described', mention of the function in the specification was sufficient: see *Von der Linde v Brummerstaedt & Co* (1909) 26 RPC 289; *HE Curtis & Son Ltd v RH Heward & Co* (1923) 40 RPC 183, CA; *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1927) 44 RPC 367 (affd (1928) 45 RPC 153, CA); *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 259 at 271, CA (on appeal (1935) 152 LT 537, 52 RPC 171, HL). See also PARA 481 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/474. New chemical substance.

474. New chemical substance.

In the case of a new chemical substance the question whether there is an inventive step generally depends on whether its production lay within the routine practice of some existing trade or manufacture¹, but, even if this is the case, there may yet be inventiveness if the new substance possesses valuable properties the existence of which was not obvious a priori, even though the method of synthesis is a known one, so long as it has not previously been applied to the particular starting materials concerned².

¹ See *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1927) 44 RPC 367 (affd (1928) 45 RPC 153, CA); *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289. Formerly the courts held the view that a new chemical substance was patentable even if the course of chemical development would have naturally led to it: see *Badische Anilin und Soda Fabrik v Levinstein* (1887) 12 App Cas 710 at 711-712, 4 RPC 449 at 462, HL (revsg (1885) 29 ChD 366, 2 RPC 73, CA, and restoring (1883) 24 ChD 156); *Badische Anilin und Soda Fabrik v Dawson* (1889) 6 RPC 387 at 393; *Acetylene Illuminating Co Ltd v United Alkali Co Ltd* (1904) 22 RPC 145 at 153, HL. The change of view does not mark any change in law but rather the appreciation that in certain branches of chemistry increased knowledge has rendered prediction as to modes of manufacture and properties of bodies in known series almost a matter of certainty. For other cases where articles or substances new in themselves were held not to be patentable see *Adamant Stone and Paving Co Ltd v Liverpool Corpn* (1896) 14 RPC 11 (on appeal (1897) 14 RPC 264, CA); *Dick v Ellam's Duplicator Co* (1900) 17 RPC 196, CA; *Hudson, Scott & Co Ltd v Barringer, Walls and Manners Ltd* (1906) 23 RPC 502, CA.

² *Re May and Baker Ltd and Ciba Ltd's Letters Patent* (1948) 65 RPC 255 at 281 (affd (1950) 67 RPC 23, HL); *Beecham Group Ltd's (Amoxycillin) Application* [1980] RPC 261, CA. If the method of synthesis has previously been applied to the same starting materials, there may have been an inventive discovery of the properties of the product, but the product itself will lack novelty. Even so, the use of the product so as to reap the benefit of the newly discovered properties may be patentable if it is a 'manufacture': see PARA 475.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/475. Patent for analogous user.

475. Patent for analogous user.

Many patents are for the user of old apparatus, integers or processes for a new purpose. Inventiveness in these cases has to be judged, in general, by considering whether the new user lies so far out of the track of the former use that it would not suggest itself naturally to a person reasonably skilled in the particular art but would require thought and study¹.

The inventive art necessary to support a patent for the new user may lie in the appreciation of the fact that the problem to be overcome may be solved by the use of old means², or in the adaptation of old means so as to overcome the special difficulties which occur in the particular problem³. In the first case it is usually necessary to establish that it was not known that the new and old problems were identical⁴. This may be expressed by saying that the new user must not be 'merely analogous' to the old user. The merit of an invention may lie in the determination of the real nature of the difficulties to be overcome⁵, but, if these are known, then ingenuity must be shown either in the choice of a method for overcoming them or in the means for carrying out the method, although it is not necessary that the means should be new⁶.

In considering whether user is analogous, attention must be paid not only to the means employed, but also the object for which they are employed. It is not sufficient to establish analogous user to show that the results sought to be attained by the new user, or some of them, were produced by the earlier user, fortuitously or to an unimportant extent⁷.

Where the new user involves fresh difficulties for which the remedy is not obvious, the old user is not considered analogous⁸. Nor is an old user so considered where the new application makes use of properties or advantages not apparent or useful in the old⁹.

The purpose of the rules relating to obviousness is to safeguard manufacturers from undue interference in the development of their methods, or in the use of the knowledge which has been accumulated in their own and other trades¹⁰. It is a question of fact whether a new use is to be regarded as an analogous user, and the formula 'analogous user' may merely beg the question which the court has to decide¹¹.

1 *Penn v Bibby* (1866) 2 Ch App 127 at 136. See also *Harwood v Great Northern Rly Co* (1864) 11 HL Cas 654 at 682; *Acetylene Illuminating Co Ltd v United Alkali Co Ltd* (1904) 22 RPC 145 at 155, HL. See also PARA 440. It has been said that the user may be analogous, though not obvious: *Bonnard v London General Omnibus Co Ltd* (1920) 38 RPC 1 at 11, HL.

2 See *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231, CA.

3 *Gadd and Mason v Manchester Corp'n* (1892) 9 RPC 516 at 524, CA, approved in *Benmax v Austin Motor Co Ltd* as reported in (1955) 72 RPC 39 at 44-45, HL, and explained in *Lister & Co Ltd's Patent* [1966] RPC 30, DC. See also *Hayward v Hamilton* (1881) Griffin's Patent Cases (1884-1886) 115 at 116, CA; *British Liquid Air Co Ltd v British Oxygen Co Ltd* (1908) 25 RPC 577 at 601, CA (where the fact that scientific opinion thought the method impossible was held evidence against analogy); *Hickton's Patent Syndicate v Patents and Machine Improvements Co* (1909) 26 RPC 339 at 347, CA.

4 *Steiner v Heald* (1851) 20 LJ Ex 410, Ex Ch; *AG für Autogene Aluminium Schweissung v London Aluminium Co (No 2)* (1922) 39 RPC 296 at 308, HL.

5 See PARA 459.

6 *Dangerfield v Jones* (1865) 13 LT 142 (affd 14 WR 356); *Cannington v Nuttall* (1871) LR 5 HL 205; *Lawrence v Perry & Co Ltd* (1884) 2 RPC 179 at 188; *Reason Manufacturing Co Ltd v Ernest F Moy Ltd* (1902) 19 RPC 409 (on appeal (1903) 20 RPC 205, CA); *Kinmond v Keay* (1903) 20 RPC 497; *Hickton's Patents Syndicate v Patents*

and *Machine Improvements Co* (1909) 26 RPC 339, CA. As to the application of old means to get over special defects in complicated machines see *Edison-Bell Phonograph Corp Ltd v Smith* (1894) 11 RPC 389 at 398, CA, per Lord Esher MR; cf *British United Shoe Machinery Co Ltd v Hugh Claughton Ltd* (1906) 23 RPC 321 at 333.

7 *Flour Oxidizing Co Ltd v Carr & Co Ltd* (1908) 25 RPC 428; *Flour Oxidizing Co Ltd v Hutchinson* (1909) 26 RPC 597. See also *Harwood v Great Northern Rly Co* (1860) 29 LJQB 193 at 202; *Automatic Coal Gas Retort Co Ltd v Salford Corp* (1897) 14 RPC 450; *Welsbach Incandescent Gas Light Co Ltd v John M'Grady & Co* (1901) 18 RPC 513; *Anti-Vibration Incandescent Lighting Co Ltd v Crossley* (1905) 22 RPC 441, CA; *J and J Evans, Taunton Ltd v Hoskins and Sewell Ltd* (1907) 24 RPC 517, CA.

8 *Penn v Bibby* (1866) 2 Ch App 127; *Cannington v Nuttall* (1871) LR 5 HL 205; *Gadd and Mason v Manchester Corp* (1892) 9 RPC 516, CA; *British Liquid Air Co Ltd v British Oxygen Co Ltd* (1909) 26 RPC 509, HL (affg (1908) 25 RPC 577, CA); *Higginson and Arundel v Bentley and Bentley Ltd* (1922) 39 RPC 177, CA; *Hale v Coombes* (1924) 41 RPC 112 at 137, CA (on appeal (1925) 42 RPC 328, HL); *Higginson and Arundel v Pyman* (1926) 43 RPC 291, CA; *Mellor v William Beardmore & Co Ltd* (1926) 43 RPC 361 at 372.

9 *Neilson v Harford* (1841) 8 M & W 806; *Muntz v Foster* (1843) 2 Web Pat Cas 93; *Edison and Swan Electric Light Co v Woodhouse and Rawson* (1887) 3 TLR 327, 4 RPC 79, CA; *Moseley v Victoria Rubber Co* (1887) 57 LT 142, 4 RPC 241; *Hayward v Hamilton* (1881) Griffin's Patent Cases (1884-1886) 115, CA; *Hopkinson v St James's and Pall-Mall Electric Lighting Co* (1893) 10 RPC 46; *Pirrie v York Street Flax Spinning Co Ltd* (1894) 11 RPC 429, CA; *Cassel Gold Extracting Co Ltd v Cyanide Gold Recovery Syndicate* (1895) 12 RPC 232, CA; *Automatic Coal Gas Retort Co Ltd v Salford Corp* (1897) 14 RPC 450; *Welsbach Incandescent Gas Lighting Co Ltd v John M'Grady & Co* (1901) 18 RPC 513; *Sandow Ltd v Szalay* (1905) 23 RPC 6, HL; *Hickton's Patent Syndicate v Patents and Machine Improvements Co* (1909) 26 RPC 339, CA; *Marconi and Marconi's Wireless Telegraph Co Ltd v British Radio-Telegraph and Telephone Co Ltd* (1911) 27 TLR 274, 28 RPC 181; *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231 at 256, CA.

10 *Gadd and Mason v Manchester Corp* (1892) 67 LT 576, 9 RPC 516, CA; *Wood v Raphael* (1896) 13 RPC 730 at 735 (affd (1897) 14 RPC 496, CA); *Siddeley v London Hygienic Ice Co Ltd* (1897) 14 RPC 514; *Dredge v Parnell* (1899) 16 RPC 625, HL; *Donnersmarckhütte Oberschlesische Eisen und Kohlenwerke AG v Electric Construction Co Ltd* (1910) 27 RPC 774 at 779, 783, CA; *Gillies v Gane Milking Machine Co* (1916) 34 RPC 21 at 29, PC; *Simplex Lithograph Co v Sir Joseph Causton & Sons Ltd* (1921) 38 RPC 403, CA; *Wallace v Tullis, Russell & Co* (1921) 39 RPC 3 at 24; *JD Insulating and Refrigerating Co Ltd v Thos Anderson Ltd* (1923) 41 RPC 1 at 19; *Lister Bros v Thorp, Medley & Co* (1930) 47 RPC 99 (affd 47 RPC 526 at 535, CA); *VD Ltd v Boston Deep Sea Fishing and Ice Co Ltd* (1935) 52 RPC 303 at 327. The fact that workers in a particular trade are ignorant of devices used in other trades is not necessarily sufficient to make the use of such devices in that trade patentable: cf *Patent Bottle Envelope Co v Seymer* (1858) 28 LJCP 22; *Shaw v Barton and Loudon* (1895) 12 RPC 282 at 291; *Nadel v Martin* (1903) 20 RPC 721 at 743, CA.

11 *Benmax v Austin Motor Co Ltd* (1953) 70 RPC 284 at 289, CA. However, on appeal that formula was, in fact, used: see (1955) 72 RPC 39 at 45, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/476. When analogous user arises.

476. When analogous user arises.

A presumption of analogous user is strong where two methods have been employed in the manufacture of particular articles or in particular trades, and only one of those methods has been employed in the manufacture of different articles or in different trades, and an application is made for a patent for the use of the other method in the manufacture of the last-mentioned articles or in the last-mentioned trades¹. The same applies where self-contained units of machinery, or processes fulfilling a function complete in itself, are sought to be transferred from one trade to another or to a different purpose in the same trade; if these units act in the old way, and achieve in their new environment a result not new in itself, there is, generally speaking, no sufficient subject matter to warrant the grant of a patent in respect of the new user².

A presumption of analogous user arises equally where there has been a duplication of an existing part of a patented apparatus without any alteration in its function or mode of action³. A similar presumption arises where the use of a mode of construction or action is extended without a new purpose being achieved⁴. Again, patents for making in one piece articles previously made in two or more pieces have generally been held to be invalid⁵, and, similarly, division of itself does not in general involve an inventive step⁶.

1 *Herrburger, Schwander & Cie v Squire* (1889) 6 RPC 194, CA; *Morgan & Co Ltd v Windover & Co* (1890) 7 RPC 131, HL; *Embossed Metal Plate Co Ltd v Saupe and Busch* (1891) 8 RPC 355; *Westley, Richards & Co v Perkes* (1893) 10 RPC 181; *Adamant Stone and Paving Co Ltd v Liverpool Corpn* (1896) 14 RPC 11 (on appeal (1897) 14 RPC 264, CA); *Wood v Raphael* (1897) 14 RPC 496, CA; *Rucker v London Electric Supply Corpn Ltd* (1900) 17 RPC 279; *Carter v Leyson (trading as Peckham Box Co)* (1902) 19 RPC 473; *Baxter v Marsden* (1904) 22 RPC 18; *Northern Press and Engineering Co Ltd v Hoe & Co* (1906) 23 RPC 613, CA.

2 *Tatham v Dania* (1869) Griffin's Patent Cases (1884-1886) 213; *Bamlett v Picksley* (1875) Griffin's Patent Cases (1884-1886) 40; *Cropper v Smith* (1884) 1 RPC 81 at 88, 90, CA; *Britain v Hirsch* (1888) 5 RPC 226; *Leadbeater v Kitchin* (1890) 7 RPC 235; *Hazlehurst v Rylands* (1890) 9 RPC 1, CA; *Shaw v Barton and Loudon* (1895) 12 RPC 282; *Farbenfabriken vormals Friedrich Bayer & Co v Chemische Fabrik von Heydon* (1905) 22 RPC 501; *Nadel v Martin* (1905) 23 RPC 41, HL; *Von der Linde v Brummerstaedt & Co* (1909) 26 RPC 289; *Doulton & Co Ltd v Albion Clay Co Ltd* (1911) 28 RPC 638, CA; *British United Shoe Machinery Co Ltd v Standard Engineering Co Ltd* (1916) 33 RPC 245 at 268, CA; *Bonnard v London General Omnibus Co Ltd* (1920) 38 RPC 1, HL; *Clorius v Tonner* (1922) 39 RPC 242; *British Oxygen Co Ltd v Maine Lighting Co* (1924) 41 RPC 604 at 614, CA; *Bowen v E J Pearson & Sons Ltd* (1924) 42 RPC 101; *Higginson and Arundel v Pyman* (1925) 43 RPC 113 at 136.

3 *Haslam & Co Ltd v Hall* (1887) 5 RPC 1 (on appeal (1888) 20 QBD 491, CA); *Deutsche Nahmaschinen Fabrik vormals Wertheim v Pfaff* (1890) 7 RPC 251, CA; *Elias v Grovesend Tinsplate Co* (1890) 7 RPC 455, CA; *Fuller v Handy* (1903) 21 RPC 6; *Read v Stella Conduit Co* (1916) 33 RPC 191 at 199, CA; *SA Servo-Frein Dewandre v Citroen Cars Ltd* (1930) 47 RPC 221 at 273, CA; *Wilkey and Whites Manufacturing Co Ltd v H Freeman and Letrik Ltd* (1931) 48 RPC 405.

4 *Nicoll v Swears and Wells* (1893) 69 LT 110, 10 RPC 240; *Allen v Horton* (1893) 10 RPC 412; *Siddall and Hilton Ltd v Wood* (1903) 21 RPC 230.

5 *Ormson v Clarke* (1863) 14 CBNS 475; *Blakey & Co v Latham & Co* (1888) 6 RPC 29 (on appeal (1889) 6 RPC 184, CA); *Longbottom v Shaw* (1891) 8 RPC 333 at 338, HL; *Woodrow v Long, Humphreys & Co Ltd* (1933) 51 RPC 25, CA.

6 *Macnamara v Hulse* (1842) 2 Web Pat Cas 128n.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/477. Analogous proposals.

477. Analogous proposals.

There can only be a question of analogous user where there has been actual use of the earlier matter and not merely a suggestion of such use, for example in a patent specification¹. Analogous prior proposals may, however, in some cases invalidate a later claim².

¹ *Pope Appliance Corp v Spanish River Pulp and Paper Mills Ltd* [1929] AC 269 at 282, 46 RPC 23 at 56, PC; *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231 at 236, CA.

² Such cases have been rare. An example, perhaps, is *Allmänna Svenska Elektriska AB v Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63, CA: see *Martin and Biro Swan Ltd v H Millwood Ltd* (1954) 71 RPC 458 at 459, CA, per Jenkins LJ, in argument. *Benmax v Austin Motor Co Ltd* (1953) 70 RPC 284 at 285, 293, CA, might have been an example, but on appeal a different view was taken on the prior document: see (1955) 72 RPC 39 at 46-47, HL. See also *Nadel v Martin* (1903) 20 RPC 721 at 741, 743, CA; *Gillette Safety Razor Co v Anglo-American Trading Co Ltd* (1913) 30 RPC 465 at 479, HL; *Servo-Frein Dewandre SA v Citroen Cars Ltd* (1930) 47 RPC 221 at 255, 278, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/478. New use of old substance.

478. New use of old substance.

A valid patent may be obtained for a new use of a known substance if the use is not obvious, or produces considerable advantages¹; but the fact that the substance had been used for analogous purposes², or that analogous substances had been used for the new purpose³, would invalidate the claim.

1 For examples of such patents see *Walton v Potter* (1841) 1 Web Pat Cas 585 (use of india rubber for holding teeth of cards); *Muntz v Foster* (1843) 2 Web Pat Cas 93 (use of special copper alloy for sheathing); *Innes v Short and Beal* (1898) 14 TLR 492, 15 RPC 449 (use of zinc powder to prevent furring in boilers). In *Re Martin and Hyam's Patent* (1855) 25 LTOS 170 it was suggested that the use of gutta percha for clogs would be patentable. In *United Telephone Co v Harrison, Cox-Walker & Co* (1882) 21 ChD 720, it was suggested that the use of mica in telephone tympana would not be in itself patentable. It was held that the use of block instead of sheet felt for bicycle handles was not subject matter sufficient for the grant of a patent in *Cooper & Co (Birmingham) Ltd v Baedeker* (1900) 17 RPC 209, CA. See also *Rushton v Crawley* (1870) LR 10 Eq 522; *United Telephone Co v Harrison, Cox-Walker & Co*; *McClay v Lawes & Co Ltd* (1905) 22 RPC 199 at 203.

2 *Riekmann v Thierry* (1896) 14 RPC 105, HL.

3 *Albo-Carbon Light Co v Kidd* (1887) 4 RPC 535 at 539 (use of solid instead of liquid naphtha to enrich gas). See also *Palmer Tyre Ltd v Pneumatic Tyre Co Ltd* (1899) 16 RPC 451 at 494.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/479. New use of old process.

479. New use of old process.

There may be invention in applying a process to a substance or use to which it has not previously been applied, if the application or its results are not obvious¹. Most chemical patents fall within this category².

¹ *Reitzman v Grahame-Chapman and Derustit Ltd* (1950) 68 RPC 25 at 38-39, CA, citing *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 RPC 369, HL; *Samuel Heap & Son Ltd v Bradford Dyers' Association Ltd* (1929) 46 RPC 254. Such new use was held to involve invention in *Crane v Price* (1842) 1 Web Pat Cas 393; *Steiner v Heald* (1851) 6 Exch 607, Ex Ch; *British Liquid Air Co Ltd v British Oxygen Co Ltd* (1908) 25 RPC 577 at 601, CA (affd (1909) 26 RPC 509, HL); *Osram Lamp Works Ltd v Z Electric Lamp Manufacturing Co Ltd* (1912) 29 RPC 401 at 421, 423; *Manbré and Garton Ltd v Albion Sugar Co Ltd* (1936) 53 RPC 281. Such new use was held not to involve invention in *British Thomson-Houston Co Ltd v Duram Ltd* (1918) 35 RPC 161, HL; *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 259 at 285, CA (affd (1935) 152 LT 537, 52 RPC 171, HL).

² See eg *Re May and Baker Ltd and Ciba Ltd's Letters Patent* (1948) 65 RPC 255 at 281; and the other cases relating to selection patents cited in PARA 480.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/480. Selection patents.

480. Selection patents.

In the case of selection patents¹ the inventive step lies in the selection, from among a known class of bodies, apparatus or processes, of some which possess a special advantage. It is necessary for the validity of a selection patent that substantially the whole of the selected group should possess this advantage and that it must be peculiar to the group, or at least be possessed by only a limited class of things outside it². Generally also, where there is no novelty in the method of preparation, the advantage should be of an unexpected character, or otherwise not obvious to persons skilled in the art³.

The nature of the special characteristics on which the selection is based must, at least in chemical cases, be stated in the specification⁴. After-discovered advantages are highly unlikely to be capable of supporting inventiveness⁵.

When the possible choice is limited to a small number of variants, selection can seldom afford matter for the grant of a patent⁶.

1 As to the meaning of 'selection patent' see PARA 321. As to novelty of selection patents see PARA 441.

2 *Re May and Baker Ltd and Ciba Ltd's Letters Patent* (1948) 65 RPC 255 at 281, citing *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289 at 322; *Shell Refining and Marketing Co Ltd's Patent* [1960] RPC 35 at 52, CA. For an example of a valid selection patent dealing with bacteriological processes see *Commercial Solvents Corp'n v Synthetic Products Co Ltd* (1926) 43 RPC 185 at 225. See also *Farbwerke Hoechst AG v Unichem Laboratories* [1969] RPC 55.

3 *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289 at 321, 323. On this point cf *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1927) 44 RPC 367; affd (1928) 45 RPC 153, CA.

4 *Re IG Farbenindustrie AG's Patents* (1930) 47 RPC 289 at 323. See also *Philips (Bosgra's) Application* [1974] RPC 241; *El du Pont de Nemours & Co (Witsiepe's) Application* [1982] FSR 303, HL; *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195 at 218, CA.

5 *Re Richardson-Vicks Inc's Patent* [1995] RPC 568; *Ranbaxy UK Ltd v Warner-Lambert Co* [2005] EWHC 2142 (Pat), [2006] FSR 209.

6 *Simplex Lithograph Co v Sir Joseph Causton & Sons Ltd* (1921) 38 RPC 403, CA; *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 63 at 110, 114 (affd (1935) 152 LT 537, 52 RPC 171, HL). Except in chemical cases, the number of possible variants is usually too small for a selection of any one to be patentable. For a chemical case in which the general class was too small to admit a valid selection see *Beecham Group Ltd's (Amoxycillin) Application* [1980] RPC 261, CA. See, however, *El du Pont de Nemours & Co (Witsiepe's) Application* [1982] FSR 303, HL (cited in PARA 441 note 12).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/481. Combination patents.

481. Combination patents.

A combination or collocation of integers the production of which has required independent thought, ingenuity or skill may constitute good subject matter for the grant of a patent, provided that it enables a more efficient result to be obtained, even though all the integers are old¹. This general statement covers two classes of invention:

- 247 (1) combinations proper, in which the several integers are so placed together that by their working interrelation they produce a new or improved result², so that the combination is more than the mere sum of its integers³; and
- 248 (2) combinations of a number of integers, mechanical or chemical, which produces a result superior to what was formerly achieved, even though each integer performs its old function⁴.

Most claims appear at first sight to be combination claims, since they specify the use of a device either in particular machines or with other integers. It must, however, be borne in mind that claims are often so framed for the purpose of description or limitation, or in order to avoid questions of anticipation⁵.

1 *Mercedes Daimler Motor Co Ltd v FIAT Motor Cab Co Ltd* (1915) 32 RPC 393 at 413, HL; *Canadian General Electric Co Ltd v Fada Radio Ltd* [1930] AC 97 at 101, 47 RPC 69 at 88, PC; *C Van der Lely NV v Bamfords Ltd* [1961] RPC 296 at 308, CA (affd [1963] RPC 61, HL).

2 *Martin and Biro Swan Ltd v H Millwood Ltd* [1956] RPC 125 at 132, HL, citing *British Celanese Ltd v Courtaulds Ltd* (1935) 52 RPC 171, HL; *Drysdale and Sidney Smith and Blyth Ltd v Davey Paxman & Co (Colchester) Ltd and Re Letters Patent No 274162* (1937) 55 RPC 95 at 114.

3 *Bamlett v Picksley* (1875) Griffin's Patent Cases (1884-1886) 40 at 44; *Allen v Oates and Green Ltd* (1898) 15 RPC 298 at 303 (affd 15 RPC 744); *Re Klaber's Patent* (1906) 23 RPC 461 at 469, HL; *British United Shoe Machinery Co Ltd v A Fussell & Sons Ltd* (1908) 25 RPC 631 at 657, CA. Examples illustrating forms of patentable combination will be found in *Cornish and Sievier v Keene and Nickels* (1835) 1 Web Pat Cas 512 at 517 (subsequent proceedings (1837) 3 Bing NC 570); *Spencer v Jack* (1864) 11 LT 242; *Cannington v Nuttall* (1871) LR 5 HL 205; *Murray v Clayton* (1872) 7 Ch App 570; *Harrison v Anderston Foundry Co* (1876) 1 App Cas 574, HL; *Vickers, Son & Co Ltd v Siddell* (1890) 15 App Cas 496, HL; *Nobel's Explosives Co Ltd v Anderson* (1894) 10 TLR 599, 11 RPC 519, CA; *Pneumatic Tyre Co Ltd v Caswell* (1896) 13 RPC 375, CA; *Fawcett v Homan* (1896) 12 TLR 507, 13 RPC 398; *Deeley v Perkes* [1896] AC 496 at 497, 13 RPC 581 at 589, HL; *Molassine Co Ltd v R Townsend & Co Ltd* (1905) 23 RPC 27; *Kelvin v Whyte, Thomson & Co* (1907) 25 RPC 177; *International Harvester Co of America v Peacock* (1908) 25 RPC 765, PC. In some of these cases the result was new in itself; in others the means for its production differed substantially from those formerly used for the same purpose. See also *Amp Inc v Hellermann Ltd* [1966] RPC 159 at 184, CA; *Rado v John Tye & Son Ltd* [1967] RPC 297 at 302, CA.

4 See PARA 483.

5 *Dredge v Parnell* (1898) 15 RPC 84 at 90, CA (affd (1899) 16 RPC 625, HL); *Pugh v Riley Cycle Co Ltd* (1914) 31 RPC 266 at 283, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/482. Requisites of valid combination.

482. Requisites of valid combination.

The inventive step necessary to make a combination patentable may exist in all or any of the stages of invention¹; and a patentable combination may be one producing a new result, or arriving at an old result in a better or cheaper way², or giving a useful choice of means³. Different considerations apply to each of these cases in order to arrive at a conclusion whether there is an inventive step in the particular combination. The fact that the result is new is itself cogent evidence of invention⁴; but, if the result is old, it is probably correct to regard the combination as being the result of intelligent choice rather than the result of an inventive step⁵. If it has been necessary to make modifications in the form or construction of all or any of the separate old integers included in the combination in order to ensure their more perfect interaction, there is a strong presumption that there has been invention⁶. In determining whether the combination of features of a claim is obvious, it is not legitimate to take the features one at a time⁷.

1 As to the stages of invention see PARA 459.

2 *Cornish and Sievier v Keene and Nickels* (1835) 1 Web Pat Cas 512 at 517; *Crane v Price* (1842) 1 Web Pat Cas 393 at 409; *Spencer v Jack* (1864) 11 LT 242; *Cannington v Nuttall* (1871) LR 5 HL 205; *Murray v Clayton* (1872) 7 Ch App 570; *Harrison v Anderston Foundry Co* (1876) 1 App Cas 574, HL; *International Harvester Co of America v Peacock* (1908) 25 RPC 765, PC; *Mabuchi Motor KK's Patents* [1996] RPC 387 at 409. In some of these cases the result was new in itself; in others the means for its production differed substantially from those formerly used for the similar purpose.

3 *Scott v Hamling & Co Ltd* (1896) 14 RPC 123 at 140; *Assidoman Multipack Ltd v Mead Corpn* [1995] RPC 321 at 345-346.

4 *Crosthwaite Fire Bar Syndicate Ltd v Senior* (1909) 26 RPC 713 at 732.

5 *Donnersmarckhütte Oberschlesische Eisen und Kohlenwerke AG v Electric Construction Co Ltd* (1910) 27 RPC 774 at 783, CA.

6 *International Harvester Co of America v Peacock* (1908) 25 RPC 765 at 777, PC.

7 *Shoketsu Kinzoku Kogyo KK's Patent* [1992] FSR 184.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/483. Combination by selection.

483. Combination by selection.

There can be a valid claim to a mere collocation of separate integers none of which interact¹, or of successive processes, or steps in a process, which are directed to different qualities of the article to be manufactured². In such cases, however, it is *prima facie* sufficient to invalidate the claim that each integer, or part of the process, is old when taken by itself³; the claim can be valid only if invention was involved in selecting the best integers or process steps to put together⁴, and only rarely (in the absence of interaction between the integers or steps) can the requirements for a valid selection patent be fulfilled⁵. It is relevant to the validity of such a claim whether the separate integers have been commonly used⁶ or their use has been merely suggested in earlier specifications⁷. An important consideration is, however, whether the combination as a whole has resulted in a real advance in the art⁸.

1 If some of the integers of the claim interact so as to constitute a true combination, it is no objection to the claim that it specifies other integers irrelevant to the combination, although these surplus integers will normally be disregarded in considering subject matter: *Edison-Bell Phonograph Corp Ltd v Smith* (1894) 11 RPC 148 at 163 (affd 11 RPC 389, CA); *British Dynamite Co v Krebs* (1896) 13 RPC 190, HL; *British United Shoe Machinery Co Ltd v A Fussell & Sons Ltd* (1908) 25 RPC 631 at 649, CA.

2 An example perhaps is *Lightning Fastener Co Ltd v Colonial Fastener Co Ltd* (1934) 51 RPC 349, PC.

3 See *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 259 at 272, CA (on appeal (1935) 52 RPC 171, HL); and see *Williams v Nye* (1890) 7 RPC 62, CA; *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1927) 44 RPC 367 (affd (1928) 45 RPC 153, CA). See also *Saxby v Gloucester Waggon Co* (1881) 7 QBD 305 (affd (1883) Griffin's Patent Cases (1887) 56, HL); *Re Gaulard and Gibbs' Patent* (1890) 7 RPC 367, HL; *Northern Press and Engineering Co Ltd v Hoe & Co* (1906) 23 RPC 417 (on appeal 23 RPC 613, CA); *Thermos Ltd v Isola Ltd* (1910) 27 RPC 388; *Donnersmarckhütte Oberschlesische Eisen und Kohlenwerke AG v Electric Construction Co Ltd* (1910) 27 RPC 321 (on appeal 27 RPC 774, CA); *Hanks v Coombes* (1928) 45 RPC 237 at 256, CA.

4 *Saxby v Gloucester Waggon Co* (1881) 7 QBD 305 at 312; *Chadburn v Mechan & Sons* (1895) 12 RPC 120 at 154.

5 As to these requirements see PARA 480.

6 Ie so that their respective effects and limitations are known.

7 *Von Heyden v Neustadt* (1880) 50 LJ Ch 126 at 128. CA. See also PARA 480 et seq.

8 *Paterson Engineering Co Ltd v Candy Filter Co Ltd* (1932) 50 RPC 1 at 8, CA; *Shoketsu Kinzoku Kogyo KK's Patent* [1992] FSR 184.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/484. Omission.

484. Omission.

There may be invention in the omission of a stage of a process¹, or of an unnecessary part of a machine², or of an unnecessary ingredient³, or in appreciating that previous standards were unnecessarily high⁴. However, a patent of this sort presents great difficulty, and a claim based upon such an inventive step must be strictly limited to things making use of that step⁵.

1 'It is just as much invention to reject the bad as to select the good': *British Westinghouse Electric and Manufacturing Co v Braulik* (1910) 27 RPC 209 at 224, CA, per Fletcher Moulton LJ. See also *Russell v Cowley* (1835) 1 Web Pat Cas 457, 465; *Booth v Kennard* (1857) 26 LJ Ex 305; *Leonhardt & Co v Kallé & Co* (1895) 12 RPC 103; *Badische Anilin und Soda Fabrik v Société Chimique des Usines du Rhône and Wilson* (1898) 14 RPC 875 (affd 15 RPC 359, CA).

2 *Minter v Mower* (1835) 1 Web Pat Cas 138. Cf *British Motor Syndicate Ltd v Universal Motor Carriage and Cycle Co Ltd* (1899) 16 RPC 113; *Beston v Watts* (1908) 25 RPC 19, CA.

3 *Cassel Gold Extracting Co Ltd v Cyanide Gold Recovery Syndicate* (1895) 11 TLR 345 at 348, 12 RPC 232 at 254, CA.

4 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 136-137, CA; affd [1948] 1 All ER 308, 65 RPC 141, HL.

5 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1946) 63 RPC 113 at 137, CA, impliedly approved on appeal [1948] 1 All ER 308, 65 RPC 141, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/485. Variation.

485. Variation.

A variation in scale or degree in an article or process may form subject matter if it has brought about new and useful results¹.

Although it cannot be laid down as a rule of law that there is no patentable subject matter in printing or drawing on articles signs that facilitate their use, the courts have generally refused to recognise the validity of patents having such an object². Similarly, variations in the shape of articles to adapt them for use on a particular machine do not generally form patentable subject matter, even though the machine itself is novel and constitutes a patentable invention³.

In some cases, and particularly in the case of chemical patents, a variation of old methods has been held to constitute an inventive step because it is not possible to predict the new result from the results of the old methods without experiment and research⁴.

1 *British Vacuum Cleaner Co Ltd v Suction Cleaners Ltd* (1904) 21 RPC 303; *British Vacuum Cleaner Co Ltd v London and South Western Rly Co* (1912) 29 RPC 309, HL. See also *Bovill v Cowan* [1867] WN 115; *Bovill v Crate* (1867) Griffin's Patent Cases (1887) 46 at 47; *Thompson v Moore* (1889) 23 LR 599 at 657, 6 RPC 426 at 455; *Nobel's Explosives Co Ltd v Anderson* (1894) 10 TLR 599, 11 RPC 519, CA (affd (1895) 11 TLR 266, 12 RPC 164, HL); *Re Brown's Patent* (1907) 25 RPC 86 at 116, CA; *J Lucas (Batteries) Ltd v Gaedor Ltd* [1978] RPC 297. For the limitation of this principle see, however, *Donnersmarckhütte Oberschlesische Eisen und Kohlenwerke AG v Electric Construction Co Ltd* (1910) 27 RPC 774 at 783, CA. Many chemical process claims are of this nature.

2 *Philpott v Hanbury* (1885) 2 RPC 33; *James Duckett & Son Ltd and Duckett v Sankey & Son* (1899) 16 RPC 357 at 359; *Re Klaber's Patent* (1902) 19 RPC 174; cf *Johnson v Warner Bros Pictures Ltd* (1930) 48 RPC 343.

3 *Lamson Paragon Supply Co Ltd v Carter-Davis Ltd* (1930) 48 RPC 133.

4 *Electric Telegraph Co v Brett* (1851) 20 LJCP 123 at 131; *Moseley v Victoria Rubber Co* (1887) 57 LT 142 at 146, 4 RPC 241 at 252; *Nobel's Explosives Co Ltd v Anderson* (1894) 11 RPC 115 at 127; *Leonhardt & Co v Kallé & Co* (1895) 12 RPC 103; *Lancashire Explosives Co Ltd v Roburite Explosives Co Ltd* (1895) 12 TLR 35, 12 RPC 470, CA (affd (1897) 14 RPC 303, HL); *British Liquid Air Co Ltd v British Oxygen Co Ltd* (1908) 25 RPC 577 at 601, CA; *British United Shoe Machinery Co Ltd v A Fussell & Sons Ltd* (1908) 25 RPC 631 at 648, CA; *Osram Lamp Works Ltd v Z Electric Lamp Manufacturing Co Ltd* (1912) 29 RPC 401 at 421, 423; *Margreth v Acetylene Lamp Co* (1913) 30 RPC 184 at 192; *Ore Concentration Co (1905) Ltd v Sulphide Corp Ltd* (1914) 31 RPC 206 at 226, PC; *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 RPC 369 at 396, HL. It is otherwise where existing knowledge pointed to the result as probable: see *Re Alsop's Patent* (1907) 24 RPC 733; *Sharpe and Dohme Inc v Boots Pure Drug Co Ltd* (1927) 44 RPC 367 (affd (1928) 45 RPC 153, CA).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/486. Adjustments.

486. Adjustments.

The courts have generally held that there is no inventive step in a claim to working a machine, process or apparatus in a particular manner or for a particular object¹, or in adjustments to it or in it which are within the capacity of an expert workman², but there is no absolute rule; a new use of old apparatus may be validly patentable³, and an adjustment may produce what is in effect a new article⁴.

1 *Kay v Marshall* (1841) 8 Cl & Fin 245, 2 Web Pat Cas 79, HL; *Ralston v Smith* (1865) 11 HL Cas 223; *Bovill v Crate* (1867) Griffin's Patent Cases (1887) 46; *Pugh v Riley Cycle Co Ltd* (1914) 31 RPC 266 at 282, HL; *British United Shoe Machinery Co Ltd v Standard Rotary Machine Co Ltd* (1917) 35 RPC 33, HL; *British Thomson-Houston Co Ltd v Duram Ltd* (1918) 35 RPC 161, HL.

2 *Cincinnati Grinders Inc v BSA Tools Ltd* (1930) 48 RPC 33, CA.

3 *Flour Oxidizing Co Ltd v Carr & Co Ltd* (1908) 25 RPC 428 (a case often cited by higher courts).

4 *Molins v Industrial Machinery Co Ltd* [1937] 4 All ER 295, 55 RPC 31, CA, explaining *British Thomson-Houston Co Ltd v Metropolitan-Vickers Electrical Co Ltd* (1928) 45 RPC 1, HL; *Dyson Appliances Ltd v Hoover Ltd* [2001] RPC 473 at 529. Probably the real question is what adjustments an expert workman would have been likely to think of making: *Pugh v Riley Cycle Co Ltd* (1913) 30 RPC 514, CA; on appeal (1914) 31 RPC 266, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(iv) Obviousness/487. Small results.

487. Small results.

Where a change has been made in a known article or process to effect a small result of trifling or dubious utility, or where it is not essential to the result obtained, the new variation thereby effected does not in general amount to an inventive step¹. These so-called inventions generally consist in the choice of well-known variants to meet some special purpose often at the sacrifice of other advantages in the forms already in use, in circumstances which lend no weight to the argument that the novelty of the new variation implies that it was not obvious².

¹ *Re Waterhouse's Patent* (1906) 23 RPC 470 at 477 per Romer LJ. See also *R v Arkwright* (1785) 1 Web Pat Cas 64; *Pow v Taunton* (1845) 9 Jur 1056; *Dangerfield v Jones* (1865) 13 LT 142. Use of the test stated in PARA 455 may, however, lead to such considerations as these being disregarded, as in *Killick v Pye Ltd* [1958] RPC 366, CA.

² Examples of such patents are *Dobbs v Penn* (1849) 3 Exch 427; *Lawrence v Perry & Co Ltd* (1884) 2 RPC 179; *Re Haddan's Patent* (1885) 2 RPC 218; *Rowcliffe v Longford Wire, Iron and Steel Co Ltd* (1887) 4 RPC 281; *Fletcher v Arden, Hill & Co* (1887) 5 RPC 46; *Tucker v Kaye* (1891) 8 RPC 230, CA; *Wilson v Union Oil Mills Co Ltd* (1891) 9 RPC 57; *Murchland v Nicholson* (1893) 10 RPC 417; *Cera Light Co Ltd v Dobbie & Son* (1892) 11 RPC 10; *Montgomerie v Patterson* (1894) 11 RPC 633; *Sudbury v Lee and Glen* (1894) 11 RPC 58; *Savage v DB Harris & Sons* (1896) 12 TLR 332, 13 RPC 364, CA; *Beavis v Rylands Glass and Engineering Co Ltd* (1899) 17 RPC 93 (affd (1900) 17 RPC 704, CA); *Patent Exploitation Ltd v American Electrical Novelty and Manufacturing Co Ltd* (1905) 22 RPC 316, CA; *Nadel v Martin* (1905) 23 RPC 41, HL; *British United Shoe Machinery Co Ltd v Hugh Claughton Ltd* (1906) 23 RPC 321 (affd (1907) 24 RPC 33, CA); *Re Waterhouse's Patent* (1906) 23 RPC 470; *Stroud v Humber Ltd* (1906) 24 RPC 141; *Hill v Thomas & Sons* (1907) 24 RPC 415, CA; *Sirdar Rubber Co Ltd and Maclulieh v Wallington, Weston & Co* (1907) 97 LT 113, 24 RPC 539, HL; *Consolidated Pneumatic Tool Co Ltd v Clark* (1907) 24 RPC 593, CA; *Arnot v Dunlop Pneumatic Tyre Co Ltd* (1908) 25 RPC 309, HL; *Witham Bros Ltd and Lord v Catlow, Marsden and Dunn* (1908) 25 RPC 788; *Atkinson v Britton* (1910) 27 RPC 469, CA; *Pugh v Riley Cycle Co Ltd* (1914) 31 RPC 266 at 282, HL; *Mercedes Daimler Motor Co Ltd v FIAT Motor Car Co Ltd* (1915) 32 RPC 393 at 414, HL; *Re Hancock's Patent* (1917) 34 RPC 283 at 288; *Bloxham v Kee-Less Clock Co* (1922) 39 RPC 195 at 211; *Rose v JW Pickavant & Co Ltd* (1923) 40 RPC 320; *Shaw v Burnet & Co* (1924) 41 RPC 432; *Thomas v South Wales Colliery Tramways and Engineering Co Ltd* (1924) 42 RPC 22 at 28; *Tucker v Wandsworth Electrical Manufacturing Co Ltd* (1925) 42 RPC 480 at 491 (on appeal 42 RPC 531, CA); *White v Todd Oil Burners Ltd* (1929) 46 RPC 275 at 291.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(v) Industrial Application/488. Capacity for industrial application.

(v) Industrial Application

488. Capacity for industrial application.

An invention¹ is taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture².

1 As to the extent of an invention see PARA 431 note 1.

2 Patents Act 1977 s 4(1) (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 4, Sch 3). The inclusion of agriculture is to remove any doubt that inventions such as new methods of treating crops are patentable.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vi) Lack of Entitlement to Patent/489. Patent granted to person not entitled.

(vi) Lack of Entitlement to Patent

489. Patent granted to person not entitled.

A patent is invalid, as against a person with a good title, for a limited period after grant, if the grantee or one of the grantees was not a person entitled to be granted that patent¹. The function of this provision is to enable cases of misappropriation of inventions or parts of inventions to be resolved; it is not appropriate to the resolution of mere disputes over ownership². The issue of validity may be raised on the ground of disentitlement only by a person found by the court³ or the comptroller⁴ to be entitled to the grant of the patent or part of the patent concerned⁵. Either the proceedings in which the issue is raised, or the proceedings in which the rival title is established, must in general be commenced within two years beginning with the date of the grant⁶ unless it is shown that some person registered⁷ as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent⁸.

1 Patents Act 1977 s 72(1)(b) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 18); and see PARAS 430, 564-565. As to the persons entitled to a patent see the Patents Act 1977 s 7(2); and PARA 307.

2 The effect of a successful challenge to validity is to destroy the patent, which is rarely a practical way of resolving a dispute as to ownership. But see *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693; affd [1999] RPC 442, [1998] All ER (D) 545, CA. As to disputes over ownership of patents see PARA 361 et seq.

3 Ie in an action for a declaration or on a reference under the Patents Act 1977 s 37: see PARA 366. As to the meaning of 'court' see PARA 637 note 1.

4 Ie on a reference under the Patents Act 1977 s 37. As to the comptroller see PARA 577.

5 Such a finding must precede an application to revoke on this ground (see the Patents Act 1977 s 72(2)(a); and see *Dolphin Showers Ltd and Brueton v Farmiloe* [1989] FSR 1 at 6), but it may be made in or concurrently with any other dispute over validity (see the Patents Act 1977 s 74(4), (5); and PARA 520). For example, it may be raised as a defence in infringement proceedings and the court can give directions as to how the issue should be determined: *Dolphin Showers Ltd and Brueton v Farmiloe*. A person to whom the right of a person entitled to be granted the patent has been assigned after the date of the grant of the patent cannot claim for revocation on this ground: *Dolphin Showers Ltd and Brueton v Farmiloe*.

6 See the Patents Act 1977 s 74(4)(b).

7 As to registration see PARA 585 et seq.

8 Patents Act 1977 s 74(4)(b). It appears, however, that, taking the provisions cited in the previous notes with s 37, a person who fails to act within the two-year period can thereafter apply to the comptroller (although he may not apply to the court: see s 37(9); and PARA 367) to determine title and can thereafter put validity in issue but not apply to revoke. This was probably not intended, and the effect on third persons of a resulting finding of invalidity is wholly obscure.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/490. Patent specification insufficient.

(vii) Insufficiency

490. Patent specification insufficient.

A patent is invalid if the specification¹ does not disclose² the invention clearly enough and completely enough to enable the invention to be performed by a person skilled in the art³. In an ordinary product claim, the product is the invention and it is sufficiently enabled if the specification and common general knowledge enables the skilled person to make it⁴.

This objection corresponds closely to one branch of the objection to the validity of patents under the Patents Act 1949 known as 'insufficiency'⁵, so the older cases are relevant⁶. Care must be taken, however, in applying the older authorities because of the differences in wording of the relevant provisions of the Patents Act 1949 and the Patents Act 1977 and because the question of sufficiency is one of fact⁷.

¹ As to the specification see PARA 319.

² Matter is taken to have been disclosed in a specification if it was either claimed or disclosed, otherwise than by way of disclaimer or acknowledgment of prior art, in that specification: see the Patents Act 1977 s 130(3). The disclosure must be an enabling disclosure: *Biogen Inc v Medeva plc* [1997] RPC 1 at 47, HL; *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323. The test for enablement for insufficiency and for anticipation is the same: see *Synthon BV v Smithkline Beecham*, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent*; and PARA 438.

³ Patents Act 1977 ss 72(1)(c), 74(3). As to persons skilled in the art see PARAS 456, 492. The test to be applied is whether the disclosure is sufficient to enable the whole width of the claimed invention to be performed, having regard to the nature and extent of the claim. Enablement of one embodiment of the patent will not always amount to sufficient disclosure: *Chiron Corp v Murex Diagnostics Ltd (No 12)*; *Chiron Corp v Organon Teknika Ltd (No 12)* [1996] FSR 153, CA. See also *American Home Products Corp v Novartis Pharmaceuticals UK Ltd* [2001] RPC 159, CA; *Pharmacia Corp v Merck & Co, Inc* [2001] EWCA Civ 1610, [2002] RPC 775 at 834; *Norbrook Laboratories Ltd's Patent (Application for Revocation by Schering-Plough)* [2005] EWHC 2532 (Pat), [2006] FSR 302; *Halliburton Energy Services Inc v Smith International Inc* [2006] EWCA Civ 1715, [2006] All ER (D) 246 (Dec); *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2002] EWCA Civ 1096, [2003] RPC 31 at 71; *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46 at [103], [2005] 1 All ER 667 at [103], [2005] RPC 169 at [103] per Lord Hoffmann (whether the specification is sufficient or not is highly sensitive to the nature of the invention. The first step is to identify the invention and decide what it claims to enable the skilled man to do. Then one can ask whether the specification enables him to do it); *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323.

⁴ See *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311 at [27], (2008) 101 BMLR 52 at [27], [2008] All ER (D) 152 (Apr) at [27] per Lord Hoffmann. In this case the Court of Appeal declined to find that the decision in *Biogen Inc v Medeva plc* [1997] RPC 1, 38 BMLR 149, HL, established a broad principle but was instead limited to 'product-by-process' claims.

⁵ Under the Patents Act 1949, it was an objection to the validity of a patent that the complete specification: (1) did not sufficiently and fairly describe the invention and the method by which it was to be performed; or (2) did not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection: see s 32(1)(h) (repealed). Head (1) specified two distinct duties: *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245 at 265, CA.

⁶ See PARA 492 et seq.

⁷ *Mentor Corp v Hollister Inc* [1991] FSR 557 at 561; *Halliburton Energy Services Inc v Smith International Inc* [2006] EWCA Civ 1715 at [12], [2006] All ER (D) 246 (Dec) at [12]. The relevant statutory provisions are the

Patents Act 1949 s 32(1)(h) and the Patents Act 1977 s 72(1)(c). See also *Helitune Ltd v Stewart Hughes Ltd* [1991] FSR 171 at 201.

UPDATE

490 Patent specification insufficient

NOTE 3--See *Novartis AG v Johnson & Johnson Medical Ltd (t/a Johnson & Johnson Vision Care)* [2009] EWHC 1671 (Pat), [2009] All ER (D) 129 (Jul) (patent did not enable skilled person to predict whether particular product would satisfy requirement of claims without clinical testing).

NOTE 4--*Generics*, cited, affirmed: [2009] UKHL 12, [2009] 2 All ER 955.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/491. Nature of objection to insufficiency of description.

491. Nature of objection to insufficiency of description.

The specification must enable the invention to be performed to the full extent of the monopoly claimed¹. In order to decide whether the specification is sufficient, the first step is to decide what the invention is and this is to be found by reading and construing the claims².

If the invention discloses a principle capable of general application, the claims may be in correspondingly general terms and the patentee does not need to show that he has proved its application in every general instance³. On the other hand, if the claims include a number of discrete methods or products, then the patentee has to enable the invention to be performed in respect of each of them⁴. The skilled man does not necessarily have to be put in the position of being able to perform all possible embodiments; it may sometimes be enough if he can make one embodiment using the information in the specification, his own common general knowledge and any reasonable trial and error⁵. The instructions must be such as to enable the skilled addressee to perform the invention using the common general knowledge, carrying out routine methods of trial and error, correcting obvious errors and omissions⁶ but without undue effort⁷ or prolonged research, inquiry or experiment⁸.

1 *Biogen Inc v Medeva plc* [1997] RPC 1 at 48, HL. See also *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311, (2008) 101 BMLR 52, [2008] All ER (D) 152 (Apr). The formulation in *Biogen Inc v Medeva plc* of what constituted insufficiency was initially regarded as extending the scope of the objection of insufficiency and a contrast was drawn between so-called 'Biogen' insufficiency and 'classical' insufficiency. There is, however, only one ground of insufficiency, namely that provided for in the Patents Act 1977 s 72(1)(c) (see PARA 490): *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2002] EWCA Civ 1096, [2003] RPC 31 at 65, CA.

2 *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323; *Generics (UK) Ltd v H Lundbeck A/S* [2008] EWCA Civ 311 at [29], (2008) 101 BMLR 52 at [29], [2008] All ER (D) 152 (Apr) at [29].

3 *Biogen Inc v Medeva plc* [1997] RPC 1 at 48, HL. See also *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169; *Norton's Patent* [2006] FSR 302.

4 *Biogen Inc v Medeva plc* [1997] RPC 1 at 48, HL. See also *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169; *Norbrook Laboratories Ltd's Patent* [2006] FSR 302. See also *Genentech I/Polypeptide expression* (T 292/85) [1989] OJ EPO 275; *Exxon/Fuel Oils* (T 409/91) [1994] OJ EPO 653.

5 *Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83 at 136; *Mölnlycke AB v Procter & Gamble Ltd (No 5)* [1994] RPC 49 at 99, CA; *Chiron Corp v Organon Technika Ltd (No 3)*, *Chiron Corp v Murex Diagnostics Ltd (No 3)* [1994] FSR 202 at 240.

6 *Valensi v British Radio Corp* [1973] RPC 337, CA (a case under the Patents Act 1949); *Helitune Ltd v Stewart Hughes Ltd* [1991] FSR 171 at 197.

7 *Halliburton Energy Services Inc v Smith International Inc* [2006] EWCA Civ 1715 at [19], [2006] All ER (D) 246 (Dec) at [19].

8 *Valensi v British Radio Corp* [1973] RPC 337, CA (a case under the Patents Act 1949); *Helitune Ltd v Stewart Hughes Ltd* [1991] FSR 171; *Mentor Corp v Hollister Inc* [1993] RPC 7.

UPDATE

491 Nature of objection to insufficiency of description

NOTES--There is a difference between the sufficiency of instructions for making a product and the sufficiency of instructions for using it: *Corevalve Inc v Edwards Lifesciences AG* [2009] EWHC 6 (Pat), [2009] All ER (D) 66 (Jan).

NOTES 1, 2--*Generics*, cited, affirmed: [2009] UKHL 12, [2009] 2 All ER 955.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/492. The skilled addressee.

492. The skilled addressee.

The sufficiency of the directions depends on the presumed skill of the person to whom the specification is addressed¹, namely the person who is expected to carry the invention into practice², and he will be presumed to combine a reasonable amount of common sense with a knowledge of the technical area or areas to which the invention relates as they existed at the date of the patent³.

The nature of the invention determines the level of sophistication required of the skilled addressee. For example, in the case of an elaborate scientific process the addressee may be presumed to be a competent scientist, such as would direct the operations of a factory⁴, whereas in the case of a simple invention the directions should be sufficient to enable the ordinary workman to carry it out without further instructions⁵. In some cases the addressee, in order to be properly qualified, may need to possess more than one qualification, for example to be a chemist and also a mechanic⁶. Nowadays the addressee may be a graduate scientist or a research team⁷.

1 Authorities on the nature of the skilled addressee in relation to novelty and to lack of inventive step are equally applicable in relation to insufficiency: *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323. As to such skilled addressees see PARA 456. However, it should be remembered that in relation to insufficiency the task of the skilled person is to attempt to perform the claimed invention and to have that goal in mind: *Synthon BV v Smithkline Beecham*, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent*.

2 *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 RPC 369, HL. For example, the lampmaker, and not the chemist, was held to be the addressee of a lamp patent (*Z Electric Lamp Manufacturing Co Ltd v Marples, Leach & Co Ltd* (1910) 27 RPC 305 (on appeal 27 RPC 737, CA); *Osram Lamp Works Ltd v Z Electric Lamp Manufacturing Co Ltd* (1912) 29 RPC 401 at 424); and the skilled worker in gutta percha, and not the golf professional, was held to be the addressee of a ball patent (*Haskell Golf Ball Co Ltd v Hutchinson (No 2)* (1905) 22 RPC 478 at 493). Earlier cases tended to regard the specification as being addressed in the first place to the factory manager, works chemist or metallurgist, engineering draughtsman or the like (see eg *Leonhardt & Co v Kallé & Co* (1895) 12 RPC 103; *Knight v Argylls Ltd* (1913) 30 RPC 321, CA; *Gold Ore Treatment Co of Western Australia Ltd v Golden Horseshoe Estates Co Ltd* (1919) 36 RPC 95, PC). Nowadays, the courts are prepared to accept that the specification may be addressed to persons with a high level of expertise: *Valensi v British Radio Corp'n* [1973] RPC 337, CA (addressees of a specification of a new colour television system were held to be technicians, rather than the graduate scientists then working in that field). See also *Standard Brands Inc's Patent (No 2)* [1981] RPC 499, CA; *Mentor Corp'n v Hollister Inc* [1991] FSR 557 at 562 (affd [1993] RPC 7 at 14, CA); *Chiron Corp'n v Organon Technika Ltd (No 3)*, *Chiron Corp'n v Murex Diagnostics Ltd (No 3)* [1994] FSR 202 at 240; *Genentech Inc's Patent* [1989] RPC 147, CA; *Biogen Inc v Medeva plc* [1997] RPC 1, HL; *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169 (research team involved in recombinant DNA technology).

3 *Incandescent Gas Light Co Ltd v De Mare Incandescent Gas Light System Ltd* (1896) 13 RPC 301 at 320 (on appeal 12 TLR 495, 13 RPC 559, CA); *Re Tiemann's Patent* (1899) 16 RPC 561 at 575; *Z Electric Lamp Manufacturing Co Ltd v Marples, Leach & Co Ltd* (1910) 27 RPC 737 at 745, CA; *Submarine Signal Co v Henry Hughes & Son Ltd* (1931) 49 RPC 149.

4 *Badische Anilin und Soda Fabrik v Levinstein* (1887) 12 App Cas 710, 4 RPC 449, HL; *Incandescent Gas Light Co Ltd v De Mare Incandescent Gas Light System Ltd* (1896) 13 RPC 301 at 327; *Re Tiemann's Patent* (1899) 16 RPC 561 at 574, 575. See also *Neilson v Harford* (1841) 1 Web Pat Cas 295 at 331; *Edison and Swan United Electric Light Co Ltd v Holland* (1889) 5 TLR 294 at 298, 6 RPC 243 at 280, CA.

5 *Plimpton v Malcolmson* (1876) 3 ChD 531 at 568; *Kraft, Kraft Cheese Co Inc and Kraft Walker Cheese Co Pty Ltd v McAnulty* (1931) 48 RPC 536, PC.

6 *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 RPC 369 at 391, HL.

7 *American Cyanamid Co v Ethicon Ltd* [1979] RPC 215. See also *Helitune Ltd v Stewart Hughes Ltd* [1991] FSR 171 at 197 (technician skilled in making radiation detectors). See also the modern cases cited in note 1.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/493. Subsequent knowledge.

493. Subsequent knowledge.

The relevant date of compliance with the requirement of sufficiency is the date of the application for the patent¹. Subsequent knowledge may not be used either to supplement the disclosure or to render a sufficient disclosure insufficient².

1 *Biogen Inc v Medeva plc* [1997] RPC 1 at 54, HL.

2 *Biogen Inc v Medeva plc* [1997] RPC 1 at 54, HL.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/494. Enablement.

494. Enablement.

Whether a specification is sufficient is a question of fact¹. The requirements are that any directions given be both clear and complete². It is assumed that the skilled person is seeking success and not failure³. In some cases, it may not be necessary to give detailed instructions as the skilled person might naturally expect to determine such matters for himself provided he would have not difficulty in so doing⁴.

Directions must be sufficient for the due execution of the invention throughout the range claimed⁵, including special directions for special cases if the competent workman is not likely to know these already⁶. In cases involving patents for a class of processes, however, the patentee is not bound to give exhaustive examples⁷. Although the directions must be sufficient for carrying out the invention in all cases specifically described⁸, it is not necessary that all possible ways in which the invention can be carried out should be described, since in many cases there may be alternatives involving invention which would come within the ambit of the claim. This is more particularly the case where the claim is of a functional nature⁹. The requirements for sufficiency are no stricter where the claim is of a functional nature¹⁰. A patentee need not deal with matters of scientific theory¹¹.

1 *Mentor Corp'n v Hollister Inc* [1993] RPC 7; *Molnlycke AB v Procter & Gamble Ltd (No 5)* [1992] FSR 549, [1994] RPC 49; *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2002] RPC 1 at 117.

2 See the Patents Act 1977 s 72(1)(c); and PARAS 490-491.

3 *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1921) 39 RPC 49 at 92, HL; *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2002] EWCA Civ 1096 at [96], [2003] RPC 31 at [96], CA ('lawyers can often think up puzzles at the edge of a claim, but skilled persons are concerned with practicalities not puzzles').

4 *British Ore Concentration Syndicate Ltd v Minerals Separation Ltd* (1909) 26 RPC 124 at 139, CA.

5 *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1921) 39 RPC 49, HL; *Felton v Greaves* (1829) 3 C & P 611; *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245, CA. See also *Maxim-Nordenfelt Guns and Ammunition Co Ltd and Maxim v Anderson* (1897) 14 RPC 671, CA (on appeal (1898) 15 RPC 421, HL); *Re Tiemann's Patent* (1899) 16 RPC 561 at 575; *Kopp v Rosenwald Bros* (1902) 20 RPC 154, CA; *Carnegie Steel Co v Bell Bros Ltd* (1909) 26 RPC 265. Thus a patent for the production of dyes which named in the specification four bodies to be treated with sulphur was held to be bad because, although the directions for heating three of them were sufficient, they were insufficient as regards the fourth body: *Vidal Dyes Syndicate Ltd v Levinstein Ltd*.

6 The following are examples of insufficient directions: a patent for making belts from 'hard-woven' cotton canvas, of which only three out of ten known qualities were suitable for the invention, was held invalid in the absence of evidence that a workman would know which qualities to use: *Gandy v Reddaway* (1883) 2 RPC 49, CA. See also *Wegmann v Corcoran* (1879) 13 ChD 65, CA; *Badische Anilin und Soda Fabrik v Société Chimique des Usines du Rhône and Wilson* (1898) 14 RPC 875 (affd 15 RPC 359, CA); *Wilson Bros Bobbin Co Ltd v Wilson & Co (Barnsley) Ltd* (1902) 20 RPC 1 at 16, HL; *European Eibel Co Ltd v Edward Lloyd Ltd* (1911) 28 RPC 349; *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 TLR 24, 34 RPC 369 at 384, 394, HL; *Kraft, Kraft Cheese Co Inc and Kraft Walker Cheese Co Pty Ltd v McAnulty* (1931) 48 RPC 536, PC; *International de Lavaud Manufacturing Corp'n Ltd, Stanton Ironworks Co Ltd and Cochrane (Middlesbro) Foundry Ltd v Clay Cross Co Ltd* (1941) 58 RPC 177 at 195; *Bristol-Myers Co (Johnson and Hardcastle's) Application* [1974] RPC 389 (where a salt was specified as a starting material but only the anhydrous form produced the invention claimed, and the directions were held to be insufficient). The case of *John Summers & Sons Ltd v Cold Metal Process Co* (1947) 65 RPC 75 at 110 possibly falls under this rule. The following are examples of sufficient directions: a patent which referred to the use of gunpowder or other proper combustible material was held sufficient on evidence that a competent workman would know what could be used (*Bickford v Skewes* (1841) 1 QB 938); flax and like yarns (*Pirrie v York Street Flax Spinning Co Ltd* (1894) 11 RPC 429, CA); where a patent for mattresses, after describing a particular mesh, stated that others could be used, it was held valid on evidence that a

competent workman would know which meshes would produce the effect described (*J and J Evans, Taunton Ltd v Hoskins and Sewell Ltd* (1907) 24 RPC 517, CA).

7 *Re Gaulard and Gibbs' Patent* (1889) 6 RPC 215 at 224, CA (on appeal (1890) 7 RPC 367, HL); *Leonhardt & Co v Kallé & Co* (1895) 12 RPC 103; *British Dynamite Co v Krebs* (1896) 13 RPC 190, HL; *Thermit Ltd v Weldite Ltd* (1907) 24 RPC 441; *Minerals Separation Ltd v Ore Concentration Co (1905) Ltd* [1909] 1 Ch 744, 26 RPC 413, CA; *Flour Oxidizing Co Ltd v Hutchinson* (1909) 26 RPC 597.

8 *Amalgamated Carburetters Ltd v Bowden Wire Ltd* (1930) 48 RPC 105 at 122; *No-Fume Ltd v Frank-Pitchford & Co Ltd* (1935) 52 RPC 231 at 250, CA.

9 It is said that before the expiry of the original telephone patents there were 1,400 patents for improvements all of which fell within the main claims of the master patent.

10 See *International Business Machines Corp'n's Application* [1970] RPC 533.

11 *Coles v Baylis, Lewis & Co* (1886) 3 RPC 178; *Leonhardt & Co v Kallé & Co* (1895) 12 RPC 103 at 116; *Atkins and Applegarth v Castner-Kellner Alkali Co Ltd* (1901) 18 RPC 281 at 295; *Re Andrews' Patent* (1907) 24 RPC 349 at 372, CA (on appeal (1908) 25 RPC 477, HL); *Re Le Rasoir Apollo, Letters Patent No 239,112* (1931) 49 RPC 1.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/495. Exceptional cases.

495. Exceptional cases.

The courts are not anxious to find insufficiency, if the specification is fairly drawn¹, and will not do so merely because exceptional cases² or unlikely materials³ might come within the words of the specification and will not work, or because the words do not exclude a mistake which a competent workman would not make⁴. The courts are also reluctant to find insufficiency on the ground that a claim purports to define its extent by reference to a qualitative rather than a quantitative requirement⁵. The question whether the directions contained in a specification are sufficient is generally one of fact depending on the evidence offered⁶.

1 *Raleigh Cycle Co Ltd v H Miller & Co Ltd* [1948] 1 All ER 308 at 310, 65 RPC 141 at 147, HL.

2 *Morgan v Seaward* (1836) 1 Web Pat Cas 170 at 180.

3 A patentee gave directions to use carbon gas; carbon dioxide and carbon monoxide which were useless and which were covered by this description were excluded on the evidence that no competent workman would think of using them: *Edison and Swan Electric Lighting Co v Woodhouse and Rawson* (1887) 3 TLR 367, 4 RPC 99, CA; *Edison and Swan United Electric Light Co Ltd v Holland* (1889) 5 TLR 294, 6 RPC 243, CA. See also *Stevens v Keating* (1847) 2 Web Pat Cas 175 at 183; *Thermit Ltd v Weldite Ltd* (1907) 24 RPC 441; *Flour Oxidizing Co Ltd v Hutchinson* (1909) 26 RPC 597 at 626; *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 TLR 24, 34 RPC 369, HL.

4 *Osram-Robertson Lamp Works Ltd v Pope's Electric Lamp Co Ltd* (1917) 34 TLR 24, 34 RPC 369, HL; *Commercial Solvents Corp v Synthetic Products Co Ltd* (1926) 43 RPC 185 at 222; *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231 at 243, CA. Errors in the drawings which would not mislead a workman will not invalidate a patent (*British United Shoe Machinery Co Ltd v A Fussell & Sons Ltd* (1908) 25 RPC 364 at 385; on appeal 25 RPC 631, CA), but such error must be an obvious one (*Knight v Argylls Ltd* (1913) 30 RPC 321, CA).

5 *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2002] RPC 1 at 116. See also *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1921) 39 RPC 49, HL; *Cleveland Graphite Bronze Co v Glacier Metal Co Ltd* (1950) 67 RPC 149, HL. See also PARA 494 text and note 3.

6 The burden of proof is on the person alleging that the patent is insufficient: *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2002] EWCA Civ 1096, [2003] RPC 31. It is often necessary for the allegation of insufficiency to be supported by the carrying out of experiments to show that the directions contained in the specification do not allow the invention to be performed. As to experiments see PARA 537; and see eg *Smithkline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568, [2005] FSR 524; *Mayne Pharma Pty Ltd v Debiopharm SA* [2006] EWHC 164 (Pat), [2006] FSR 656.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/496. Experiments.

496. Experiments.

A description is insufficient if undue experimentation is requisite¹. Trials to ascertain the best working conditions or to arrive at a successful result may be a necessity², but there must be sufficient directions for the competent reader of the specification to know what trials to make and how to perform them³. In particular, where the invention claimed is defined by words of degree, or in terms of the result to be achieved, the instructions must enable the reader, over the whole width of the claim, to obtain success with the aid of simple experiments only⁴. In a simple invention the description should make tests unnecessary⁵. Proportions may be given broadly, unless exactitude is of the essence of the invention or essential to success⁶.

1 *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231, CA; *Valensi v British Radio Corpn* [1973] RPC 337, CA; *Standard Brands Inc's Patent (No 2)* [1981] RPC 499, CA; *Mentor Corpn v Hollister Inc* [1993] RPC 7 at 14, CA.

2 *Neilson v Harford* (1841) 1 Web Pat Cas 295 at 320; *Otto v Linford* (1882) 46 LT 35, CA; *Edison and Swan United Electric Light Co Ltd v Holland* (1889) 5 TLR 294, 6 RPC 243, CA; *Leonhardt & Co v Kallé & Co* (1895) 12 RPC 103 at 116; *British Dynamite Co v Krebs* (1896) 13 RPC 190, HL; *Thermit Ltd v Weldite Ltd* (1907) 24 RPC 441 at 461; *Watson, Laidlaw & Co Ltd v Pott, Cassels and Williamson* (1911) 28 RPC 565, HL; *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231, CA.

3 *Fox v Astrachans Ltd* (1910) 27 RPC 377.

4 *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1921) 39 RPC 49, HL; *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231, CA.

5 *Hinks & Son v Safety Lighting Co* (1876) 4 ChD 607 at 617; *Fletcher v Arden, Hill & Co* (1887) 5 RPC 46; *Kinmond v Keay* (1903) 20 RPC 497.

6 Cases on this point were reviewed in *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231, CA. Among the older cases where the directions as to proportions were found to be sufficient are *Muntz v Foster* (1843) 2 Web Pat Cas 93; *Patent Type Founding Co v Richard* (1859) John 381; *Betts v Menzies* (1862) 10 HL Cas 117; *Neilson v Betts* (1871) LR 5 HL 1; *British Ore Concentration Syndicate Ltd v Minerals Separation Ltd* (1909) 27 RPC 33, HL. For cases where the instructions were held to be insufficient see *Lane Fox v Kensington and Knightsbridge Electric Lighting Co* (1892) 9 RPC 413, CA; *Kinmond v Keay* (1903) 20 RPC 497; *Nicholls v Kershaw* (1910) 27 RPC 237 at 250; *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245 at 260, CA. The danger of relying on indefinite adjectives such as 'deep' or 'shallow' was pointed out in *Re Taylor's Patent* (1916) 33 RPC 138, CA, but the specification may make it sufficiently clear what such terms mean: see *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1920) 37 RPC 277, CA; *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd (No 2)* (1922) 39 RPC 212; *Re Lowndes' Patent* (1927) 45 RPC 48; *No-Fume Ltd v Frank Pitchford & Co Ltd* (1935) 52 RPC 231, CA; *Dow Chemical AG v Spence Bryson & Co Ltd* [1984] RPC 359 at 391, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(vii) Insufficiency/497. Biological material and sequence listings.

497. Biological material and sequence listings.

The specification of an application for a patent, or of a patent, for an invention¹ which involves the use of or concerns biological material is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art if it complies with the requirements for depositing the biological material². Where the specification of an application discloses a sequence, it must include a sequence listing³.

1 As to the meaning of 'invention' see PARA 301 note 2.

2 See the Patents Rules 2007, SI 2007/3291, r 13(1), Sch 1; and PARA 322.

3 See the Patents Rules 2007, SI 2007/3291, r 13(2), Sch 1; and PARA 323.

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(viii) Extensions to Disclosure

498. Amendment extending disclosure.

A patent is invalid if the matter disclosed¹ in the specification of the patent extends beyond that disclosed in the application for the patent as filed², because of amendments made to the specification since the date of filing.

Similarly, a patent granted on a divisional application³, or a new application filed⁴ following a dispute as to title, will be invalid if the matter disclosed in the new specification extends beyond that disclosed in the patent application⁵.

1 As to the meaning of 'disclosed' see PARA 490 note 3.

2 See the Patents Act 1977 ss 72(1)(d), 74(3). As to the meaning of 'application as filed' see PARA 317 note 2. As to whether matter disclosed in the specification extends beyond that disclosed in the application as filed due to amendment see PARAS 352-353.

3 Ie under the Patents Act 1977 s 15(4): see PARA 316.

4 Ie under the Patents Act 1977 s 8(3) (see PARA 362), s 12 (see PARA 364) or s 37(4) (see PARA 366). For limitations on such later applications disclosing matter extending beyond that disclosed in the patent application see s 76(1); and PARAS 352-353.

5 Patents Act 1977 ss 72(1)(d), 74(3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/7. VALIDITY/(2) VALIDITY AND INVALIDITY/(ix) Extensions to Protection/499. Amendment extending protection.

(ix) Extensions to Protection

499. Amendment extending protection.

A patent is invalid if the protection conferred by it is extended by amendment of the specification after grant¹. The protection granted by a patent is that specified by the claims as interpreted by the description and drawings, if any².

¹ See the Patents Act 1977 ss 72(1)(e), 74(3), 76(2); and PARA 352. Section 72(1)(e) relates only to post-grant amendments: *Liversedge v British Telecommunications plc* (AC Egerton, third party) [1991] RPC 229.

² See the Patents Act 1977 s 125(1); and PARA 431 note 1.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/500. Questions arising on an alleged infringement.

8. INFRINGEMENT

(1) CAUSE OF ACTION FOR INFRINGEMENT

500. Questions arising on an alleged infringement.

The question of infringement of a patent involves consideration of two matters. The first is whether the article or process alleged to infringe falls within the scope of the monopoly granted by the patent; and the second is whether the alleged infringer has done, in relation to that article or process, any act the monopoly in which is given by a patent to its proprietor¹.

¹ See PARA 501 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/501. The test of infringement.

501. The test of infringement.

To determine whether a patent is infringed, the specification and, in particular, its claims must be construed, purposively and with due regard to the European Patent Convention¹, to determine its essential integers. If it then appears that the alleged infringement falls entirely within the words of some claim, no further question arises; the patent is infringed². If, however, what is alleged to infringe is some variant of what is claimed, the question must be looked at more closely. The question in each case is whether persons with practical knowledge and experience of the kind of work in which the invention is intended to be used would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect on the way the invention worked³. In many cases, the following guidelines⁴ have been found to be useful. There will still be infringement if, but only if:

- 249 (1) the variant has no material effect upon the way the invention works;
- 250 (2) it was obvious to a skilled reader, at the date of publication of the specification, that this was so; and
- 251 (3) it would be apparent to any skilled reader that the words of the claim from which the variant departs could not have been intended to exclude such minor variants⁵.

It is not permissible to construe a claim by attempting to distil its principle in the light of an alleged infringement⁶. An integer may not be struck out from the claim merely because it does not appear to make any difference to the inventive concept⁷. Where a patent has multiple claims, it is reasonable to infer that an earlier claim will be read as wider than a later subsidiary claim⁸.

1 See the European Patent Convention art 69, Protocol; and PARA 415 et seq. As to the convention see PARA 668.

2 See eg *Société Nouvelle des Bennes Saphem v Edbro Ltd* [1983] RPC 345 at 359, CA; *Codex Corpn v Racal-Milgo Ltd* [1983] RPC 369, CA; *AC Edwards Ltd v Acme Signs & Displays Ltd* [1992] RPC 131, CA; *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331; *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369.

3 *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 243, HL.

4 *Improver Corpn v Remington Consumer Products Ltd* [1990] FSR 181.

5 *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 243, HL, where earlier cases are reviewed. This formulation has consistently been followed and reference back to earlier cases is unnecessary: *Codex Corpn v Racal-Milgo Ltd* [1983] RPC 369 at 380, CA. Whilst the formulation in *Improver Corpn v Remington Consumer Products Ltd* [1990] FSR 181 at 189, has been found useful by later courts, in *Wheatley v Drillsafe Ltd* [2001] RPC 133, CA, it was stated that the issue of the construction of claims is a unitary one and the formulation in *Improver Corpn v Remington Consumer Products Ltd* simply aims to assist in arrival at the proper purposive and contextual interpretation. The formulation in *Improver Corpn v Remington Consumer Products Ltd* may be less useful in chemical cases: *Pharmacia Corpn v Merck & Co Inc* [2001] EWCA Civ 1610, [2002] RPC 775 at 796, [2001] All ER (D) 227 (Dec); *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169. The formulation in *Catnic Components Ltd v Hill & Smith Ltd* was supported in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46 at [45]-[48], [2005] 1 All ER 667 at [45]-[48], [2005] RPC 169 at [45]-[48] per Lord Hoffmann, who emphasised that the *Improver* formulation forms

guidelines and not formal rules (see at [52]). See also *Merck & Co Inc v Generics (UK) Ltd* [2003] EWHC 2842 (Pat), [2004] RPC 607 as to the permissibility of experiments directed to questions of construction of the type in *Catnic Components Ltd v Hill & Smith Ltd*.

6 *Nobel's Explosives Co Ltd v Anderson, Cordite Case* (1894) 11 RPC 519 at 523, CA (affd (1895) 12 RPC 164, HL); *Willemijn Houdstermaatschappij BV v Madge Networks Ltd* [1992] RPC 386, CA. But see *Rockwater v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 919 at 952.

7 *Société Technique de Pulverisation STEP v Emson Europe Ltd* [1993] RPC 513 at 522; *Wesley Jessen Corp v Coopervision Ltd* [2003] RPC 355 at 382; *Halliburton Energy Service Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat), [2006] RPC 25.

8 *Ultraframe (UK) Ltd v Eurocell Building Plastics Ltd* [2004] EWHC 1623 (Pat) at [77], [2005] RPC 111 at [77].

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/502. Inessential integers.

502. Inessential integers.

It follows from the test of infringement¹ that infringement is not necessarily avoided by replacing an inessential integer by a variant, or omitting it altogether². If, however, ingenuity or invention would be needed to appreciate that the integer concerned could be replaced in such a way, it is unlikely that it can be an inessential integer³, or that the replacement could be obviously an immaterial variation.

¹ See PARA 501.

² *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 237, HL; *Fairfax (Dental Equipment) Ltd v S J Filhol Ltd* [1986] RPC 499, CA; *Anchor Building Products Ltd v Redland Roof Tiles Ltd* [1990] RPC 283, CA; *T Bonzel v Intervention Ltd (No 3)* [1991] RPC 553; *Insituform Technical Services Ltd v Inliner UK plc* [1992] RPC 83; *Lux Traffic Controls Ltd v Pike Signals Ltd*, *Lux Traffic Controls Ltd v Faronwise Ltd* [1993] RPC 107; *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197. See also *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169.

³ See eg *Improver Corp'n v Remington Consumer Products Ltd* [1990] FSR 181; *Southco Inc v Dzus Fastener Europe Ltd* [1992] RPC 299, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/503. Colourable differences.

503. Colourable differences.

It also follows from the test of infringement¹ that infringement cannot be avoided by differences from what is claimed that are merely colourable, that is, by merely making the infringing manufacture appear to be different². A difference or variant, although small, which results in something simpler than that patented³, or leads to a new or significantly improved result⁴, may very well be a material one. It depends on whether the skilled reader would not believe the patentee intended to exclude it from the claim and, if he would realise it, had no material effect on the way the inventive concept of the patent worked⁵.

1 See PARAS 501-502.

2 See eg *Raleigh Cycle Co Ltd v H Miller & Co Ltd* [1948] 1 All ER 308, 65 RPC 141, HL (which contains instances of more than one difference held 'colourable'); *Beecham Group Ltd v Bristol Laboratories Ltd* [1978] RPC 153, HL (where one penicillin derivative was held to infringe a claim to another derivative as, chemically, it was equivalent to the claimed derivative 'temporarily masked'). See also the cases cited in PARA 502 note 2.

3 *Unwin v Heath* (1855) 5 HL Cas 505; *Plating Co Ltd v Farquharson* (1883) Griffin's Patent Cases (1884-1886) 187; *Nobel's Explosives Co Ltd v Anderson* (1895) 11 TLR 266, 12 RPC 164, HL; *Morris and Bastert v Young* (1895) 12 RPC 455 at 461, HL. These cases decided before *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 237, HL (see para 581 note 4) should be regarded, however, as examples only.

4 *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245 at 275-276, CA; *RCA Photophone Ltd v Gaumont-British Picture Corp Ltd and British Acoustic Films Ltd* (1936) 53 RPC 167 at 189, CA. These cases decided before *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183 at 237, HL (see PARA 501 note 5) should be regarded, however, as examples only.

5 *Insituform Technical Services Ltd v Inliner UK plc* [1992] RPC 83 at 92.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/504. Ingenuity in infringement.

504. Ingenuity in infringement.

Where the alleged infringing manufacture falls within the words of a claim, it is no defence to show that it involves ingenuity¹. Only where it is not precisely within the words of any claim is the question whether it involved ingenuity relevant².

¹ 'The superadding of ingenuity to robbery does not make the operation justifiable': *Wenham Gas Co Ltd v Champion Gas Lamp Co* (1892) 9 RPC 49 at 56, CA, per Bowen LJ. See also *Proctor v Bennis* (1887) 36 ChD 740 at 756, 4 RPC 333 at 354, CA; *Haskell Golf Ball Co Ltd v Hutchinson (No 2)* (1908) 25 RPC 194, HL; *Marconi and Marconi's Wireless Telegraph Co Ltd v British Radio-Telegraph and Telephone Co Ltd* (1911) 28 RPC 181 at 218.

² See PARA 501 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/505. Time within which infringement may be committed.

505. Time within which infringement may be committed.

An actionable infringement may be committed from the date of publication of the application¹ until the expiration of the term of the patent², but no action for infringement may be commenced until the patent is granted³. An act done before the patent is granted⁴ will infringe only if it infringes both within the scope of the monopoly of the patent as granted and also within the scope of the claims⁵ contained in the application as first published⁶.

1 Ie under the Patents Act 1977 s 16: see PARA 327.

2 As to the term of a patent see PARA 339.

3 See the Patents Act 1977 s 69(1), (2)(a). See also PARAS 548-549.

4 As to grant see PARA 338.

5 Ie those claims as interpreted by the description and any drawings referred to in the description of claims.

6 See the Patents Act 1977 s 69(2)(b).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/506. Articles sold by the proprietor of the patent.

506. Articles sold by the proprietor of the patent.

In the absence of special stipulations¹, articles manufactured or sold by the proprietor of the patent or his agents are licensed generally, and may be used or sold in any manner², and, if purchased abroad, may be imported into the United Kingdom³. Where a patented product⁴ is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him are entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor⁵. Where the act complained of is manufacture or user, and is performed at the claimant's instigation, it is generally considered as licensed and does not constitute an infringement⁶.

1 As to the effect of limiting conditions see PARA 380 et seq.

2 Where the patent contains claims for an integer per se, and also for its use in a specified combination, it seems that the sale of such an integer licenses its use in the combination: *Arnold v Bradbury* (1871) 6 Ch App 706. See also *Oxley v Holden* (1860) 8 CBNS 666.

3 *Betts v Willmott* (1871) 6 Ch App 239, CA. It is otherwise if the vendor is only a licensee under a foreign patent (*SA des Manufactures de Glaces v Tilghman's Patent Sand Blast Co* (1883) 25 ChD 1, CA); but, where manufacture took place in one of the member states of the European Union either by the proprietor or with his consent (eg by a licensee), the articles purchased may be imported into the United Kingdom (Case 15/74 *Centrafarm BV v Sterling Drug Inc* [1974] ECR 1147, [1974] 2 CMLR 480, EC; Case 16/74 *Centrafarm BV v Winthrop BV* [1974] ECR 1183, [1974] 2 CMLR 480, EC). As to the meaning of 'United Kingdom' see PARA 303 note 5.

4 As to the meaning of 'patented product' see PARA 372 note 11.

5 Patents Act 1977 s 36(5). See PARA 372.

6 Eg where an agent of the claimant has given an order to the defendant to make an article in a way which infringed the patent (*Kelly v Batchelar* (1893) 10 RPC 289), or where the claimant was himself present on the occasion of user (*Henser and Guignard v Hardie* (1894) 11 RPC 421 at 427); but see to the contrary *Dunlop Pneumatic Tyre Co Ltd v Neal* [1899] 1 Ch 807, 16 RPC 247 (act of infringement held in such circumstances to have been established). This rule does not extend to a sale to an agent of the claimant made in the ordinary course of business (*Dunlop Rubber Co Ltd v Longlife Battery Depot* [1958] 3 All ER 197 at 201, [1958] 1 WLR 1033 at 1039, [1958] RPC 473 at 477), and such sales in response to test purchases are commonly relied on as instances of infringement.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/507. Repairs.

507. Repairs.

The owner of a patented article is entitled to make genuine repairs¹, or to replace parts of a combination which normally wear out more quickly than other parts², even if, in so doing, he would otherwise infringe any copyright belonging to the proprietor of the patent³. The implied licence to repair extends to the purchaser's agents and contractors⁴.

1 These repairs must not, however, amount to making a substantially new article: *Dunlop Pneumatic Tyre Co Ltd v Neal* [1899] 1 Ch 807, 16 RPC 247; *Dunlop Pneumatic Tyre Co Ltd and Pneumatic Tyre Co Ltd v Excelsior Tyre, Cement and Rubber Co and Baker* (1901) 18 RPC 209; *Dunlop Pneumatic Tyre Co Ltd v Holborn Tyre Co Ltd* (1901) 18 RPC 222. In *Dunlop Pneumatic Tyre Co Ltd v David Moseley & Sons Ltd* (1904) as reported in 21 RPC 274 at 282, CA, Cozens-Hardy LJ expressed a doubt whether these decisions were not too favourable to the proprietor of the patent.

2 *Sirdar Rubber Co Ltd and Maclulieh Ltd v Wallington, Weston & Co* (1905) 22 RPC 257 (on appeal (1906) 23 RPC 132, CA; (1907) 24 RPC 539, HL); *Solar Thomson Engineering Co Ltd v Barton* [1977] RPC 537, CA; *Dellareed Ltd v Delkim Developments* [1988] FSR 329.

3 *Solar Thomson Engineering Co Ltd v Barton* [1977] RPC 537, CA (implied licence under the copyright to give business efficacy to the right to repair a patented article). The owner's right to repair is not an independent right conferred upon him by licence, express or implied but is a residual right, forming part of the right to do whatever does not amount to making the product: *United Wire Ltd v Screen Repair Services (Scotland) Ltd* [2000] 4 All ER 353 at 358, [2001] RPC 439, HL, per Lord Hoffmann.

4 *Solar Thomson Engineering Co Ltd v Barton* [1977] RPC 537, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/508. Agent's liability for infringement.

508. Agent's liability for infringement.

The ordinary rules as to agency in tort¹ apply to infringement, so that in general both principals and agents are liable².

¹ See **AGENCY** vol 1 (2008) PARA 164; **TORT** vol 97 (2010) PARA 431.

² *Day v Davies* (1904) 22 RPC 34 at 42. See also *Sykes v Howarth* (1879) 48 LJ Ch 769; *Anderson v Patent Oxonite Co Ltd* (1886) 3 RPC 279; *Incandescent Gas Light Co Ltd v New Incandescent (Sunlight Patent) Gas Lighting Co Ltd* (1897) 76 LT 47, 15 RPC 81; *Incandescent Gas Light Co Ltd v Brogden* (1899) 16 RPC 179. An employee who has merely carried out his employer's orders should not, however, in general be joined as a defendant: *F Savage & Co Ltd v Brindle* (1896) 13 RPC 266. As to the distinction between agent and independent contractor see *Dixon v London Small Arms Co Ltd* (1876) 1 App Cas 632; *Howard and Bullough Ltd v Tweedales and Smalley* (1895) 12 RPC 519; *Henry Bros (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1997] RPC 693; affd [1999] RPC 442, [1998] All ER (D) 545, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/509. Directors' liability for infringement.

509. Directors' liability for infringement.

The directors of a company are not personally liable for infringements by the company, even if they are managing directors or the sole directors and shareholders, unless:

- 252 (1) they have formed the company for the purpose of infringing;
- 253 (2) they have directly ordered or authorised the acts complained of; or
- 254 (3) they have so authorised or ordered by implication¹.

A director may be liable for procuring infringement². A knowing, deliberate, wilful participation in the alleged tort is not an essential pre-condition to personal liability³. The director's involvement must, however, be such as would render him liable as a joint tortfeasor if the company had not existed⁴.

¹ See *Belvedere Fish Guano Co Ltd v Rainham Chemical Works Ltd, Feldman and Partridge* [1920] 2 KB 487 at 521 et seq, CA, per Younger LJ (approved sub nom *Rainham Chemical Works Ltd v Belvedere Fish Guano Co* [1921] 2 AC 465, HL, where the subject is fully considered), from which it would appear that the judgment in *Betts v De Vitre* (1868) 3 Ch App 429 (affd sub nom *Neilson v Betts* (1871) LR 5 HL 1), which was followed in *Welsbach Incandescent Gas Light Co Ltd v Daylight Incandescent Mantle Co Ltd* (1899) 16 RPC 344 (on appeal (1900) 17 RPC 141, CA), must be taken as either overruled or only supportable by reason of the particular acts. See also *Performing Right Society Ltd v Caryl Theatrical Syndicate Ltd* [1924] 1 KB 1 at 14, CA; *Wah Tat Bank Ltd v Chan Cheng Kum* [1975] AC 507 at 514, [1975] 2 All ER 257 at 259-260, PC; *CBS Songs Ltd v Amstrad Consumer Electronics plc* [1988] AC 1013, [1988] 2 All ER 484, [1988] RPC 567, HL (copyright). See also *British Thomson-Houston Co Ltd v Sterling Accessories Ltd* [1924] 2 Ch 33, 41 RPC 311 (where it was held that the signature by directors, as agents for the company, of a contract for the sale of infringing lamps would not make them liable for infringements); *Reitzman v Grahame-Chapman and Derustit Ltd* (1950) 67 RPC 178 at 185; on appeal 68 RPC 25, CA (director actively engaged in directing infringing activities), and *Leggatt v Hood's Original Licensees' Darts Accessories Ltd and Hood* (1950) 67 RPC 134 at 138; *Mentmore Manufacturing Co Ltd v National Merchandising Manufacturing Co Inc* (1978) 89 DLR (3d) 195 (Fed CA); *C Evans & Sons Ltd v Spriteband Ltd* [1985] FSR 267, CA. See generally **COMPANIES** vol 14 (2009) PARA 585 et seq. As to the third ground of liability stated in the text, and as to the particulars necessary where directors are charged with infringement, see *British Thomson-Houston Co Ltd v Irradiant Lamp Works Ltd* (1924) 41 RPC 338; *C Evans & Sons Ltd v Spriteband Ltd* [1985] FSR 267, CA.

² See PARA 510.

³ *C Evans & Sons Ltd v Spriteband Ltd* [1985] FSR 267, CA; *MCA Records Inc v Charly Records Ltd* [2001] EWCA Civ 1441, [2002] FSR 401 (copyright).

⁴ *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 238.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/510. Procuring infringement.

510. Procuring infringement.

The allegation of procuring infringement by others is probably a distinct tort based on the principle enunciated in *Lumley v Gye*¹ and must be separately pleaded with proper particularity². There is, however, a difference between procuring an infringement and merely facilitating one³. The sale of a non-patented article to a person who, to the vendor's knowledge, intended to use it in a patented process does not amount to procuring infringement, nor does supply for that sole purpose⁴.

1 See *Lumley v Gye* (1853) 2 E & B 216.

2 *Belegging-en Exploitiemaatschappij Lavender BV v Witten Industrial Diamonds Ltd* [1979] FSR 59 at 64, CA.

3 *CBS Songs Ltd v Amstrad Consumer Electronics plc* [1988] RPC 567 at 609, HL, citing *Belegging-en Exploitiemaatschappij Lavender BV v Witten Industrial Diamonds Ltd* [1979] FSR 59 at 65, CA; applied in *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 239; *Kalman v PCL Packaging (UK) Ltd* [1982] FSR 406.

4 *Townsend v Haworth* (1875) 12 ChD 831n, CA; *Dunlop Pneumatic Tyre Co Ltd v David Moseley & Sons Ltd* [1904] 1 Ch 612, 21 RPC 274, CA; *Belegging-en Exploitiemaatschappij Lavender BV v Witten Industrial Diamonds Ltd* [1979] FSR 59, CA. See, however, PARA 513.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(1) CAUSE OF ACTION FOR INFRINGEMENT/511. Undertaking not to infringe.

511. Undertaking not to infringe.

The court will enforce a contractual undertaking given to the proprietor of a patent not to infringe the patent if the undertaking is limited to the term of the patent¹, even though the patent ceases to be in force before the end of that term². If not so limited, the undertaking will normally be void as in unreasonable restraint of trade³. Prior specifications are not relevant to an action on such an undertaking⁴; nor is it open to the defendant to put validity in issue⁵.

1 *Bescot (Electrics) Ltd v Merlin Mouldings Ltd* (1952) 69 RPC 297. As to the term of patents see PARA 339.

2 *Heginbotham Bros Ltd v Burne* (1939) 56 RPC 399, CA.

3 *Bescot (Electrics) Ltd v Merlin Mouldings Ltd* (1952) 69 RPC 297; *Dranetz Anstalt v Hayek* [2002] EWCA Civ 1729, [2003] 1 BCLC 278, [2003] FSR 561 (terms of side-letter attached to agreement restraining inventor from competition with patent holder unenforceable). As to restraint of trade generally see **COMPETITION** vol 18 (2009) PARA 377 et seq.

4 *Heinemann Electric Co v Dorman and Smith Ltd* (1955) 72 RPC 162, CA. For cases of agreement not to put validity in issue or not to use a patented process see *Hills v Laming* (1853) 23 LJ Ex 60; *MacDougall Bros v Partington* (1890) 7 RPC 216; *Howard and Bullough Ltd v Tweedales and Smalley* (1896) 13 RPC 211; *Roberts v Graydon* (1904) 21 RPC 194; *Hay v Gonville* (1908) 25 RPC 161; *Watts v Everitt Press Manufacturing Co* (1910) 27 RPC 718, CA. For cases of estoppel by judgment see *Dudgeon v Thomson* (1877) 3 App Cas 34, HL; *Thompson v Moore* (1889) 23 LR Ir 599, 6 RPC 426; *Multiform Displays Ltd v Whitmarley Displays Ltd* [1956] RPC 143, CA (on appeal [1957] RPC 260, HL).

5 *C Van der Lely NV v Maulden Engineering Co (Beds) Ltd* [1984] FSR 157. This may, however, be incompatible with the EC Treaty: cf Case 65/86 *Bayer AG v Maschinenfabrik Hennocke GmbH v Süllhöfer* [1988] ECR 5349, [1990] 4 CMLR 182, [1990] FSR 300, ECJ (no-challenge clause in patent litigation settlement agreement: see PARA 388 note 5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(2) ACTS OF INFRINGEMENT/512. Direct infringement.

(2) ACTS OF INFRINGEMENT

512. Direct infringement.

Subject to certain exceptions¹, a person infringes a patent² for an invention if, but only if, while the patent is in force³, he does any of the following things in the United Kingdom⁴ without the consent of the proprietor of the patent⁵:

- 255 (1) where the invention is a product, he makes⁶, disposes of⁷, offers to dispose of⁸, uses⁹ or imports the product¹⁰ or keeps it¹¹ whether for disposal or otherwise¹²;
- 256 (2) where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent¹³;
- 257 (3) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly¹⁴ by means of that process or keeps any such product whether for disposal or otherwise¹⁵.

In the case of goods manufactured abroad, no infringement is committed by a person whose possession has terminated before their introduction into the United Kingdom¹⁶ unless there is a concerted design between the foreign supplier and the English importer to sell the goods in the United Kingdom¹⁷. Except where knowledge is an essential element of the tort, the knowledge of the infringer is immaterial¹⁸ except on the question of damages¹⁹.

1 le subject to the provisions of the Patents Act 1977 s 60: see PARAS 513-515.

2 As to infringement generally see PARA 500 et seq.

3 As to the term of patents see PARA 339.

4 As to the meaning of 'United Kingdom' see PARA 303 note 5.

5 Patents Act 1977 ss 60(1), 132(2). An act is not an infringement unless it falls within s 60(1), (2) or (3). In the application of s 60 to a patent of which there are two or more joint proprietors the reference to the proprietor is to be construed: (1) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of s 36 (see PARA 372) or any agreement referred to in s 36, is or are entitled to do that act without its amounting to an infringement; and (2) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of s 36 or any such agreement, is or are the proper person or persons to give the requisite consent: s 66(1).

6 This covers manufacture for sale in the United Kingdom or abroad: *Goucher v Clayton* (1865) 11 Jur NS 462 at 465; *Lyon v Goddard* (1893) 11 RPC 113.

7 'Disposal' includes selling: *Kalman v PCL Packaging (UK) Ltd* [1982] FSR 406. A sale abroad such that the vendor has no rights to dispose of in the United Kingdom is not an infringement: *Kalman v PCL Packaging (UK) Ltd*, applying *Badische Anilin und Soda Fabrik v Johnson & Co* (1897) 14 RPC 919, HL. See also *Sabaf SpA v MFI Furniture Centres Ltd* [2004] UKHL 45, [2005] RPC 10.

8 The offer must be made in the United Kingdom to dispose of the infringing articles within the jurisdiction: *Kalman v PCL Packaging (UK) Ltd* [1982] FSR 406. See also *Cincinnati Grinders Inc v BSA Tools Ltd* (1931) 48 RPC 33 at 51, CA.

9 Under the previous law the following constituted use: exhibition of an article for trade purposes (*Dunlop Pneumatic Tyre Co Ltd and Pneumatic Tyre Co Ltd v British and Colonial Motor Car Co Ltd* (1901) 18 RPC 313);

use of articles as samples to procure orders to be executed abroad (*Badische Anilin und Soda Fabrik v Chemische Fabrik vormals Sandoz* (1903) 88 LT 490, 20 RPC 413, CA). This is probably still good law. See also *Smith Kline and French Laboratories Ltd v Douglas Pharmaceuticals Ltd* [1991] FSR 522, NZ CA (importation of sample for purposes of application for product licence).

10 Importation is the act of bringing the goods into the United Kingdom: see *Sabaf SpA v MFI Furniture Centres Ltd* [2004] UKHL 45, [2005] RPC 10.

11 The storage of goods by a carrier pending the settlement of a dispute between the proprietor and an alleged infringer has been held not to be 'keeping' for this purpose (*Smith Kline and French Laboratories Ltd v RD Harbottle Ltd* [1980] 1 CMLR 277, [1980] RPC 363) nor does delivering it to a third party amount to an infringing 'disposal' (*Kalman v PCL Packaging (UK) Ltd* [1982] FSR 406). Under the old law keeping a machine as a stand-by was an infringement (*British United Shoe Machinery Co Ltd v Simon Collier Ltd* (1909) 25 TLR 415, 26 RPC 534, CA; on appeal (1910) 27 RPC 567, HL) and so was possession for the purposes of infringement (*British United Shoes Machinery Co Ltd v Simon Collier Ltd*). Possession or the transport of an infringing article for the purpose of sale is infringement: *Betts v Neilson* (1868) 3 Ch App 429 (affd sub nom *Neilson v Betts* (1871) LR 5 HL 1); *Adair v Young* (1879) 12 ChD 13, CA; *United Telephone Co v London and Globe Telephone and Maintenance Co* (1884) 26 ChD 766, 1 RPC 117; *British Motor Syndicate Ltd v Taylor & Son Ltd* [1901] 1 Ch 122, (1900) 17 RPC 723, CA; *Saccharin Corp Ltd v DTJ Lyle & Son Ltd* (1904) 21 RPC 604, CA; *Saccharin Corp Ltd v Ross Bros* (1905) 22 RPC 246; *Morton-Norwich Products Inc v Intercen Ltd* [1978] RPC 501. A custom house agent who merely passes the goods through customs and delivers them to the consignee does not infringe: *Nobel's Explosives Co Ltd v Jones, Scott & Co* (1882) 8 App Cas 5, HL. As to the position of a warehousing and transporting agent see *Nobel's Explosives Co Ltd v Jones, Scott & Co*; *Washburn and Moen Manufacturing Co v Cunard Steamship Co and JC Parkes & Sons* (1889) 5 TLR 592, 6 RPC 398; *Badische Anilin und Soda Fabrik v Basle Chemical Works, Bindschedler* [1898] AC 200, HL. These cases are probably still good law.

12 Patents Act 1977 s 60(1)(a).

13 Patents Act 1977 ss 60(1)(b), 132(2). See, for example, *Tamglass Ltd OY v Luoyang Glass Technology Co Ltd* [2006] EWHC 65 (Ch), [2006] FSR 608, [2006] All ER (D) 207 (Jan).

14 See *Pioneer Electronics Capital Inc v Warner Music Manufacturing Europe GmbH* [1997] RPC 757, CA, where it was said that: (1) the product obtained directly by means of a patented process is the product with which the process ends; it does not cease to be the product so obtained if it is subjected to further processing which does not cause it to lose its identity, there being no such loss where it retains its essential characteristics; (2) it is a question of fact and degree whether a product with which the patented process ends retains its essential characteristics or not; (3) there is no free standing 'essential characteristics' test, such characteristics being relevant only to the question of loss of identity. See also *Monsanto Technology LLC v Cargill International SA* [2007] EWHC 2257 (Pat), [2008] FSR 153, [2007] All ER (D) 118 (Oct); *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat), [2006] RPC 25 (affd [2006] EWCA Civ 1715, [2006] All ER (D) 246 (Dec)).

15 Patents Act 1977 s 60(1)(c). Cf the cases under the previous law: *United Horse-Shoe and Nail Co Ltd v Stewart* (1888) 13 App Cas 401, 5 RPC 260, HL (damages assessed on the basis that each sale in the United Kingdom of a nail made abroad on a patented machine was an infringement, although the nails were not in themselves new). See also *Cartsburn Sugar Refining Co v Sharp* (1884) 1 RPC 181 at 186. The presence of a minor patented feature in a machine did not make articles made on it infringements; there was a question of degree: *Wilderman v FW Berk & Co Ltd* [1925] Ch 116, 42 RPC 79 at 87, where *United Horse-Shoe and Nail Co Ltd v Stewart* was not cited. In *VD Ltd v Boston Deep Sea Fishing and Ice Co Ltd* (1935) 52 RPC 303 at 322, Clauson J refused to hold that the sale of fish caught outside territorial limits with patented apparatus was an infringement of the patent.

16 *Kalman v PCL Packaging (UK) Ltd* [1982] FSR 406. This principle was established under previous law. Thus a foreigner posting such goods from abroad to a customer in the United Kingdom does not infringe since the post is the agent of the consignee: *Badische Anilin und Soda Fabrik v Johnson & Co* (1897) 14 RPC 919, HL. Nor does an agent in the United Kingdom who enters into a contract for delivery of such goods to a customer at a foreign port (*Saccharin Corp Ltd v Reitmeyer & Co* [1900] 2 Ch 659, 17 RPC 606; *Badische Anilin und Soda Fabrik v Hickson* [1906] AC 419, 23 RPC 433, HL), but it is otherwise if goods are consigned to the defendant in the United Kingdom and then exported (*Betts v Neilson* (1868) 3 Ch App 429; affd sub nom *Neilson v Betts* (1871) LR 5 HL 1). The right to possession of the goods while in transit where the English buyer was not entitled to possession until the price was paid is sufficient possession: *Morton-Norwich Products Inc v Intercen Ltd* [1978] RPC 501. But where title to the goods passes abroad, arranging transportation to the United Kingdom at the purchaser's request is not an infringement: *Sabaf SpA v MFI Furniture Centres Ltd* [2004] UKHL 45, [2005] RPC 10.

17 *Morton-Norwich Products Inc v Intercen Ltd* [1978] RPC 501 at 512, 514. See also *Dow Chemical AG v Spence Bryson & Co Ltd* [1984] RPC 359 at 391, CA; *Puschner v Tom Palmer (Scotland) Ltd* [1989] RPC 430;

Unilever plc v Gillette (UK) Ltd [1989] RPC 583 at 600, CA; *Intel Corp v General Instrument Corp (No 2)* [1991] RPC 235. See also *Mölnlycke AB v Procter & Gamble Ltd (No 4)* [1992] RPC 21, CA and *Unilever plc v Chefaro Proprietaries Ltd* [1994] FSR 135, CA, where the circumstances which can give rise to joint tortfeasorship and common design are considered.

18 *Stead v Anderson* (1847) 2 Web Pat Cas 151 at 156; *Unwin v Heath* (1855) 5 HL Cas 505 at 537.

19 See the Patents Act 1977 s 62(1); and PARA 549.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(2) ACTS OF INFRINGEMENT/513. Indirect infringement.

513. Indirect infringement.

A person, other than the proprietor of the patent, infringes¹ a patent for an invention if, while the patent is in force² and without the proprietor's consent, he supplies or offers to supply in the United Kingdom³ a person other than a licensee or other person entitled to work the invention⁴ with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom⁵. Where the means are a staple commercial product⁶, the supply or offer to supply is not an infringement unless it was made for the purpose of inducing the person supplied, or, as the case may be, the person to whom the offer was made, to do an act which constitutes an infringement⁷ of the patent⁸.

1 Ie subject to the Patents Act 1977 s 60(3)-(7): see PARAS 512 note 5, 514-515.

2 As to the term of patents see PARA 339.

3 As to the meaning of 'United Kingdom' see PARA 303 note 5.

4 For these purposes, the reference to a person entitled to work an invention includes a reference to a person so entitled by virtue of the Patents Act 1977 s 55 (see PARA 405): s 60(6)(a). As to the position where a co-owner is working the invention for his own benefit see s 36(2)(a), (4); and PARA 372. A person who, by virtue of s 20B(4) or (5) (see PARA 334), s 28A(4) or (5) (see PARA 358), s 64 (see PARA 514) or s 117A(4) or (5) (see PARA 333), is entitled to do an act in relation to the invention without its constituting such an infringement is to be treated, so far as concerns that act, as a person entitled to work the invention: s 60(6)(b) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 8(a); and SI 2004/2357). A person who does an act in relation to an invention which is prevented only by virtue of the Patents Act 1977 s 60(5)(a), (b) or (c) (see PARA 514 heads (1)-(3)) from constituting an infringement is not, however, to be so treated: s 60(6).

5 Patents Act 1977 s 60(2). This alters pre-existing law and overrules *McCormick v Gray* (1861) 7 H & N 25; *Townsend v Haworth* (1875) as reported in 48 LJ Ch 770n, CA; *Sykes v Howarth* (1879) 12 ChD 826; *Dunlop Pneumatic Tyre Co Ltd v David Moseley & Sons Ltd* [1904] 1 Ch 612, 21 RPC 274, CA; *Belegging-en Exploitiemaatschappij Lavender BV v Witten Industrial Diamonds Ltd* [1979] FSR 59, CA. For a case involving indirect infringement see *Anchor Building Products Ltd v Redland Roof Tiles Ltd* [1990] RPC 283, CA. A supply of a program to customers in the United Kingdom which enabled them to access a host computer outside the United Kingdom was the supply of a means intended to put the invention into effect in the United Kingdom: *Menashe Business Mercantile Ltd v William Hill Organisation Ltd* [2002] EWCA Civ 1702, [2003] 1 All ER 279, [2003] RPC 575.

6 'Staple commercial product' is not defined.

7 Ie by virtue of the Patents Act 1977 s 60(1): see PARA 512.

8 Patents Act 1977 s 60(3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(2) ACTS OF INFRINGEMENT/514. Excepted acts; right to continue prior use.

514. Excepted acts; right to continue prior use.

An act which would otherwise constitute an act of infringement of a patent¹ does not do so² if:

- 258 (1) it is done privately and for purposes which are not commercial³;
- 259 (2) it is done for experimental purposes relating to the subject matter of the invention⁴;
- 260 (3) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared⁵;
- 261 (4) it consists of a specified use connected with ships, aircraft, hovercraft or vehicles⁶;
- 262 (5) it consists of a specified use for plant propagation or animal reproduction by a farmer⁷;
- 263 (6) it consists of an act done in conducting a study, test or trial which is necessary for and is conducted with a view to the application of the European directives governing veterinary medicinal products⁸ or medicinal products for human use⁹ or any other act which is required for the purpose of the application of those provisions¹⁰.

Further, where a patent is granted for an invention, a person who in the United Kingdom¹¹ before the priority date¹² of the invention:

- 264 (a) does in good faith an act which would constitute an infringement of the patent if it were in force; or
- 265 (b) makes in good faith effective and serious preparations to do such an act,

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act¹³.

If the act was done, or the preparations were made, in the course of a business, the person entitled to the right so conferred may:

- 266 (i) authorise the doing of that act by any partners of his for the time being in that business; and
- 267 (ii) assign that right, or transmit it on death or, in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or the preparations were made¹⁴.

1 See PARAS 512-513.

2 Persons who carry out non-infringing acts within heads (1)-(3) in the text are not thereby persons entitled to use the invention for the purposes of the Patents Act 1977 s 60(2): see s 60(6); and PARA 513 note 4. Further, the supply or the offer to supply such persons with essential means for putting the invention into effect amounts to infringement: see s 60(3); and PARA 513.

3 Patents Act 1977 s 60(5)(a).

4 Patents Act 1977 s 60(5)(b). The difference in wording between s 60(5)(a) and s 60(5)(b) indicates that the 'experimental purposes' in s 60(5)(b) may have a commercial end in view (*Monsanto Co v Stauffer Chemical Co* [1985] RPC 515 at 538, CA) eg experiments carried out to see whether the experimenter could make a quality product commercially in accordance with the patent specification (*Micro Chemicals Ltd v Smith Kline & French Inter-American Corp*n (1971) 25 DLR 79 at 89, Can SC; *Monsanto Co v Stauffer Chemical Co* at 538). See also *Helitune Ltd v Stewart Hughes Ltd* [1991] RPC 78, [1991] FSR 171; *Lubrizol v Esso* [1998] RPC 727, CA. Trials carried out to discover something unknown or to test a hypothesis or to find out whether something which is known to work in specific conditions will work in other conditions can be regarded as experiments. Trials carried out to demonstrate to a third party that a product works or in order to amass information to satisfy a third party such as a customer or regulatory authority that the product works as its maker claims are, however, not acts done for experimental purposes: *Monsanto Co v Stauffer Chemical Co* at 542. It is not an infringement to carry out experiments for the purpose of challenging the validity of a patent or of an amendment or of establishing whether what the defendant is doing actually does infringe: see *Monsanto Co v Stauffer Chemical Co*; *Smith Kline & French Laboratories Ltd v Evans Medical Ltd* [1989] FSR 513. The experiments must relate to the subject matter of the invention the subject of the patent in respect of which infringement is alleged in the sense of having a real and direct connection with that subject matter: *Smith Kline & French Laboratories Ltd v Evans Medical Ltd* at 524. This can cause difficulties where a product is covered by both a master patent and a selection patent: see *Smith Kline & French Laboratories Ltd v Evans Medical Ltd* at 524.

5 Patents Act 1977 s 60(5)(c).

6 See the Patents Act 1977 s 60(5)(d)-(f); and PARA 515 heads (1)-(3).

7 See the Patents Act 1977 s 60(5)(g), (h); and PARA 516 heads (1), (2).

8 Ie EC Directive 2001/82 (OJ L311, 28.11.2001, p 1) of the European Parliament and Council on the Community code relating to veterinary medicinal products, art 13 paras 1-5 (amended by EC Directive 2004/28 of the European Parliament and Council (OJ L136, 30.4.2004, p 58)): Patents Act 1977 s 60(7) (amended by SI 2005/2759).

9 Ie EC Directive 2001/83 (OJ L311, 28.11.2001, p 67) of the European Parliament and of the Council on the Community code relating to medicinal products for human use (amended by EC Directive 2002/98 (OJ L33, 8.2.2003, p 30) of the European Parliament and of the Council, by EC Commission Directive 2003/63 (OJ L159, 27.6.2003, p 46) and by EC Directives 2004/24 (OJ L136, 30.4.2004, p 85) and EC Directive 2004/27 (OJ L136, 30.4.2004, p 34) of the European Parliament and of the Council) art 10 paras 1-4: Patents Act 1977 s 60(7) (amended by SI 2005/2759).

10 Patents Act 1977 s 60(5)(i) (added by SI 2005/2759).

11 As to the meaning of 'United Kingdom' see PARA 303 note 5.

12 As to the meaning of 'priority date' see PARA 311 note 6.

13 Patents Act 1977 s 64(1) (s 64 substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 17). Where a product is disposed of to another in exercise of the rights conferred by the Patents Act 1977 s 64(1) or (2), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent: s 64(3) (as so substituted).

14 Patents Act 1977 s 64(2) (as substituted: see note 13). See also note 13.

UPDATE

514 Excepted acts; right to continue prior use

NOTE 9--Directive 2001/83: further amended by European Parliament and EC Council Regulation 1901/2006 (OJ L378, 27.12.2006, p 1), European Parliament and EC Council Regulation 1394/2007 (OJ L324, 10.12.2007, p 121), European Parliament and EC Council Directive 2008/29 (OJ L81, 20.3.2008, p 51), European Parliament and EC Council Directive 2009/53 (OJ L168, 30.6.2009, p 33), and EC Commission Directive 2009/120 (OJ L242, 15.9.2009, p 3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(2) ACTS OF INFRINGEMENT/515. Use of ships, aircraft, hovercraft and vehicles.

515. Use of ships, aircraft, hovercraft and vehicles.

An act which would otherwise infringe a patent¹ does not do so if it consists of:

- 268 (1) the use, exclusively for the needs of a ship registered in or belonging to a convention country² (a 'relevant ship'), of a product or process in the body of such a ship³ or in its machinery, tackle, apparatus or other accessories, where the ship has temporarily or accidentally entered the internal or territorial waters of the United Kingdom⁴; or
- 269 (2) the use of a product or process in the body or operation of an aircraft, hovercraft or vehicle so registered or belonging (a 'relevant aircraft, hovercraft or vehicle') which has temporarily or accidentally entered or is crossing the United Kingdom, including the air space above it and its territorial waters, or the use of accessories for such a relevant aircraft, hovercraft or vehicle⁵; or
- 270 (3) the use of an exempted aircraft⁶ which has lawfully entered or is lawfully crossing the United Kingdom, including the air space above it and its territorial waters, or the importation into the United Kingdom, or the use or storage there, of any part or accessory for such an aircraft⁷.

Furthermore, no lawful entry into the United Kingdom⁸ or lawful transit across the United Kingdom, with or without landings, of an aircraft, other than an aircraft used in military, customs or police services, registered in any of certain countries or territories⁹ may entail any seizure or detention¹⁰ of the aircraft or any proceedings¹¹, or any other interference with the aircraft, on the ground that the construction, mechanism, parts, accessories or operation of the aircraft is or are an infringement of any patent, design or model¹². Nor may the importation into, or storage in, the United Kingdom of spare parts and spare equipment for such an aircraft and their use and installation in the repair of such an aircraft entail any seizure or detention of the aircraft, parts or equipment or any proceedings, or any other interference with the aircraft, on the ground that the parts or equipment or their installation infringe any patent, design or model¹³ unless the parts or equipment concerned are sold or distributed in the United Kingdom or exported from the United Kingdom for sale or distribution¹⁴. These provisions relate only to proceedings by or on behalf of persons in the United Kingdom¹⁵, and to proceedings against the owner or operator of the aircraft¹⁶, or, as the case may be, against the owner or operator of the aircraft or the owner of the parts or equipment¹⁷.

Where these protective provisions do not apply, the use of patented articles on or over the territorial waters of the United Kingdom is an infringement of the patent¹⁸. Use outside territorial waters does not generally amount to an infringement¹⁹ but acts done on the continental shelf or in connection with the exploration of the sea bed or subsoil or exploration of their natural resources constitute acts done in the United Kingdom²⁰ and so may infringe a patent.

¹ See PARAS 512-513.

² I.e. a country, other than the United Kingdom, which is a party to the International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431), or which is a member of the World Trade Organisation. For these countries see PARA 652. As to the meaning of 'United Kingdom' see PARA 303 note 5.

3 A claim to the whole ship (in casu a multi-hull vessel) so that the whole ship would be an infringement is also within the exclusion: *Stena Rederi AB v Irish Ferries Ltd* [2003] EWCA Civ 66, [2003] RPC 668.

4 Patents Act 1977 ss 60(5)(d), (7), 132(2) (s 60(7) amended by SI 1999/1899). As to the extent of the territorial waters (or sea) of the United Kingdom see the Territorial Sea Act 1987 and **INTERNATIONAL RELATIONS LAW** vol 61 (2010) PARA 124. For the purposes of the Patents Act 1977, the territorial waters of the United Kingdom are treated as part of the United Kingdom: sees 132(3); and PARA 305. 'Temporary' means transient or limited in time and does not depend on frequency: *Stena Rederi AB v Irish Ferries Ltd* [2003] EWCA Civ 66, [2003] RPC 668 (ferry crossing between Ireland and the United Kingdom was temporarily within the internal and territorial waters).

5 Patents Act 1977 ss 60(5)(e), (7), 132(2) (s 60(7) as amended: see note 4).

6 For these purposes, 'exempted aircraft' means an aircraft to which the Civil Aviation Act 1982 s 89 (aircraft exempted from seizure in respect of patent claims (see the text to notes 8-17)) applies: Patents Act 1977 s 60(7) (amended by the Civil Aviation Act 1982 s 109, Sch 15 para 19).

7 Patents Act 1977 ss 60(5)(f), 132(2).

8 The Civil Aviation Act 1982 s 89 is applied to Jersey by the Civil Aviation Act 1982 (Jersey) Order 1990, SI 1990/2145 (see art 2, Sch 1 Pts I, II) and to Guernsey by the Civil Aviation Act 1982 (Guernsey) Order 1992, SI 1992/230 (see art 2, Sch 1 Pts I, II) and is applied in adapted and modified form to certain overseas territories by the Civil Aviation Act 1949 (Overseas Territories) Order 1969, SI 1969/592 (see art 3, Sch 2 para 12, Sch 3).

9 Civil Aviation Act 1982 s 89(4)(a). As to the relevant countries and territories see the Aircraft (Exemption from Seizure on Patent Claims) Order 1977, SI 1977/829, art 4, Schedule. Her Majesty may by Order in Council exempt other aircraft: Civil Aviation Act 1982 s 89(4)(b).

10 Where it is alleged by any person interested that a foreign aircraft which is not an aircraft to which the Civil Aviation Act 1982 s 89 applies, and which is making a passage through or over the United Kingdom, infringes in itself or in any part of it any invention, design or model which is entitled to protection in the United Kingdom, it is lawful, subject to and in accordance with rules of court, to detain the aircraft until the owner thereof deposits or secures in respect of the alleged infringement a sum (the 'deposited sum') and thereupon the aircraft is not during the continuance or in the course of the passage subject to any lien, arrest, detention or prohibition, whether by order of a court or otherwise, in respect or on account of the alleged infringement: s 89(5), Sch 12 para 1. The deposited sum must be such sum as may be agreed between the parties interested or, in default of agreement, fixed by the Secretary of State or some person duly authorised on his behalf; and payment thereof must be made or secured to the Secretary of State in such manner as the Secretary of State approves: Sch 12 para 2. The deposited sum must be dealt with by such tribunal and in accordance with such procedure as may be specified by rules of court and any such rules may provide generally for carrying Sch 12 into effect: Sch 12 para 3. For these purposes, 'owner' includes the actual owner of an aircraft and any person claiming through or under him; and 'passage' includes all reasonable landings and stoppages in the course or for the purpose of the passage: Sch 12 para 4. At the date at which this volume states the law no such rules of court had been made.

11 As to the proceedings concerned see the text and notes 15-17.

12 Civil Aviation Act 1982 s 89(1). Section 89 gives effect to the Convention on International Civil Aviation (the 'Chicago Convention') (Chicago, 7 December 1944: TS 8 (1953); Cmd 8742) art 27: see **AIR LAW** vol 2 (2008) PARA 436. As to the convention see **AIR LAW** vol 2 (2008) PARA 2 et seq.

13 Civil Aviation Act 1982 s 89(2).

14 Civil Aviation Act 1982 s 89(3).

15 See the Civil Aviation Act 1982 s 89(1), (2).

16 See the Civil Aviation Act 1982 s 89(1). See also note 17.

17 See the Civil Aviation Act 1982 s 89(2). So far as the aircraft itself is concerned, this is comprehensive except that it cannot prevent actions for damages by foreign patentees. So far as equipment or spares are concerned, the protection given seems to be comprehensive only on the assumption that the operator will import, store and fit his own equipment or spares.

18 See the Patents Act 1977 s 132(3), which provides that for the purposes of the Patents Act 1977 the territorial waters of the United Kingdom are to be treated as part of the United Kingdom.

19 *Newall v Elliott and Glass* (1864) 10 Jur NS 954; *Goucher v Clayton* (1865) 11 Jur NS 462 at 465; *VD Ltd v Boston Deep Sea Fishing and Ice Co Ltd* (1935) 52 RPC 303.

20 See the Patents Act 1977 s 132(4); and PARA 305.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/8. INFRINGEMENT/(2) ACTS OF INFRINGEMENT/516. Use of plant propagating material or animal reproductive material.

516. Use of plant propagating material or animal reproductive material.

An act which would otherwise infringe a patent¹ does not do so if it consists of:

- 271 (1) the use by a farmer of the product of his harvest for propagation or multiplication by him on his own holding², where there has been a sale³ of plant propagating material to the farmer by the proprietor of the patent or with his consent for agricultural use⁴;
- 272 (2) the use of an animal or animal reproductive material by a farmer for an agricultural purpose⁵ following a sale to the farmer, by the proprietor of the patent or with his consent, of breeding stock or other animal reproductive material which constitutes or contains the patented invention⁶.

1 See PARAS 512-513.

2 'Farmer's own holding' means any land which a farmer actually exploits for plant growing, whether as his property or otherwise managed under his own responsibility and on his own account: Patents Act 1977 s 60(6A), Sch A1 para 1 (s 60(6A), Sch A1 added by SI 2000/2037).

3 'Sale' includes any other form of commercialisation: Patents Act 1977 s 60(6C) (added by SI 2000/2037).

4 Patents Act 1977 s 60(5)(g) (added by SI 2000/2037). For the provisions restricting the circumstances in which the Patents Act 1977 s 60(5)(g) applies and for the provisions which apply where an act would constitute an infringement of the patent by for s 60(5)(g) see s 60(6A), Sch A1 (as added: see note 2).

5 Use for an agricultural purpose: (1) includes making an animal or animal reproductive material available for the purposes of pursuing the farmer's agricultural activity; but (2) does not include sale within the framework, or for the purposes, of a commercial reproduction activity: Patents Act 1977 s 60(6B) (added by SI 2000/2037).

6 Patents Act 1977 s 60(5)(h) (added by SI 2000/2037).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(1) INTRODUCTION/517. Nature of proceedings.

9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION

(1) INTRODUCTION

517. Nature of proceedings.

The proceedings with which this part of the title is concerned¹ are proceedings for the infringement of a patent², proceedings for a declaration of non-infringement³, proceedings to restrain groundless threats of infringement proceedings⁴ and proceedings for the revocation of a patent⁵. All these proceedings may, in England and Wales, be brought in the Patents Court⁶ or the patents county court⁷ and proceedings to restrain threats must be so brought⁸; but proceedings for revocation or for a declaration of non-infringement of a patent may be brought before the comptroller⁹, and the parties may by agreement refer a question of infringement to him¹⁰. Where certain proceedings¹¹ are pending before the court, proceedings¹² may not be instituted before the comptroller without the leave of the court¹³.

The proprietor of a patent or any other person may request the comptroller to issue an opinion as to whether there has been an infringement of a patent or whether the invention in question is not patentable¹⁴.

1 As to applications for prerogative orders see PARA 643.

2 As to proceedings for infringement see PARA 521 et seq.

3 As to proceedings for a declaration of non-infringement see PARA 556.

4 As to proceedings to restrain threats see PARA 557 et seq.

5 As to proceedings for revocation see PARA 564 et seq.

6 Patents Act 1977 ss 61(1), 70(1), 71(1), 72(1), 130(1). As to the Patents Court see PARA 637 et seq.

7 Patents Act 1977 ss 61(1), 70(1), 71(1), 72(1), 130(1). As to the patents county court see PARA 644 et seq.

8 Patents Act 1977 s 70(1).

9 Patents Act 1977 ss 71(1), 72(1). As to the comptroller see PARA 577.

10 See the Patents Act 1977 s 61(3); and PARA 555. Relief is limited to damages and a declaration (Patents Act 1977 s 61(1)(c), (e), (3)), with a certificate of contested validity (see s 65; and PARA 551). A declaration that a patent is valid is, however, not conclusive; the other party may challenge validity again in the event of High Court infringement proceedings: see s 72(5); and PARA 554. As an alternative, the parties may refer their dispute to arbitration, and there are provisions for sending a dispute referred to the comptroller to arbitration.

11 Ie any proceedings with respect to a patent such as are described in PARA 598 heads (1)-(5).

12 Ie proceedings under the Patents Act 1977 s 61(3) (see PARA 555), s 69 (see PARA 548), s 71 (see PARA 556) or s 72 (see PARAS 564-565).

13 Patents Act 1977 s 74(7).

14 See the Patents Act 1977 ss 74A, 74B; and PARAS 518-519.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(1) INTRODUCTION/518. Opinions by the UK Intellectual Property Office.

518. Opinions by the UK Intellectual Property Office.

The proprietor of a patent or any other person may request the comptroller¹ to issue an opinion²:

- 273 (1) as to whether a particular act constitutes, or, if done, would constitute, an infringement of the patent³;
- 274 (2) as to whether, or to what extent, the invention in question is not patentable because it is not new or does not involve an inventive step⁴.

An opinion can be requested even if the patent has expired or has been surrendered⁵.

The comptroller must issue an opinion if requested to do so, but must not do so if:

- 275 (a) the request appears to him to be frivolous or vexatious or the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings⁶;
- 276 (b) the requestor gives him notice in writing that the request is withdrawn⁷; or
- 277 (c) for any reason he considers it inappropriate in all the circumstances to do so⁸.

If the comptroller intends at any time to refuse the request under heads (a) to (c), he must notify the requester accordingly⁹.

The comptroller must notify interested persons¹⁰ of the request and must advertise it in such manner as he thinks fit¹¹.

If the request has not been refused or withdrawn, any person may, before the end of the relevant period, file observations on any issue raised by the request¹². Such observations may include reasons why the comptroller should refuse the request¹³.

An opinion under these provisions is not binding for any purposes¹⁴.

An opinion must be prepared by an examiner¹⁵.

In relation to a decision of the comptroller whether to issue an opinion under these provisions, for the purposes of the exercise of the comptroller's discretionary powers¹⁶, only the person making the request for an opinion¹⁷ is to be regarded as a party to a proceeding before the comptroller, and no appeal lies at the instance of any other person¹⁸.

1 As to the comptroller see PARA 577. A request must be made on Patents Form 17 and must be accompanied by a copy and a statement setting out fully: (1) the question upon which an opinion is sought; (2) the requester's submissions on that question; and (3) any matters of fact which are requested to be taken into account: Patents Rules 2007, SI 2007/3291, r 93(1). The statement must be accompanied by: (a) the name and address of any persons, of whom the requester is aware, having an interest in that question; and (b) particulars of any relevant proceedings of which the requester is aware which relate to the patent in suit and which may be relevant to that question: r 93(2). 'Relevant proceedings' means proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office: r 92. Where the requester is acting as an agent in making the request, the persons referred to in head (a) do not include the person for whom the requester is so acting: r 93(3). The statement must be accompanied by a copy of any evidence or other document (except a document which has been published by the comptroller or is kept at the UK Intellectual Property Office) which is referred to in the statement: r 93(4). Each such statement, evidence or other document must be provided in

duplicate: r 93(5). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 Patents Act 1977 s 74A(1) (s 74A added by the Patents Act 2004 s 13(1)).

3 Patents Act 1977 s 74A(1)(a) (as added: see note 2). As to infringement see PARA 500 et seq.

4 Patents Act 1977 ss 1(1)(a), (b), 74A(1)(b) (as added: see note 2). As to novelty see PARA 435 et seq; and as to lack of inventive step see PARA 452 et seq. See *Re DLP Ltd's Patent* [2007] EWHC 2669 (Pat), [2008] 1 All ER 839, [2008] RPC 257.

5 Patents Act 1977 s 74A(2) (as added: see note 2). As to the term of patents see PARA 339. As to surrender see PARA 359.

6 Patents Act 1977 s 74A(3)(a) (as added: see note 2); Patents Rules 2007, SI 2007/3291, r 94(1).

7 Patents Act 1977 s 74A(3)(a) (as added: see note 2); Patents Rules 2007, SI 2007/3291, r 94(2).

8 Patents Act 1977 s 74A(3)(b) (as added: see note 2).

9 Patents Rules 2007, SI 2007/3291, r 94(3).

10 The comptroller must notify each of the following persons of the request (except where the person concerned is the requester): (1) the patent holder; (2) any holder of a licence or sub-licence under the patent in suit (ie the patent to which that request relates) which has been registered under the Patents Rules 2007, SI 2007/3291, r 47 (see PARA 588); (3) any person who has made a request in respect of the patent in suit under r 54 (see PARA 581) regarding an opinion being requested under r 93; (4) any person who is specified under r 93(2)(a) (see note 1 head (a)): r 95(1). In addition, the comptroller may notify of the request any persons who appear to him to be likely to have an interest in the question upon which the opinion is sought: r 95(2). The comptroller must send a copy of the form and statement filed under r 93(1) (see note 1) to each person so notified, together with a copy of such other documents filed under r 93 as he thinks fit: r 95(3).

11 Patents Rules 2007, SI 2007/3291, r 95(1)-(4). If the request is refused or withdrawn before a notification has been made under r 95(1), the patent holder alone must be notified of the request (and of the fact that it has been refused or withdrawn) and r 95(3), (4) do not apply: r 95(5).

12 Patents Rules 2007, SI 2007/3291, r 96(1). Any person who files observations must ensure that, before the end of four weeks beginning with the date of advertisement under r 95(4), a copy of those observations is received: (1) where that person is not the patent holder, by the patent holder; and (2) by the requester: r 96(3), (7). A person to whom observations are sent may, during the period of two weeks beginning immediately after the end of the four week period, file observations confined strictly to matters in reply: r 96(4), (7). Any person who files observations must ensure that, within that period of two weeks, a copy of those observations is received: (a) where that person is the requester, by the patent holder; and (b) where that person is the patent holder, by the requester: r 96(5). If it is reasonably possible, the observations filed under this rule and the copies of such observations are to be delivered only in electronic form or using electronic communications: r 96(6).

13 Patents Rules 2007, SI 2007/3291, r 96(2).

14 Patents Act 1977 s 74A(4) (as added: see note 2).

15 Patents Act 1977 s 74A(5) (as added: see note 2). After the end of the procedure under the Patents Rules 2007, SI 2007/3291, r 96, the comptroller must refer the request to an examiner for the preparation of the opinion: r 97(1). The comptroller must issue the opinion that has been prepared by sending a copy to: (1) the requester; (2) the patent holder; and (3) any other person who filed observations under r 96(1) (see the text to note 12): r 97(2).

16 Ie for the purposes of the Patents Act 1977 s 101: see PARA 593.

17 Ie under the Patents Act 1977 s 74A(1).

18 Patents Act 1977 s 74A(6) (as added: see note 2).

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519. Review of opinion.

Rules may make provision for a review before the comptroller¹, on an application by the proprietor or an exclusive licensee² of the patent in question, of an opinion³ as to validity or infringement⁴. The rules may, in particular:

- 278 (1) prescribe the circumstances in which, and the period within which, an application may be made⁵;
- 279 (2) provide that, in prescribed circumstances, proceedings for a review may not be brought or continued where other proceedings have been brought⁶;
- 280 (3) make provision under which, in prescribed circumstances, proceedings on a review are to be treated for prescribed purposes as if they were proceedings for infringement of a patent⁷, for declaration of non-infringement⁸ or application for revocation⁹ on the grounds that the invention is not a patentable invention¹⁰; and
- 281 (4) provide for there to be a right of appeal against a decision made on a review only in prescribed cases¹¹.

The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion¹². However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other relevant proceedings¹³. The application must be made on the prescribed form¹⁴ and be accompanied by a copy and a statement in duplicate setting out the grounds on which the review is sought¹⁵. The statement must contain particulars of any relevant proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued¹⁶.

The application may be made on the following grounds only:

- 282 (a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent¹⁷; or
- 283 (b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent¹⁸.

On receipt of the application, the comptroller must send a copy of the form and statement filed to the requester (if different from the applicant) and any person who filed observations¹⁹. The comptroller must advertise the application in such manner as he thinks fit²⁰. Before the end of the relevant period²¹, any person may file a statement in support of the application or a counter-statement contesting it (which in either case must be in duplicate), and on so doing must become a party to the proceedings for a review²².

On completion of the proceedings the comptroller must either set aside the opinion in whole or in part or decide that no reason has been shown for the opinion to be set aside²³. The decision does not estop any party to any proceedings from raising any issue regarding the validity or the infringement of the patent²⁴. No appeal²⁵ lies from a decision to set aside the opinion, except where the appeal relates to a part of the opinion that is not set aside²⁶.

- 1 As to the comptroller see PARA 577.
- 2 As to the meaning of 'exclusive licensee' see PARA 380 note 7.
- 3 le under the Patents Act 1977 s 74A: see PARA 518.
- 4 Patents Act 1977 s 74B(1) (s 74B added by the Patents Act 2004 s 13(1)). See the Patents Rules 2007, SI 2007/3291, rr 98-100; and the text and notes 12-26.
- 5 Patents Act 1977 s 74B(2)(a) (as added: see note 3).
- 6 Patents Act 1977 s 74B(2)(b) (as added: see note 3).
- 7 le under the Patents Act 1977 s 61(1)(c) or (e): see PARA 517.
- 8 le under the Patents Act 1977 s 71(1): see PARA 556.
- 9 le under the Patents Act 1977 s 72(1)(a): see PARA 430.
- 10 Patents Act 1977 s 74B(2)(c) (as added: see note 3).
- 11 Patents Act 1977 s 74B(2)(d) (as added: see note 3).
- 12 Patents Rules 2007, SI 2007/3291, r 98(1).
- 13 Patents Rules 2007, SI 2007/3291, r 98(2). As to the meaning of 'relevant proceedings' see PARA 518 note 1.
- 14 The application must be made on Patents Form 2: see the Patents Rules 2007, SI 2007/3291, r 98(3).
- 15 Patents Rules 2007, SI 2007/3291, r 98(3).
- 16 Patents Rules 2007, SI 2007/3291, r 98(4).
- 17 Patents Rules 2007, SI 2007/3291, r 98(5)(a).
- 18 Patents Rules 2007, SI 2007/3291, r 98(5)(b).
- 19 Patents Rules 2007, SI 2007/3291, r 99(1). Observations are filed under r 96: see PARA 518.
- 20 Patents Rules 2007, SI 2007/3291, r 99(2).
- 21 The relevant period is: (1) four weeks beginning with the date on which the application is advertised; or (2) if it expires later, the period of two months beginning with the date on which the opinion is issued under the Patents Rules 2007, SI 2007/3291, r 97(2) (see PARA 518): r 99(4).
- 22 Patents Rules 2007, SI 2007/3291, r 99(3). The comptroller must send to the other parties a copy of each statement or counter-statement filed under r 99(3): r 99(5). The following rules apply to the proceedings for a review: r 74 (overriding objective); r 79 (copies of documents); r 80(2)-(6) (evidence and the hearing); r 81 (alteration of time limits); r 82 (general powers of the comptroller in relation to proceedings before him); r 84 (hearings in public); r 87 (evidence in proceedings before the comptroller); r 83 (striking out a statement of case and summary judgment); r 85 (security for costs or expenses); r 86 (powers of comptroller to compel attendance of witness and production of documents); r 88 (proceedings in Scotland): r 99(6), Sch 3 Pts 4, 5. For the purposes of r 83(3), a reference to 'the claimant' is a reference to the applicant for a review, and a reference to 'the defendant' is a reference to any other party: r 99(6).
- 23 Patents Rules 2007, SI 2007/3291, r 100(1). The hearing officer should only decide an opinion was wrong if the examiner had made an error of principle or reached a conclusion that was clearly wrong: *Re an appeal by DLP Ltd* [2007] EWHC 2669 (Pat), [2008] 1 All ER 839, [2008] RPC 257.
- 24 Patents Rules 2007, SI 2007/3291, r 100(2).
- 25 le under the Patents Act 1977 s 97: see PARA 573.
- 26 Patents Rules 2007, SI 2007/3291, r 100(3). An appeal did not involve an academic question and the Patents Court should not decline jurisdiction to hear such appeals. But the court should only reverse the decision of a hearing officer if he had failed to recognise an error of principle or clearly wrong conclusion in the

opinion and so declined to set it aside: *Re an appeal by DLP Ltd* [2007] EWHC 2669 (Pat) at [22], [2008] 1 All ER 839 at [22], [2008] RPC 257 at [22].

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(1) INTRODUCTION/520. Putting validity in issue.

520. Putting validity in issue.

The validity of a patent¹ may only² be put in issue³:

- 284 (1) by way of defence in infringement proceedings⁴ or proceedings⁵ for infringement of rights conferred by the publication of an application⁶;
- 285 (2) in proceedings⁷ for threats⁸;
- 286 (3) in proceedings in which a declaration of non-infringement⁹ is sought¹⁰;
- 287 (4) in revocation proceedings¹¹ before the court¹² or the comptroller¹³;
- 288 (5) in proceedings¹⁴ on a dispute as to Crown use¹⁵.

No determination may, however, be made in any such proceedings on the validity of a patent which any person puts in issue on the ground of lack of entitlement¹⁶ unless:

- 289 (a) it has been determined in entitlement proceedings¹⁷ commenced by that person or in the proceedings in which the validity is in issue that the patent should have been granted to him and not some other person¹⁸; and
- 290 (b) except where it has been so determined in entitlement proceedings, the proceedings in which the validity is in issue are commenced before the end of the period of two years beginning with the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent¹⁹.

¹ As to validity see PARA 430 et seq.

² Validity may not be put in issue in any other proceedings, and in particular no proceedings may be instituted, whether under the Patents Act 1977 or otherwise, seeking only a declaration as to the validity or invalidity of a patent: s 74(2). See *Arrow Generics Ltd v Merck & Co Inc* [2007] EWHC 1900 (Ch), [2007] FSR 920, [2007] All ER (D) 3 (Aug). As to opinions by the UK Intellectual Property Office as to validity or infringement see the Patents Act 1977 ss 74A, 74B; and PARAS 518-519. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

³ The only grounds on which validity may be put in issue, whether in proceedings for revocation under the Patents Act 1977 s 72 (see PARAS 564-565) or otherwise, are the grounds on which it may be revoked under s 72: s 74(3). For the purposes of the Patents Act 1977, the validity of a patent is not put in issue merely because the comptroller is considering its validity in order to decide whether to revoke it on his own initiative under s 73 (see PARA 571) or because its validity is being considered in connection with an opinion under s 74A or a review of such an opinion (see PARAS 518-519): s 74(8) (amended by the Patents Act 2004 s 13(2)). As to the comptroller see PARA 577.

⁴ I.e. under the Patents Act 1977 s 61: see PARA 521 et seq.

⁵ I.e. under the Patents Act 1977 s 69: see PARA 548.

⁶ Patents Act 1977 s 74(1)(a).

⁷ I.e. under the Patents Act 1977 s 70: see PARA 557 et seq.

⁸ Patents Act 1977 s 74(1)(b).

⁹ I.e. under the Patents Act 1977 s 71: see PARA 556.

¹⁰ Patents Act 1977 s 74(1)(c).

11 Ie under the Patents Act 1977 s 72: see PARA 564 et seq.

12 As to the meaning of 'court' see PARA 637 note 1.

13 Patents Act 1977 s 74(1)(d).

14 Ie under the Patents Act 1977 s 58: see PARA 410.

15 Patents Act 1977 s 74(1)(e).

16 Ie the ground mentioned in the Patents Act 1977 s 72(1)(b): see PARA 564.

17 For these purposes, 'entitlement proceedings', in relation to a patent, means a reference under the Patents Act 1977 s 37(1) (see PARA 366) on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration that it was so granted: s 74(6) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 10).

18 Patents Act 1977 s 74(4)(a). Where validity is put in issue by way of defence or counterclaim, the court or the comptroller, if it or he thinks it just to do so, must give the defendant an opportunity to comply with the condition in s 74(4)(a): s 74(5).

19 Patents Act 1977 s 74(4)(b). As to registration see PARA 585 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/521. Claimants in proceedings for infringement.

(2) PROCEEDINGS FOR INFRINGEMENT

521. Claimants in proceedings for infringement.

The right to bring a claim for infringement¹ belongs to the proprietor of the patent², to his exclusive licensees³ and, in certain circumstances⁴, to holders of compulsory licences⁵ and licences of right⁶. The claimant probably need not first secure entry of his title on the register of patents⁷, but failure to do so may limit his right to damages⁸. When a licensee sues alone, the proprietor must be made a defendant, although he is not liable for costs unless he acknowledges service of the claim form and takes part in the proceedings⁹. Where the proprietor sues, it is usual for exclusive licensees to be joined as claimants¹⁰. Previous proprietors may be joined where infringement took place before the change in ownership¹¹.

One of two or more joint proprietors may bring infringement proceedings without the concurrence of the others, provided that the others are made parties to the proceedings, although any joint proprietor who is made a defendant is not liable for any costs unless he acknowledges service of the claim form and takes part in the proceedings¹². The right to sue survives to a personal representative¹³. Where the claimant is an equitable owner, he should join the registered proprietor as claimant or defendant¹⁴. The assignee of a distinct portion of a patent, or an assignee for a particular district, may sue alone for any infringement of his rights¹⁵. Compulsory licences and licences granted under patents in respect of which licences are available as of right give the licensee power to request the proprietor to take proceedings to prevent any infringement of the patent; and, if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were a proprietor, making the proprietor a defendant¹⁶.

1 In the Patents Court proceedings in which the claimant makes a claim in respect of the infringement of a patent must be started by issuing a Part 7 claim form (see **CIVIL PROCEDURE** vol 11 (2009) PARA 116 et seq) or in existing proceedings under Part 20 (see **CIVIL PROCEDURE** vol 11 (2009) PARA 618 et seq): CPR 63.5. No proceedings for infringement may be instituted until the patent has been granted: Patents Act 1977 s 69(2)(a); and see *Therm-a-Stor Ltd v Weatherseal Windows Ltd* [1981] FSR 579, CA; and PARA 548.

2 Patents Act 1977 s 61(1). See *Xtralite (Rooflights) Ltd v Hartington Conway Ltd* [2003] EWHC 1872 (Ch), [2004] RPC 161, [2003] All ER (D) 555 (Jul) (estoppel preventing proprietor claiming ownership).

3 Patents Act 1977 s 67(1). The holder of an exclusive licence has the same right as the proprietor to bring proceedings in respect of any infringement committed after the date of the licence: s 67(1). As to the meanings of 'exclusive licence' and 'exclusive licensee' see PARA 380 note 7. As to the award of damages to an exclusive licensee see s 67(2); and PARA 546.

4 See the text and note 14.

5 See the Patents Act 1977 s 49(4); and PARA 396.

6 See the Patents Act 1977 s 46(4); and PARA 392.

7 See PARA 585 et seq.

8 See the Patents Act 1977 s 68; and PARA 553. The advantage of securing a fresh assignment or grant of a different licence immediately before registration should be noted: see *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] FSR 118.

9 See the Patents Act 1977 s 46(4), (5) (licences of right: see PARA 392), s 49(4) (compulsory licences: see PARA 396), s 67(3) (exclusive licences).

10 This is done to enable them to claim damages: *Trico Products Corpn and Trico-Folberth Ltd v Romac Motor Accessories Ltd* (1933) 51 RPC 90.

11 The assignment of a patent or the grant of an exclusive licence under it may, however, confer on the assignee or licensee the right to bring proceedings under the Patents Act 1977 s 61 or s 69 (proceedings for infringements) or s 58 (disputes as to Crown use: see PARA 410): s 30(7).

12 Patents Act 1977 s 66(2).

13 See the Law Reform (Miscellaneous Provisions) Act 1934 s 1; and **EXECUTORS AND ADMINISTRATORS** vol 17(2) (Reissue) PARA 814.

14 *Spennymoor Foundry Ltd v Catherall and Geldard* (1909) 26 RPC 822; *Three Rivers District Council v Bank of England (Governor and Co)* [1996] QB 292, [1995] 4 All ER 312, CA. It is doubtful whether a mortgagor need join a mortgagee registered as such: *Van Gelder, Apsimon & Co v Sowerby Bridge United District Flour Society* (1890) 44 ChD 374, 7 RPC 208, CA. It would seem that a mortgagee cannot sue alone: *Van Gelder, Apsimon & Co v Sowerby Bridge United District Flour Society*.

15 *Dunnicliff and Bagley v Mallet* (1859) 7 CBNS 209; *Walton v Lavater* (1860) 8 CBNS 162; *Reitzman v Grahame-Chapman and Derustit Ltd* (1950) 67 RPC 178 (on appeal (1951) 68 RPC 25, CA).

16 Patents Act 1977 s 46(4) (licences of right: see PARA 392), s 49(4) (compulsory licences: see PARA 396). A proprietor-defendant who neither acknowledges service of the claim form nor takes part in the proceedings is not liable for costs: see ss 46(5), 49(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/522. Defendants in proceedings for infringement.

522. Defendants in proceedings for infringement.

The claimant to an infringement action may join as defendants all persons responsible for the breaches on which he sues, for example the manufacturer of or dealer in an infringing article, or a vendor and purchaser¹, or a principal and agent² or as joint tortfeasors being parties to a common design to infringe³. The directors of a company should not be joined as defendants unless they have done some act which makes them personally responsible⁴. Where the action is brought against a shipping company or railway in respect of goods carried by it, the consignee should also be joined⁵. In general the choice of defendants lies with the claimant, and other persons concerned will not be made defendants against the claimant's wish⁶, although the defendants may apply to have them made defendants to a counterclaim or third parties in the normal way⁷. Where joinder of a defendant is otherwise proper, it is not improper to join him because the claimant's main motive is to obtain disclosure from him⁸.

1 *Saccharin Corp Ltd v DTJ Lyle & Son Ltd* (1904) 21 RPC 604, CA. Where both makers and users were sued, and only the makers delivered a defence, leave for judgment on motion against the users was refused: *Act für Cartonnagen Industrie v T Remus & Co and Burgon & Co* (1895) 12 RPC 94. A supplier may be liable for its customer's costs if it has funded the customer's defence: *Koninklijke Philips Electronics NV v Prico Digital Disc GmbH* [2003] EWHC 2589 (Ch), [2004] FSR 663, [2003] All ER (D) 51 (Sep). The liability to be sued survives against a personal representative: see the Law Reform (Miscellaneous Provisions) Act 1934 s 1; and **EXECUTORS AND ADMINISTRATORS** vol 17(2) (Reissue) PARA 814.

2 See PARA 508.

3 See PARA 509. An inference that a defendant has knowingly facilitated or assisted in infringement is an insufficient basis for joining him to the proceedings: *Sepracor Inc v Hoechst Marion Roussel Ltd* [1999] FSR 746, [1999] All ER (D) 80.

4 See PARA 509.

5 *Washburn and Moen Manufacturing Co v Cunard Steamship Co and JC Parkes & Sons* (1889) 5 TLR 592, 6 RPC 398.

6 *Moser v Marsden* [1892] 1 Ch 487, 9 RPC 214, CA; *Evans v Central Electric Supply Co Ltd* (1923) 40 RPC 357. In *Vavasour v Krupp* (1878) 9 ChD 351, CA, the Mikado was joined as a defendant at his own request and obtained an order permitting him to remove the infringing articles. However, see *Tetra Molectric Ltd v Japan Imports Ltd (Win Lighter Corpn intervening)* [1976] RPC 541, CA, where a foreign manufacturer was added as a respondent to an appeal in an infringement action against an English distributor against the wishes of the proprietor of the patent.

7 As to joinder of parties see **CIVIL PROCEDURE** vol 11 (2009) PARA 210 et seq. Where there is no real dispute between the defendant and the party it seeks to join, joinder for the purposes of obtaining disclosure should be refused when there is no evidence that the disclosure will be of benefit: *Biogen Inc v Medeva plc* [1993] RPC 475.

8 *Mölnlycke AB v Procter & Gamble Ltd (No 4)* [1992] 4 All ER 47, [1992] 1 WLR 1112, [1992] RPC 21, CA, distinguished in *Biogen Inc v Medeva plc* [1993] RPC 475.

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522 Defendants in proceedings for infringement

NOTE 3--See *MMI Research Ltd v Cellxion Ltd* [2009] EWHC 418 (Pat), [2009] All ER (D) 124 (Mar).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/523. Relief claimed.

523. Relief claimed.

The relief which may be claimed¹ in proceedings for infringement of a patent² is:

- 291 (1) an injunction restraining the defendant from any apprehended act of infringement³;
- 292 (2) an order for him to deliver up or destroy any patented product⁴ in relation to which the patent is infringed or any article in which that product is inextricably comprised⁵;
- 293 (3) damages in respect of the infringement⁶;
- 294 (4) an account of the profits derived by him from the infringement⁷;
- 295 (5) a declaration that the patent is valid and has been infringed by him⁸; and
- 296 (6) further or other relief and costs⁹.

The relief which may be claimed in infringement proceedings before the comptroller¹⁰ is limited to relief under heads (3) and (5) above¹¹.

In determining whether to grant any relief and the extent of relief to be granted under the Patents Act 1977, the court¹² or the comptroller must apply the principles applied by the court in relation to that relief immediately before the above provisions came into force¹³.

In addition, the patentee may request the court to order appropriate measures for the dissemination and publication of the judgment to be taken at the defendant's expense¹⁴.

1 In a claim for infringement the statement of case must contain particulars as specified in *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11: see CPR 63.9; and PARA 528. A claim for unjust enrichment is not permitted: *Union Carbide Corp'n v BP Chemicals Ltd* [1998] FSR 1 (on appeal on a different point [1999] RPC 409, CA).

2 As to infringement see PARA 500 et seq.

3 Patents Act 1977 s 61(1)(a). See also PARA 521 note 1. As to injunctions see PARAS 538, 543-544.

4 As to the meaning of 'patented product' see PARA 372 note 11.

5 Patents Act 1977 s 61(1)(b). As to delivery up see PARA 550.

6 Patents Act 1977 s 61(1)(c). As to damages see PARA 545 et seq.

7 Patents Act 1977 s 61(1)(d). As to accounts of profits see PARA 545.

8 Patents Act 1977 s 61(1)(e). As to the validity of patents see PARA 430 et seq.

9 This is the usual additional relief claimed in the Chancery Division. As to costs see PARA 553.

10 In proceedings referred to under the Patents Act 1977 s 61(3): see PARA 555. As to the comptroller see PARA 577.

11 Patents Act 1977 s 61(3).

12 As to the meaning of 'court' see PARA 637 note 1.

13 Patents Act 1977 s 61(6). Section 61 came into force on 1 June 1978: see the Patents Act 1977 (Commencement No 2) Order 1978, SI 1978/586, art 2.

14 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 29.2.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/524. Service out of the jurisdiction.

524. Service out of the jurisdiction.

In a claim brought upon an infringement committed within the jurisdiction, permission may be given to serve the claim form out of the jurisdiction either as a claim founded on a tort committed within the jurisdiction¹, or as a claim in which an injunction is sought ordering the defendant to do or refrain from doing something² within the jurisdiction³, or on the ground that the defendant out of the jurisdiction is a necessary or proper party to the claim properly brought against a person duly served within the jurisdiction⁴. No permission is, however, required⁵ provided each claim is a claim which, by virtue of the Civil Jurisdiction and Judgments Act 1982, the court has power to hear and determine and provided certain conditions apply⁶. A prima facie case of infringement, or threatened infringement, within the jurisdiction must be shown⁷, but the court will not decide doubtful questions of law or fact adversely to the claimant on an application for permission or on an application to discharge the order⁸.

¹ See CPR 6.20(8); and **CIVIL PROCEDURE** vol 11 (2009) PARA 170.

² ie if the patent has not expired: see *Badische Anilin und Soda Fabrik v Chemische Fabrik vormals Sandoz* (1903) 20 RPC 413, CA; on appeal (1904) 90 LT 733, 21 RPC 533, HL.

³ See CPR 6.20(2); and **CIVIL PROCEDURE** vol 11 (2009) PARA 170. See also *Badische Anilin und Soda Fabrik v Johnson & Co* (1895) 12 RPC 535, CA; on appeal (1897) 14 RPC 919, HL.

⁴ See CPR 6.20(3); and **CIVIL PROCEDURE** vol 11 (2009) PARA 170. See also *Washburn and Moen Manufacturing Co v Cunard SS Co and JC Parkes & Sons* (1889) 6 RPC 398; *Beecham Group plc v Norton Healthcare Ltd* [1997] FSR 81, (1996) 37 BMLR 76.

⁵ See CPR 6.19; and **CIVIL PROCEDURE** vol 11 (2009) PARAS 168-169.

⁶ As to these conditions see CPR 6.19; and **CIVIL PROCEDURE** vol 11 (2009) PARAS 168-169. The claimant must establish a 'good arguable case' that the court does so have jurisdiction: *Mölnlycke AB v Procter & Gamble Ltd (No 4)* [1992] 4 All ER 47, [1992] 1 WLR 1112, [1992] RPC 21, CA.

⁷ See *Badische Anilin und Soda Fabrik v Chemische Fabrik vormals Sandoz* (1903) 20 RPC 413, CA (on appeal (1904) 90 LT 733, 21 RPC 533, HL); *Electric Furnace Co v Selas Corp of America* [1987] RPC 23, CA; *Raychem Corp v Theron (UK) Ltd* [1989] RPC 423; *Puschner v Tom Palmer (Scotland) Ltd* [1989] RPC 430.

⁸ *Badische Anilin und Soda Fabrik v Chemische Fabrik vormals Sandoz* (1903) 20 RPC 413, CA; on appeal (1904) 90 LT 733, 21 RPC 533, HL. The claimant must establish a 'good arguable case' ie a serious question which calls for a trial for its proper determination: *Unilever plc v Gillette (UK) Ltd* [1989] RPC 583 at 600, CA; *Mölnlycke AB v Procter & Gamble Ltd (No 4)* [1992] 4 All ER 47, [1992] RPC 21, CA. In the case of defendants in Scotland or Northern Ireland the question of forum conveniens will also be considered: *Lennon v Scottish Daily Record and Sunday Mail Ltd* [2004] EWHC 359 (QB), [2004] All ER (D) 34 (Mar); *Ivax Pharmaceuticals UK Ltd v Akzo Nobel NV* [2005] EWHC 2658 (Ch), [2006] FSR 888, [2005] All ER (D) 356 (Jul).

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NOTES 1-6--CPR Pt 6 substituted by SI 2008/2178.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/525. Claims against the Crown.

525. Claims against the Crown.

Subject to certain statutory restrictions¹, civil proceedings lie against the Crown for an infringement committed by a servant or agent of the Crown², with the authority of the Crown, of a patent³. Save as so provided, no proceedings lie against the Crown by virtue of the Crown Proceedings Act 1947 in respect of the infringement of a patent⁴. Infringement by the Crown is, however, unlikely in view of its wide powers to make use of patented inventions for the services of the Crown⁵.

¹ See subject to the provisions of the Crown Proceedings Act 1947: see **CROWN PROCEEDINGS AND CROWN PRACTICE** vol 12(1) (Reissue) PARA 115 et seq. Thus an injunction may not be granted against the Crown: see s 21(1) proviso (a); and **CROWN PROCEEDINGS AND CROWN PRACTICE** vol 12(1) (Reissue) PARA 134.

² As to the authority of agents generally see **AGENCY** vol 1 (2008) PARA 29 et seq.

³ Crown Proceedings Act 1947 s 3(1)(a) (substituted by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 4(1)). The Patents Act 1977 does not affect the Queen in her private capacity but, subject to that, it binds the Crown: s 129.

⁴ Crown Proceedings Act 1947 s 3(1) (substituted by the Copyright, Designs and Patents Act 1988 Sch 7 para 4(1)). Nothing in the Crown Proceedings Act 1947 s 3 is to be construed as affecting the rights of a government department under the Patents Act 1977 s 55 (see PARAS 405-406) or the rights of the Secretary of State under s 22 (see PARAS 335-336): Crown Proceedings Act 1947 s 3(2) (substituted by the Copyright, Designs and Patents Act 1988 Sch 7 para 4(1)). As to the Secretary of State see PARA 575.

⁵ See the Patents Act 1977 ss 55-59; and PARA 404 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/526. Advertising proceedings.

526. Advertising proceedings.

It is not a contempt of court¹ for a claimant to advertise that he has brought a claim or that he will prosecute infringers², although he should not state that success is certain or that the defendant has infringed³. Similarly, the defendant must not state that the invention is old⁴. The publication of fair reports of proceedings in the court is permissible⁵, but this may amount to contempt if the proceedings were collusive and another action is pending⁶. Statements about a pending action may amount to trade libel, if false and malicious⁷.

1 As to contempt of court see **CONTEMPT OF COURT** vol 9(1) (Reissue) PARA 401 et seq.

2 *Fenner v Wilson* [1893] 2 Ch 656, 10 RPC 283; *Dunlop Pneumatic Tyre Co Ltd v Clifton Rubber Co Ltd* (1902) 19 RPC 527; *Haskell Golf Ball Co v Hutchinson and Main* (1904) 20 TLR 606, 21 RPC 497; *Mullard Radio Valve Co Ltd v Rothermel Corpn Ltd* (1933) 51 RPC 1; but see *Fusee Vesta Co v Bryant and May Ltd* (1887) 4 RPC 191 (threats after application to amend). See also *St Mungo Manufacturing Co v Hutchinson, Main & Co Ltd* (1908) 25 RPC 356. Cf *Carl-Zeiss-Stiftung v Rayner and Keeler Ltd* [1960] 3 All ER 289, [1960] 1 WLR 1145, [1961] RPC 1 (trade mark).

3 *Goulard and Gibbs v Lindsay & Co Ltd and Ferranti* (1887) 4 RPC 189; *Fenner v Wilson* [1893] 2 Ch 656, 10 RPC 283; and see *Mullard Radio Valve Co Ltd v Rothermel Corpn Ltd* (1933) 51 RPC 1.

4 *Daw v Eley* (1865) LR 1 Eq 38; *British Vacuum Cleaner Co Ltd v Suction Cleaners Ltd* (1904) 21 RPC 303; *St Mungo Manufacturing Co v Hutchinson, Main & Co Ltd* (1908) 25 RPC 356.

5 Misrepresentation may be treated as contempt: *Edlin v Pneumatic Tyre Co* (1893) 10 RPC 317; *Gillette Safety Razor Co v AW Gamage Ltd* (1906) 24 RPC 1. See also *Therm-a-Stor Ltd v Weatherseal Windows Ltd* [1981] FSR 579 at 582, CA.

6 *Roberts v Graydon* (1904) 21 RPC 194.

7 *Mentmore Manufacturing Co Ltd v Fomento (Sterling Area) Ltd* (1954) 72 RPC 12; on appeal (1955) 72 RPC 157, CA. As to trade libel or slander of goods generally see **LIBEL AND SLANDER** vol 28 (Reissue) PARA 274 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/527. Pleadings.

527. Pleadings.

In a normal infringement action in the Patents Court, the statement of case¹, defence² and counterclaim, and reply and defence to counterclaim are substantially in common form. The facts peculiar to the particular claim are contained in particulars of infringement³, which must be contained in the statement of case⁴. The period for service of the defence is 42 days after service of the claim form⁵. Evidence is restricted to matters raised in these particulars, except by permission of the court⁶.

1 As to the statement of case see PARA 528.

2 As to the defence see PARA 530.

3 As to these particulars see PARA 529.

4 CPR 63.9(1).

5 CPR 63.6(a), 63.9(2).

6 See PARA 541.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/528. Statement of case.

528. Statement of case.

In a claim for infringement of a patent the statement of case must show which of the claims in the specification of the patent are alleged to be infringed and give at least one example of each type of infringement alleged¹. A copy of each document referred to in the statement of case, and where necessary a translation of the document, must be served with the statement of case².

Where the validity of a patent is challenged the statement of case must contain particulars of the relief sought and the issues except those relating to validity of the patent³. The statement of case must have a separate document annexed to it headed 'Grounds of Invalidity' specifying the grounds on which validity of the patent is challenged⁴. A copy of each document referred to in the Grounds of Invalidity, and where necessary a translation of the document, must be served with the Grounds of Invalidity⁵. The comptroller⁶ must be sent a copy of the Grounds of Invalidity and where any such Grounds of Invalidity are amended, a copy of the amended document, at the same time as the Grounds of Invalidity are served or amended⁷.

An allegation that the patent is valid is often included⁸. If the specification has been amended⁹, this may be stated and an allegation added that the original specification was framed in good faith and with reasonable skill and knowledge¹⁰. Where a certificate of contested validity¹¹ has been granted, the fact should be stated. Several patents may be sued on in one claim, provided that no inconvenience or oppression will arise from the plurality of issues¹².

1 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.1(1). As to these particulars see PARA 607; and as to allegations where directors are sued see *British Thomson-Houston Co Ltd v Irradiant Lamp Works Ltd* (1924) 41 RPC 338.

2 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.1(2).

3 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.2(1).

4 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.2(2). As to grounds of invalidity see PARA 430.

5 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.2(3).

6 As to the comptroller see PARA 577.

7 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.2(4).

8 It is, however, unnecessary: *Amory v Brown* (1869) LR 8 Eq 663. See also *Weber v Xetal Products Ltd* (1933) 50 RPC 211; *C Evans & Sons Ltd v Spritebrand Ltd* [1985] FSR 267, CA; *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197 at 238. *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 12 requires the claimant as early as possible to identify which claims are contended to have independent validity: see PARA 349.

9 As to the amendment of specifications see PARA 346 et seq.

10 See the Patents Act 1977 s 62(3); and PARA 549. See also PARA 521 note 1.

11 As to certificates of contested validity see PARA 551.

12 In *Saccharin Corpn Ltd v Wild* [1903] 1 Ch 410, 20 RPC 243, CA, 23 patents were sued on, but an order was made limiting the number to three. In *Saccharin Corpn Ltd v R White & Sons Ltd* (1903) 88 LT 850, 20 RPC 454, CA, the number permitted was seven.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/529. Particulars of infringement.

529. Particulars of infringement.

In a claim for infringement of a patent the statement of case must be served¹. General words are added reserving the right to claim damages for other similar breaches after disclosure². 'Type of infringement' includes not only the quality of the act complained of, that is to say whether it is manufacture, assembly, offer for sale, sale, process etc, but also the nature of the act, namely that it took place within the appropriate time and constituted an infringement of the monopoly³. In the case of sale, the names of the customers may be required⁴. In the case of manufacture, place and time should normally be given⁵. The claimant need not construe his specification or indicate how he will argue that the act complained of constitutes an infringement of his patent⁶.

1 See *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.1(1), (2); and PARA 528. See also *Building Product Design Ltd v Sandtoft Roof Tiles Ltd* [2004] FSR 823 (inquiry as to damages limited to sole type of infringement pleaded). The alleged infringement might be based solely on proposed amendments to the patent: *Zipher Ltd v Markem Systems Ltd* [2007] EWHC 154 (Pat), [2007] FSR 481.

2 As to the effect of such general allegation see *AG für Autogene Aluminium Schweissung v London Aluminium Co Ltd* [1919] 2 Ch 67, 36 RPC 199, CA.

3 *Salopian Engineers Ltd v Salop Trailer Co Ltd* (1954) 71 RPC 223. See also *Sorata Ltd v Gardex Ltd* [1984] RPC 317 at 322, CA (where a patentee was not allowed to amend its particulars of infringement by alleging infringement by an article, having a different construction to the article already in issue, on the ground that this was a new cause of action which was statute-barred under the Limitation Act 1980 s 35(3)).

4 *Murray v Clayton* (1872) LR 15 Eq 115. In the case of sales of mass-produced articles identified by type, such particulars are seldom given. As to particulars to be given when a company and its directors are sued together see *British Thomson-Houston Co Ltd v Irradiant Lamp Works Ltd* (1924) 41 RPC 338.

5 The governing consideration is that the defendant should know the case which he has to meet (*Z Electric Lamp Manufacturing Co Ltd v Marples, Leach & Co Ltd* (1909) 26 RPC 762, CA), and, therefore, certain of these details may be excused where this end can be attained otherwise, eg where the breach complained of is the manufacture of a specified article which is exhibited or otherwise identified, particulars of the date and place of manufacture might not be necessary. Greater particularity may be required where the defendant is only the user than where he is also the manufacturer: *Mandleberg v Morley* (1893) 10 RPC 256 at 260; cf *Mullard Radio Valve Co Ltd v Tungsum Electric Lamp Works (Great Britain) Ltd* (1932) 49 RPC 279. See also *Nolek Systems AB v Analytical Instruments Ltd* [1984] RPC 556; *Lubrizol Corp v Esso Petroleum Co Ltd (No 3)* [1993] FSR 59.

6 *Wenham Co Ltd v Champion Gas Lamp Co Ltd and Todlenhaupt & Co* (1890) 63 LT 827, 8 RPC 22; *Marsden v Albrecht and Albrecht* (1910) 27 RPC 785, CA; *Lux Traffic Controls Ltd v Staffordshire Public Works Co Ltd* [1991] RPC 73.

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530. Defence and admissions.

The defendant may by his defence¹:

- 297 (1) deny the claimant's title to the patent²;
- 298 (2) deny that he has infringed as alleged or at all³;
- 299 (3) plead leave and licence⁴;
- 300 (4) raise one or more objections to the validity of the patent⁵;
- 301 (5) assert that the action is somehow precluded by the EC Treaty and, in particular, plead 'exhaustion of rights'⁶ or that it offends against the EC Treaty⁷;
- 302 (6) allege that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed⁸;
- 303 (7) deny, where the specification has been amended, that the original specification was drawn in good faith and with reasonable skill and knowledge⁹.

These last two pleas relate only to claims for damages and an account of profits¹⁰, and do not affect the question of an injunction. In some cases the defendant may also rely on an estoppel¹¹. Where the defendant raises objections to validity, he may counterclaim for revocation¹², in which case the claimant must serve a defence to counterclaim¹³.

The defendant may make an admission of the claim or part of the claim in accordance with the standard procedure¹⁴.

1 In a claim for infringement, the period for service of the defence is 42 days after service of the claim form: CPR 63.6(a), 63.9(2). The claimant must file any reply to a defence and serve it on all other parties within 21 days of service of the defence: CPR 63.6(b). Apart from these two modifications, CPR Pt 15 applies to patent proceedings: CPR 63.6. As to CPR Pt 15 see **CIVIL PROCEDURE** vol 11 (2009) PARA 199 et seq.

2 The objection that the patent was granted to a person not entitled to it is a ground of invalidity: see the Patents Act 1977 s 72(1)(b), (2); and PARA 564.

3 The defendant may wish to raise the so-called 'Gillette' defence, namely that what he is doing differs from that which has been done of old only in non-patentable variations: *Gillette Safety Razor Co v Anglo-American Trading Co Ltd* (1913) 30 RPC 465 at 480, HL.

4 Where the licence relied on is that implied by purchase from the proprietor of the patent or his agent, the issue is raised by the plea of non-infringement (*Badische Anilin und Soda Fabrik v Dawson* (1889) 6 RPC 387; *Betts v Willmott* (1871) 6 Ch App 239, CA), but this does not apply where the purchase is from a licensee. A defendant who claims to have purchased from a licensee cannot compel the claimant to add the licensee as a defendant: *Evans v Central Electric Supply Co Ltd* (1923) 40 RPC 357. Where the alleged infringement is a breach of a limited licence (see PARA 385), the defendant may plead want of notice of the limiting conditions.

5 See the Patents Act 1977 s 74(1)(a); and PARA 520. The only grounds on which the validity of a patent may be put in issue are the grounds on which the patent may be revoked under s 72 (see PARAS 564-565): see s 74(3); and PARA 520.

6 Cf Case 15/74 *Centrafarm BV v Sterling Drug Inc* [1974] ECR 1147, [1974] 2 CMLR 480, ECJ.

7 It offends against the EC Treaty art 81 or art 82: *Phillips Electronics NV v Ingman Ltd (trading as Diskexpress)* [1999] FSR 112, [1998] All ER (D) 214; *Sandvik Aktiebolag v KR Pfiffner (UK) Ltd* [2000] FSR 17, [1999] All ER (D) 372; *Sandisk Corp v Koninklijke Philips Electronics* [2007] EWHC 332 (Ch), [2007] FSR 545, [2007] All ER (D) 357 (Feb); *Intel Corp (a company incorporated in the state of Delaware USA) v VIA Technologies Inc* [2002] EWCA Civ 1905, [2003] FSR 574, [2002] All ER (D) 346 (Dec).

8 See the Patents Act 1977 s 62(1); and PARA 549. See also PARA 521 note 1.

9 See the Patents Act 1977 s 62(3); and PARA 549. Particulars are required of the respects in which the specification is defective, but not of what it ought to have said: *Crompton v Anglo-American Brush Electric Light Corp* (1887) 35 ChD 283, 4 RPC 197, CA; *Z Electric Lamp Manufacturing Co Ltd v Marples, Leach & Co Ltd* (1910) 27 RPC 737, CA. See also *Unilin Beheer BV v Berry Floor NV* [2005] EWCA Civ 1292, [2006] FSR 495, [2005] All ER (D) 42 (Nov). The proprietor of the patent may be required to give particulars of the passages in the specification which he alleges contain sufficient directions: *Polaroid Corp v Eastman Kodak Co* [1977] RPC 379, CA.

10 See PARA 545.

11 See PARA 554.

12 See the Patents Act 1977 s 74(1)(a); and PARA 520.

13 *Coventry Radiator Co Ltd v Coventry Motor Fittings Co Ltd* (1917) 34 RPC 239. The defence to counterclaim usually consists of a mere traverse. It is common to include with the defence to counterclaim a reply in the action, consisting of a simple joinder of issue: *Cincinnati Grinders Inc v BSA Tools Ltd* (1930) 48 RPC 33 at 43, CA. A reply may also be necessary in special cases where there is no counterclaim.

14 In accordance with CPR Pt 14: see **CIVIL PROCEDURE** vol 11 (2009) PARA 187 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/531. Particulars of lack of novelty and obviousness.

531. Particulars of lack of novelty and obviousness.

No particulars are required of the respects in which the invention is alleged to be obvious or to lack novelty¹, but particulars are required of the prior publication and use relied upon². Where common general knowledge is relied upon, it is sufficient to say so³; but, where it is intended to suggest that some specific document or prior use forms part of common general knowledge, this should be stated⁴. Further, if it is proposed to give evidence of some knowledge or practice outside the trade or art to which the patent appertains, this should be stated⁵. If any party wishes to rely upon the commercial success of a patent in answer to a plea of lack of inventive step, he must in his pleading set out the grounds on which he relies⁶. Commercial success abroad may be relevant⁷.

1 *Morris and Bastert v Young* (1895) 12 RPC 455 at 460, HL.

2 See PARA 532.

3 *Holliday v Heppenstall Bros* (1889) 41 ChD 109, 6 RPC 320, CA.

4 *English and American Machinery Co Ltd v Union Boot and Shoe Machine Co Ltd* (1894) 11 RPC 367, CA. See also *Aluma Systems Inc v Hunnebeck GmbH* [1982] FSR 239 (discovery ordered of any specific documents relied upon). As to the meaning of 'common general knowledge' see PARAS 443, 457.

5 *Fox v Astrachans Ltd* (1910) 27 RPC 377 at 385. See also *British Thomson-Houston Co Ltd v Stonebridge Electrical Co Ltd* (1916) 33 RPC 166. In some of the older cases allegations of common general knowledge in a stated trade in a particular locality, eg London and Nottingham, were held sufficient: see *Jones v Berger* (1843) 1 Web Pat Cas 544; *Palmer v Wagstaffe* (1853) 22 LJ Ex 295; *Boyd v Horrocks* (1886) 3 RPC 285; but cf *Palmer v Cooper* (1853) 9 Exch 231 with *Palmer v Wagstaffe*. In *Fisher v Dewick* (1838) 1 Web Pat Cas 551n, *Holland v Fox* (1852) 1 WR 448, and *Morgan v Fuller (2)* (1866) LR 2 Eq 297, somewhat similar pleas were held too vague. Probably such a particular would be held sufficient if it made it clear that reliance was placed on general practice (within the specified limits) and not on individual practice.

6 The patentee must do more than merely cite sales figures of the particular products relied upon and must set out the defect, if there was one, in prior art products, how it was overcome and, if long felt want is to be established, the grounds on which the patentee relies: *John Deks Ltd v Aztec Washer Co* [1989] RPC 413.

7 *Unilever plc v Gillette (UK) Ltd* [1989] RPC 417.

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532. Particulars of lack of novelty, inventive step and of insufficiency.

Where the Grounds of Invalidity¹ include an allegation:

- 304 (1) that the invention is not a patentable invention because it is not new² or does not involve an inventive step³, the particulars must specify details of the matter in the state of art relied on⁴;
- 305 (2) that the specification of the patent does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art⁵, the particulars must state, if appropriate, which examples of the invention cannot be made to work and in which respects they do not work or do not work as described in the specification⁶.

1 See PARA 528.

2 As to lack of novelty see PARA 435 et seq.

3 As to want of inventive step see PARA 438 et seq. In any proceedings in which the validity of a patent is challenged: (1) on the ground that the invention did not involve an inventive step, a party who wishes to rely on the commercial success of the patent must state the grounds on which he so relies in his statement of case; and (2) the court may order inspection of machinery or apparatus where a party alleges such machinery or apparatus was used before the priority date of the claim: *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.5.

4 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.3(1). The details required are: (1) in the case of matter made available to the public by written description the date on which and the means by which it was so made available, unless this is clear from the face of the matter; and (2) in the case of matter made available to the public by use: (a) the date or dates of such use; (b) the name of all persons making such use; (c) any written material which identifies such use; (d) the existence and location of any apparatus employed in such use; and (e) all facts and matters relied on to establish that such matter was made available to the public: PD63 para 11.4. The place of the publication relied on, eg the library of the UK Intellectual Property Office, must normally be given, but in the case of a widespread publication, eg *The Times* or the *Encyclopaedia Britannica*, an allegation of general publication would probably suffice. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579. In the case of books and other lengthy documents the passages relied on should be identified (*Harris v Rothwell* (1886) 3 RPC 243 at 246; affd (1887) 35 ChD 416, CA); and it is convenient to do this also in the case of lengthy specifications, or where only a part of a specification is relied on, but in other cases the defendant may simply state that he relies on the whole of a specification (*Edison-Bell Consolidated Phonograph Co Ltd v Columbia Phonograph Co* (1900) 18 RPC 4). As to the degree of particularity in describing prior users see *Avery Ltd v Ashworth, Son & Co Ltd* (1916) 33 RPC 235. Particular dates may be omitted where the user is alleged to have been regular and to have extended over a long period: *British Thomson-Houston Co Ltd v Crompton-Parkinson Ltd* (1935) 52 RPC 409, CA. Drawings were ordered in *Crosthwaite Fire Bar Syndicate v Senior* [1909] 1 Ch 801, 26 RPC 260. 'Apparatus' does not include ore or other substance worked on: *Minerals Separation Ltd v Ore Concentration Co (1905) Ltd* [1909] 1 Ch 744, 26 RPC 413, CA (inspection of samples produced by the process refused). Where samples are produced, the defendant need not say how they anticipate the claimant's patent: *Brown v WC Yuille & Co* (1915) 32 RPC 137.

Where common general knowledge is relied upon, it is sufficient to say so (*Holliday v Heppenstall Bros* (1889) 41 ChD 109, 6 RPC 320, CA); but, where it is intended to suggest that some specific document or prior use forms part of common general knowledge, this should be stated (*English and American Machinery Co Ltd v Union Boot and Shoe Machine Co Ltd* (1894) 11 RPC 367, CA; *Aluma Systems Inc v Hunnebeck GmbH* [1982] FSR 239 (discovery ordered of any specific documents relied upon)). As to the meaning of 'common general knowledge' see PARAS 443, 457.

5 See PARA 490.

6 *Practice Direction--Patents and other Intellectual Property Claims* PD63 para 11.3(2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/533. Amendment and further particulars.

533. Amendment and further particulars.

At any stage of the proceedings the court may order a party to serve further or better particulars of objections¹ or allow a party to amend particulars already served². On an amendment of the particulars of objections, the proprietor of the patent may normally obtain the imposition of terms giving him leave to discontinue within a fixed period and providing that, if he elects to discontinue, the defendant or petitioner is to pay all costs incurred between the service of the previous and the newly amended particulars³ or, if such a special order has previously been made in the case, those incurred since the last such order⁴. In view of the implications relating to costs of such amendments, a defendant may be permitted to withdraw his application to amend his pleadings⁵.

1 See *Godfrey L Cabot Inc v Philblack Ltd (No 2)* [1961] RPC 53, CA.

2 Permission to amend may be given at the trial itself (*Blakey & Co v Latham & Co* (1888) 6 RPC 29 at 36 (on appeal (1889) 5 TLR 301, CA); *Badische Anilin und Soda Fabrik v Société Chimique des Usines du Rhône and Wilson* (1898) 14 RPC 875 at 881 (affd 15 RPC 359, CA)), but generally only where new matter has been recently discovered (*Moss v Malings* (1886) 33 ChD 603, 3 RPC 373 at 375; *Shrewsbury and Talbot Cab Co Ltd v Morgan* (1896) 13 RPC 75). In *Shoe Machinery Co Ltd v Cutlan* [1896] 1 Ch 108 at 115, 12 RPC 530 at 534, CA, leave was granted by the Court of Appeal after trial and while an appeal was pending but leave to amend to plead fresh prior art discovered pending appeal was refused in *Coflexip SA v Stolt Comex Seaway MS Ltd* [2001] 1 All ER 952, [2001] RPC 182, CA. Where a witness for the claimant disclosed an unpleaded prior user, the defendant was granted leave to amend without terms (*Franco-Strohmenger and Cowan Inc v Peter Robinson Ltd* (1930) 47 RPC 493 at 495); similarly where such a witness disclosed omission of essential directions from the specification (*Norton and Gregory Ltd v Jacobs* (1937) 54 RPC 58 at 68, 73).

3 These terms were first imposed in *Baird v Moules Patent Earth Closet Co* (1876) 17 ChD 139n, and are now almost invariably imposed (in the form laid down by *See v Scott-Paine* (1932) 50 RPC 56, which allows, as the original form did not, for the Part 20 claim for revocation). See *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 22, Standard Form of Order for Directions para 4(b). For discussion of circumstances in which a costs order should be made in the terms of *See v Scott-Paine* see *Re GEC Alsthom Ltd's Patent* [1996] FSR 415. The judge has absolute discretion, however, and leave to amend may be given unconditionally: *Pascall v Toope* (1890) 7 RPC 125; *Woolley v Broad* [1892] 2 QB 317, 9 RPC 429, CA; *Herbert William Wilson and Wilson Bros Bobbin Co Ltd v Wilson & Co (Barnsley) Ltd* (1899) 16 RPC 315, CA; *Williamson v Moldline Ltd* [1986] RPC 556, CA; *Ecolab Inc v Reddish Savilles Ltd* [1993] FSR 193; *Behr-Thomson Dehnstoffrengler Verwaltungs GmbH v Western Thomson Controls Ltd* [1990] RPC 569; *CQR Security Systems Ltd's Patent* [1992] FSR 303; *Re GEC Alsthom Ltd's Patent* [1996] FSR 415. The period usually allowed for election is six weeks. Under such an order the claimant may discontinue as to some claims only: *Benjamin Electric Ltd v Garnet, Whiteley & Co Ltd* (1930) 47 RPC 44.

4 It follows that such an order should not be asked for as a matter of routine: *Lever Bros and Unilever Ltd's Patent* (1953) 70 RPC 275; cf *Betts & Co Ltd v Ideal Capsules Ltd* (1950) 68 RPC 23. The purpose of such an order is not to give defendants or petitioners clearance from infringement proceedings if the patentee elects for revocation (*Aumac Ltd's Patent* [1995] FSR 501), but to ensure that the full attack on validity was put before the patentee at the earliest time (*Re GEC Alsthom Ltd's Patent* [1996] FSR 415 at 417).

5 *Helitune Ltd v Stewart Hughes Ltd* [1991] RPC 78. See also *Instance v Denny Bros Printing Ltd* [1994] FSR 396.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/534. Case management.

534. Case management.

As soon as practicable the court must hold a case management conference¹. Case management must be dealt with by a judge of the court or a master or district judge where a judge of the court so directs².

The claimant must apply for a case management conference within 14 days of the date when all defendants who intend to file and serve a defence have done so³. Where the claim has been transferred, the claimant must apply for a case management conference within 14 days of the date of the order transferring the claim, unless the court held or gave directions for a case management conference, when it made the order transferring the claim⁴. Any party may, at a time earlier than that provided above, apply in writing to the court to fix a case management conference⁵. If the claimant does not make an application as required, any other party may apply for a case management conference⁶. The court may fix a case management conference at any time on its own initiative⁷.

Not less than four days before a case management conference, each party must file and serve an application notice for any order which that party intends to seek at the case management conference⁸.

Unless the court orders otherwise, the claimant, or other party making the application, in consultation with the other parties, must prepare a case management bundle containing:

- 306 (1) the claim form;
- 307 (2) all statements of case (excluding schedules), except that, if a summary of a statement of case has been filed, the bundle should contain the summary, and not the full statement of case;
- 308 (3) a pre-trial timetable, if one has been agreed or ordered;
- 309 (4) the principal orders of the court; and
- 310 (5) any agreement in writing made by the parties as to disclosure,

and must provide copies of the case management bundle for the court and the other parties at least four days before the first case management conference or any earlier hearing at which the court may give case management directions⁹.

At the case management conference the court may direct that a scientific adviser be appointed¹⁰ and a document setting out basic undisputed technology should be prepared¹¹.

Where a trial date has not been fixed by the court, a party may apply for a trial date by filing a certificate which must:

- 311 (a) state the estimated length of the trial, agreed if possible by all parties;
- 312 (b) detail the time required for the judge to consider the documents¹²;
- 313 (c) identify the area of technology; and
- 314 (d) assess the complexity of the technical issues involved by indicating the complexity on a scale of one to five (with one being the least and five the most complex)¹³.

1 CPR 63.7(4). The case management procedure under CPR Pt 26 (see **CIVIL PROCEDURE** vol 11 (2009) PARA 260 et seq) does not apply and CPR Pt 29 (see **CIVIL PROCEDURE** vol 11 (2009) PARA 293 et seq) does not apply

apart from CPR 29.3(2) (legal representatives to attend case management conferences), CPR 29.4 (the court's approval of agreed proposals for the management of proceedings) and CPR 29.5 (variation of case management timetable) (with the exception of CPR 29.5(1)(b), (c)): CPR 63.7(2), (3). The provisions relating to case management conferences set out in *Practice Direction--The Multi-track* PD 29 para 5, excluding para 5.9 and modified so far as is made necessary and the provisions relating to failure to comply with case management directions in *Practice Direction--The Multi-track* PD 29 para 7 apply to patents cases (see **CIVIL PROCEDURE** vol 11 (2009) PARAS 295, 298): see *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.1.

2 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.2.

3 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.3. As to the defence see PARA 530.

4 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.4.

5 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.5.

6 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.6.

7 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.7.

8 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.8.

9 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.9. The claimant, in consultation with the other parties, must revise and update the documents referred to in PD 63 para 4.9 appropriately as the case proceeds; this must include making all necessary revisions and additions at least seven days before any subsequent hearing at which the court may give case management directions: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.12.

10 *le* under the Supreme Court Act 1981 s 70(3): see **CIVIL PROCEDURE** vol 12 (2009) PARA 1133. CPR 35.15 (see **CIVIL PROCEDURE** vol 11 (2009) PARA 863) applies to scientific advisers: see *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.10.

11 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.10.

12 As to the status of documents pre-read by the judge prior to a hearing which in the event was not contested see *SmithKline Beecham Biologics SA v Connaught Laboratories Inc* [1999] 4 All ER 498, [2000] FSR 1.

13 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.11.

UPDATE

534 Case management

NOTE 10--Supreme Court Act 1981 now cited as Senior Courts Act 1981: Constitutional Reform Act 2005 Sch 11 para 1 (in force 1 October 2009: SI 2009/1604).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/535. Disclosure and inspection.

535. Disclosure and inspection.

The general rules relating to disclosure and inspection of documents¹ apply to patents claims with certain modifications².

Standard disclosure³ does not require the disclosure of documents where the documents relate to:

- 315 (1) the infringement of a patent by a product or process if, before or at the same time as serving a list of documents, the defendant has served on the claimant and any other party full particulars of the product or process alleged to infringe and drawings or other illustrations, if necessary⁴;
- 316 (2) any ground on which the validity of a patent is put in issue, except documents which came into existence within the period beginning two years before the earliest claimed priority date⁵ and ending two years after that date⁶; and
- 317 (3) the issue of commercial success⁷.

Where the issue of commercial success arises and the commercial success relates to an article or product, the patentee must, within such time limit as the court may direct, serve a schedule containing:

- 318 (a) an identification of the article or product (for example by product code number) which the patentee asserts has been made in accordance with the claims of the patent⁸;
- 319 (b) a summary by convenient periods of sales of any such article or product⁹;
- 320 (c) a summary for the equivalent periods of sales, if any, of any equivalent prior article or product marketed before the article or product in head (a)¹⁰; and
- 321 (d) a summary by convenient periods of any expenditure on advertising and promotion which supported the marketing of the articles or products in heads (a) and (c)¹¹.

Where the commercial success relates to the use of a process a schedule must be served containing:

- 322 (i) an identification of the process which the patentee asserts has been used in accordance with the claims of the patent¹²;
- 323 (ii) a summary by convenient periods of the revenue received from the use of such process¹³;
- 324 (iii) a summary for the equivalent periods of the revenues, if any, received from the use of any equivalent prior art process¹⁴; and
- 325 (iv) a summary by convenient periods of any expenditure which supported the use of the process in heads (i) and (iii)¹⁵.

Disclosure in patent actions is limited to the issues raised by the particulars¹⁶. Documents are relevant if they may fairly lead to a train of inquiry which would help to establish the case of the party seeking disclosure¹⁷. Where there is an inquiry as to damages or an account of profits is ordered¹⁸, the defendants are not entitled to seal up the parts of their books containing the

names of their customers¹⁹. In a proper case the court may order an innocent third person or an alleged tortfeasor to disclose information about infringement by others²⁰.

The court may allow disclosure even though it is alleged that, if given, a secret process²¹ will be divulged, but in the exercise of its discretion it will, so far as possible, limit the order in such a way that the secret process is not compelled to be disclosed²². Disclosure has been ordered of the experimental work leading up to the making of the invention where an allegation of obviousness had been made²³.

1 le CPR Pt 31: see **CIVIL PROCEDURE** vol 11 (2009) PARA 538 et seq.

2 CPR 63.8. See *Nichia Corp v Argos Ltd* [2007] EWCA Civ 741, [2007] FSR 895 (it would be against the interests of justice if documents known to exist, or easily revealed, which would harm a party's own case or assist another party's case need not be disclosed because of a blanket prima facie rule against any standard disclosure in patent actions; standard disclosure should be carried out properly but the search should be tailor-made to the case).

3 See CPR Pt 31; and **CIVIL PROCEDURE** vol 11 (2009) PARA 542.

4 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.1(1). As to the adequacy of such process descriptions see *Taylor v Ishida (Europe) Ltd* [1999] All ER (D) 948, [2000] FSR 224; affd [2001] EWCA Civ 1092, [2001] All ER (D) 147 (Jul).

5 As to the priority date see PARA 311 note 6.

6 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.1(2).

7 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.1(3).

8 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(1)(a).

9 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(1)(b).

10 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(1)(c).

11 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(1)(d).

12 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(2)(a).

13 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(2)(b).

14 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(2)(c).

15 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 5.2(2)(d).

16 *Avery Ltd v Ashworth, Son & Co Ltd* (1915) 32 RPC 560, CA; on appeal (1916) 33 RPC 235, HL. Neither party is bound to disclose documents unless they relate to the matters particularised: *Avery Ltd v Ashworth, Son & Co Ltd*. However, in appropriate circumstances the court may allow disclosure even though the mandatory requirements relating to the relevant particulars have not been complied with: *Visx Inc v Nidex Co* [1999] FSR 91; *Dendron GmbH v University of California* [2004] EWHC 1163 (Ch), [2004] FSR 475, [2004] All ER (D) 274 (May). If omitted particulars are within the knowledge of the other party it is generally proper to delay further particularisation until after disclosure: *Visx Inc v Nidex Co*. But a genuine case must be pleaded in sufficient detail to limit the area of disclosure and fishing amendments to pleadings are not permissible: *Visx Inc v Nidex Co*. Documents relating to an amendment of a patent or pleadings, affidavits or documents in another action need not be disclosed (*Avery Ltd v Ashworth, Son & Co Ltd*; *Intalite International NV v Cellular Ceilings Ltd* [1987] RPC 532), but documents relating to the same issues in former actions must be disclosed subject to the ordinary rules of privilege (*Haslam & Co Ltd v Hall* (1887) 5 RPC 1 (on appeal (1888) 20 QBD 491, 5 RPC 144, CA); *Bown v Sansom, Teale & Co* (1888) 5 RPC 510, CA; *Edison and Swan United Electric Light Co v Holland* (1888) 5 RPC 213, CA; *Thomson v Hughes* (1889) 7 RPC 187, CA). A general allegation of further breaches gives no right to extended disclosure: *Akt für Autogene Aluminium Schweissung v London Aluminium Co Ltd* [1919] 2 Ch 67 at 74, 36 RPC 199 at 207, CA. There may be some relaxation of these rules where the defendant alleges prior user by the claimant himself, in which case disclosure may be allowed before particulars are given: *Woolfe v Automatic Picture Gallery Ltd* (1901) 19 RPC 161, CA; *Re Martin's Patents* [1936] 1 All ER 711; *Visx Inc v Nidex Co* [1999] FSR 91. Disclosure will not be ordered where the allegation is lack of fair basis because this is entirely a matter of construction for the court: *Schering Agrochemicals Ltd v ABM Chemicals Ltd* [1987] RPC 185. If the defendant intends to rely on specific documents in support of an attack of lack of inventive step based on

common general knowledge, he will be ordered to give disclosure of them: *Aluma Systems Inc v Hunnebeck GmbH* [1982] FSR 239.

17 *Compania Uruguaya de Fomento Industrial SA, Biro Swan Ltd v Mentmore Manufacturing Co Ltd* (1955) 72 RPC 287 at 302; affd [1956] RPC 87, CA. As to disclosure from non-parties see *American Home Products Corp v Novartis Pharmaceuticals UK Ltd* [2001] EWCA Civ 165, [2001] RPC 159, [2001] FSR 784.

18 For inquiries as to damages and accounts of profits see PARA 545.

19 *Murray v Clayton* (1872) LR 15 Eq 115; *American Braided Wire Co v Thompson & Co* (1888) 5 RPC 375; *Saccharin Corp Ltd v Chemicals and Drugs Co Ltd* [1900] 2 Ch 556, 17 RPC 612, CA. In such cases, where the court is dealing with a wrongdoer, the defendant will not be excused from giving full disclosure merely because of the consequences which may flow from that disclosure necessitated by his own wrongful act: *Murray v Clayton*, approved in *Saccharin Corp Ltd v Chemicals and Drugs Co Ltd*.

20 *Norwich Pharmacal Co v Customs and Excise Comrs* [1974] RPC 101, HL; *Smith Kline and French Laboratories Ltd v Global Pharmaceuticals Ltd* [1986] RPC 394, CA.

21 As to inspection of processes alleged to be secret see PARA 536.

22 See *Warner-Lambert Co v Glaxo Laboratories Ltd* [1975] RPC 354, CA; *Roussel Uclaf v Imperial Chemical Industries plc* [1990] RPC 45 at 53, CA. As to the status of documents treated by the parties as confidential see *Lilly Inc v Pfizer Ltd* [2002] EWCA Civ 02, [2002] 1 All ER 842, [2002] FSR 809.

23 *Halcon International Inc v Shell Transport and Trading Co Ltd (Discovery No 2)* [1979] RPC 459; *SKM SA v Wagner Spraytech (UK) Ltd* [1982] RPC 497, CA; *Mölnlycke AB v Procter & Gamble Ltd (No 3)* [1990] RPC 498. Such disclosure should, however, be proportionate: *Nichia Corp v Argos Ltd* [2007] EWCA Civ 741, [2007] FSR 895.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/536. Inspection.

536. Inspection.

The court has power to order inspection at the instance of either party¹, but it is careful to prevent such inspection being used as a means of discovering trade secrets. Where it appears that inspection by a claimant of an alleged infringing process will reveal such secrets, the order for inspection is made only where the claimant makes out a prima facie case of infringement, or where it appears that a real issue as to infringement can best be settled by inspection²; and in a proper case the inspection will be confined to experts and counsel, who will be pledged to secrecy as to any matters the disclosure of which is not necessary for the purposes of the case³. The court may appoint an independent expert to make the inspection. Where there is no question of trade secrets, inspection is freely granted⁴.

Particulars of prior use must specify where any machinery or apparatus in relation to such use can be inspected and evidence as to any such machinery or apparatus is inadmissible unless inspection of it has been offered or the defendant has used his best endeavour to obtain inspection of it for other parties⁵.

1 The court may order the defendant to work his machinery for the purpose of inspection: *Germ Milling Co Ltd v Robinson* (1883) 1 RPC 11; *British Xylonite Co Ltd v Fibrenyle Ltd* [1959] RPC 252, CA, followed in *Unilever plc v Pearce* [1985] FSR 475. In many other cases such an order has been made by consent. In *Germ Milling Co Ltd v Robinson* an order was made for inspection on the premises of licensees of the claimant, but such an order does not compel a person not a party to the proceedings to permit inspection (see *Rylands v Ashley's Patent (Machine Made) Bottle Co* (1890) 7 RPC 175) and such inspection may be given by consent (see *Niche Generics v H Lundbeck A/S* [2003] EWHC 2590 (Pat), [2004] FSR 392). Orders may also be made enabling a party to take samples (see the Supreme Court Act 1981 s 33; CPR r 25.5; and **CIVIL PROCEDURE** vol 11 (2009) PARAS 114, 323), even samples to be tested to destruction (*Patent Type Founding Co v Walter* (1860) 8 WR 353). The court may give inspection of samples in its possession to parties in another action: *Smith v Lang* (1887) 7 RPC 148 at 150, CA. The court will not grant an order for inspection if the claimant's assertions as to infringement are speculative: *Wahl and Simon-Solitec Ltd v Buhler-Miag (England) Ltd* [1979] FSR 183.

2 *British Xylonite Co Ltd v Fibrenyle Ltd* [1959] RPC 252, CA and *Unilever plc v Pearce* [1985] FSR 475, where the earlier authorities are discussed.

3 For the terms of orders of this kind see *British Thomson-Houston Co Ltd v Duram Ltd (No 2)* (1920) 37 RPC 121; *Helps v Oldham Corpn* (1923) 40 RPC 68; *Sorbo Rubber Sponge Products Ltd v Defries* (1930) 47 RPC 454; *British Celanese Ltd v Courtaulds Ltd* (1933) 50 RPC 63 at 80 (on appeal 50 RPC 259, CA, (1935) 152 LT 537, 52 RPC 171, HL); *British Xylonite Co Ltd v Fibrenyle Ltd* [1959] RPC 90 (on appeal [1959] RPC 252, CA); *Warner-Lambert Co v Glaxo Laboratories Ltd* [1975] RPC 354, CA. The evidence as to the inspection may be taken in camera: *Badische Anilin und Soda Fabrik v Levinstein* (1885) 29 ChD 366, 2 RPC 73, CA.

4 The order may be made at any time. Thus in *Edler v Victoria Press Manufacturing Co* (1910) 27 RPC 114 and *Unilever plc v Pearce* [1985] FSR 475, inspection was ordered before the delivery of the statement of claim in order to allow the plaintiff to give proper particulars of breaches, whilst in *Badische Anilin und Soda Fabrik v Levinstein* (1885) 29 ChD 366, 2 RPC 73, CA and *McDougall Bros v Partington* (1890) 7 RPC 351, inspection was deferred until after the trial of a preliminary issue.

5 See *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 11.5(2).

UPDATE

536 Inspection

NOTE 1--Supreme Court Act 1981 now cited as Senior Courts Act 1981: Constitutional Reform Act 2005 Sch 11 para 1 (in force 1 October 2009: SI 2009/1604).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/537. Experiments, models and apparatus.

537. Experiments, models and apparatus.

Where a party seeks to establish any fact by experimental proof conducted for the purpose of litigation, he must at least 21 days before service of the application notice for directions¹ or within such other time as the court may direct, serve on all parties a notice stating the facts which he seeks to establish and giving full particulars² of the experiments proposed to establish them³. A party upon whom a notice is so served must within 21 days after such service, serve on the other party a notice stating whether or not he admits each fact⁴. He may request the opportunity to inspect a repetition of all or a number of the experiments identified in the notice⁵. Where any fact which a party seeks to establish by experimental proof is not admitted, he must apply to the court for permission and directions by application notice⁶.

Where a party intends to rely on any model or apparatus, he must apply to the court for directions at the first case management conference⁷.

¹ See under *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 9.3: see the text to note 6.

² Such particulars may have to include the numerical data generated as a result of carrying out the experiments: *Société Française Hoechst v Allied Colloids Ltd* [1991] RPC 245.

³ *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 9.1. As to matters relating to repeat experiments, failure to give notice as to the experiments to be relied on in proceedings, and the effect of failure to disclose experiments, see *Electrolux Northern Ltd v Black & Decker* [1996] FSR 595. However, 'litigation chemistry' should be avoided: *SmithKline Beecham plc's Patent (No 2)* [2003] RPC 607; *SmithKline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568, [2005] FSR 524; *Mayne Pharma Pty Ltd v Debiopharm SA* [2006] EWHC 164 (Pat), [2006] FSR 656, [2006] All ER (D) 137 (Feb).

⁴ *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 9.2(1).

⁵ *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 9.2(2).

⁶ *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 9.3.

⁷ *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 10.1. As to case management see PARA 534. As to the use of the streamlined procedure see *Research in Motion UK Ltd v Inpro Licensing SARL* [2007] EWCA Civ 51 at [4], [2007] All ER (D) 88 (Feb) at [4] per Jacob LJ. See also *Canady v Erbe Elektromedizin GMBH* [2005] EWHC 2946 (Pat), [2005] All ER (D) 327 (Dec), [2006] FSR 150, where the streamlined procedure was used for the infringement issue.

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538. Interim injunctions.

Infringement of a patent may be restrained by interim injunction¹ if the claimant can establish that he has an arguable case on the issues in the proceedings, normally validity and infringement, and that, if the injunction is refused, he will not be adequately compensated by an award of damages at the full trial². If the defendant can establish that, if the injunction is granted and the claimant loses at the full trial, then he will not be adequately compensated by an award of damages, the court must then consider the balance of convenience³. In considering the balance of convenience, the court weighs the relative harm which will be caused to each party by the grant or refusal of the injunction and considers all facts put before it which suggest that one party or the other will be prejudiced. Relevant considerations include whether a party will be good for costs and damages⁴, whether the patent is close to expiry so that the defendant is obtaining an unfair start over other competitors by infringing⁵, whether one party is a manufacturer with an established business and the other is an importer⁶, whether the grant of an injunction would deprive the public of a life-saving drug as distinct from a mere alternative medicine⁷, whether the research investment of the proprietor of the patent for future projects would be jeopardised by the loss of revenue caused by the defendant's sales⁸, whether the defendant started infringing with his eyes open⁹, whether the defendant could have cleared the way by seeking revocation or a declaration of non-infringement¹⁰ and whether the claimant delayed in seeking relief or acted promptly¹¹. The claimant's fear that, unless the defendant is stopped by an injunction, others will be encouraged to infringe is not always a relevant consideration¹². The fact that amendment proceedings are pending does not preclude the grant of an interim injunction¹³.

A very common practice is for the defendant to undertake to keep an account until the trial of the action¹⁴. If an injunction is granted, the claimant must give a cross-undertaking as to any damages the defendant may suffer should it be held that there was no ground for granting it¹⁵.

In a proper case an injunction may be granted without notice¹⁶ and, where the claimant can establish that the defendant is likely to hide or destroy the evidence of infringement if notice were given, the court may grant an order without notice for inspection and removal of documents and infringing goods into the custody of the claimant's solicitor pending trial¹⁷.

An interim injunction should not be granted to interfere with passage of a foreign aircraft over or through the United Kingdom¹⁸.

1 As to interim injunctions generally see **CIVIL PROCEDURE** vol 11 (2009) PARAS 316, 383 et seq. In the case of certain infringements by civil aircraft covered by the Convention on International Civil Aviation (the 'Chicago Convention') (Chicago, 7 December 1944; TS 8 (1953); Cmd 8742) (see **AIR LAW** vol 2 (2008) PARA 2 et seq), such an injunction must not interfere with the aircraft: see PARA 515. As to detention on infringement by other civil aircraft see PARA 515 note 10.

2 A proprietor of a patent who grants licences but does not himself manufacture is unlikely to be able to establish that damages would not be an adequate remedy: see eg *Fleming Fabrications Ltd v Albion Cylinders Ltd* [1989] RPC 47, CA.

3 *American Cyanamid Co v Ethicon Ltd* [1975] AC 396, [1975] 1 All ER 504, [1975] RPC 513, HL. An injunction is likely to be granted if the defendant fails, on motion, to establish the elements of an arguable defence: *Quantel Ltd v Electronic Graphics Ltd* [1990] RPC 272.

4 *Belfast Ropework Co Ltd v Pixdane Ltd* [1976] FSR 337 at 341-343, CA. The fact that a claimant would not be able to meet any liability on the cross-undertaking in damages is not the end of the matter; the court must

adopt the course least likely to lead to ultimate injustice: *Fleming Fabrications Ltd v Albion Cylinders Ltd* [1989] RPC 47, CA.

5 *Corruplast Ltd v George Harrison (Agencies) Ltd* [1978] RPC 761, CA.

6 *Netlon Ltd v Bridport-Gundry Ltd* [1979] FSR 530, CA.

7 *Beecham Group Ltd v Bristol Laboratories Ltd* [1967] RPC 406, CA.

8 *Netlon Ltd v Bridport-Gundry Ltd* [1979] FSR 530, CA.

9 *Belfast Ropework Co Ltd v Pixdane Ltd* [1976] FSR 337, CA; *Improver Corpn v Remington Consumer Products Ltd* [1989] RPC 69, CA.

10 *SmithKline Beecham plc v Apotex Europe Ltd* [2004] EWCA Civ 1568, [2005] FSR 524.

11 See **CIVIL PROCEDURE** vol 11 (2009) PARA 374. Delay is generally reckoned from the time the claimant became aware of the actual infringement: *Osmond v Hirst* (1885) 2 RPC 265; *United Telephone Co v Equitable Telephone Association* (1888) 5 RPC 233. Laches as to one infringer may be no ground for refusing relief against another: *Pneumatic Tyre Co Ltd v Warrilow* (1896) 13 RPC 284; *Netlon Ltd v Bridport-Gundry Ltd* [1979] FSR 530, CA. Where there are several alleged infringers, the proper course is for the claimant to proceed promptly against one and ask the others to agree that the decision in the one action be accepted by them as binding: *Bovill v Crate* (1865) LR 1 Eq 388; and see *North British Rubber Co Ltd v Gormully and Jeffery Manufacturing Co* (1894) 12 RPC 17; *Act für Cartonagen Industrie v Temler* (1899) 16 RPC 447.

12 *Conder International Ltd v Hibbing* [1984] FSR 312, CA.

13 *SmithKline Beecham plc v Apotex Europe Ltd* [2005] FSR 524.

14 Terms as to the payment of profits etc into court are sometimes imposed: see *North British Rubber Co Ltd v Gormully and Jeffery Manufacturing Co* (1894) 12 RPC 17 at 21; *Pneumatic Tyre Co Ltd v Goodman & Son* (1896) 13 RPC 723; *Coco v AN Clark (Engineers) Ltd* [1969] RPC 41 (trade secrets); *Vernons & Co (Pulp Products) Ltd v Universal Pulp Containers Ltd* [1980] FSR 179 (trade secrets; copyright); *Brupat Ltd v Sandford Marine Products Ltd* [1983] RPC 61, CA (patent). In *Quantel Ltd v Shima Seiki Europe Ltd* [1990] RPC 436 an injunction was refused upon the defendant's providing a bank guarantee of £2 million, but the circumstances were unusual.

15 This is also required where the defendant undertakes not to infringe. Such an undertaking is automatically implied where it has not been expressly given. See also note 4. For a case of an inquiry as to such damages see *Smithkline Beecham plc v Apotex Europe Ltd* [2006] EWCA Civ 658, [2007] Ch 71, [2006] 4 All ER 1078, where the question of affected third parties is also considered. As to undertakings as to damages generally see **CIVIL PROCEDURE** vol 11 (2009) PARA 419 et seq.

16 The injunction in such a case will be limited to a short time, such as a week, so that the matter may then be heard inter partes.

17 *Anton Piller KG v Manufacturing Processes Ltd* [1976] Ch 55, [1976] 1 All ER 779, [1976] RPC 719, CA. Such relief is rare in patent cases, but is more frequently given in cases of copyright and trade mark infringements.

18 Nearly all such aircraft are absolutely protected by the Civil Aviation Act 1982 s 89. For those that are not, s 89(5), Sch 12 authorises 'seizure' of the aircraft only until security is given: see PARA 515 note 10.

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539. Summary judgment and trial of preliminary issues.

Where a pure point of law is involved or the facts are not materially in dispute, a party is entitled to summary judgment on the claim or relevant issue¹. However, it is generally difficult to identify and establish such clear cut issues in a patent action even though they might at first sight appear straightforward². In particular, the construction of a claim³ requires the court to adopt the mantle of the skilled addressee which requires the aid of expert evidence⁴, and infringement often involves consideration of a purposive construction and whether any variant falls within the scope of the claim⁵.

The court will sometimes order the trial of preliminary issues⁶, but generally only in respect of issues relating to the right to sue⁷. It seldom permits the issues of validity and infringement to be separated but may do so in appropriate cases⁸.

Applications to the court for leave to amend the patent in suit have often been tried separately before the hearing of the main proceedings⁹.

1 See CPR Pt 24; and **CIVIL PROCEDURE** vol 11 (2009) PARA 524. See also *Anchor Building Products Ltd v Redland Roof Tiles Ltd* [1990] RPC 283, CA (no arguable case of infringement); *Dendron GmbH v University of California (No 3)* [2004] EWHC 1163 (Ch), [2004] FSR 861 (whether claimant an exclusive licensee).

2 *Strix Ltd v Otter Controls Ltd* [1991] FSR 354, CA (construction of claim and infringement); *Southco Inc v Dzus Fastener Europe Ltd* [1989] RPC 82 (construction of claim and infringement); *Monsanto & Co v Merck & Co Inc* [2000] RPC 77, CA (construction of claim).

3 As to the construction of claims see PARA 415.

4 *Southco Inc v Dzus Fastener Europe Ltd* [1989] RPC 82; *Monsanto & Co v Merck & Co Inc* [2000] RPC 77, CA.

5 *Strix Ltd v Otter Controls Ltd* [1991] FSR 354, CA. As to variants see PARA 415; and *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183, HL; *Improver Ltd v Remington Consumer Products Ltd* [1989] RPC 69, CA.

6 See PARA 534.

7 Eg whether the claimant's patent had been validly amended (*Woolfe v Automatic Picture Gallery Ltd* (1902) 19 RPC 425; affd [1903] 1 Ch 18, 20 RPC 177, CA); whether the terms of settlement in a former action debarred the claimant from suing (*Murex Welding Processes Ltd v Weldrics (1922) Ltd* (1933) 50 RPC 178); whether the defendant could avail himself of the defence that the claimant has inserted illegal restrictions in a contract with a third person (*Sarason v Fréney* [1914] 2 Ch 474, 31 RPC 252, 330, CA); whether the defendant enjoyed 'third party rights' (*AB Astra v Pharmaceutical Manufacturing Co* (1952) 69 RPC 252, CA); whether an undertaking unlimited in time was void as in unreasonable restraint of trade (*Bescot (Electrics) Ltd v Merlin Mouldings Ltd* (1952) 69 RPC 159); and whether the claimant held the patent in trust for the defendant (*Toogood and Jones Ltd v Soccerette Ltd* [1959] RPC 265). Cf *Dendron GmbH v University of California (No 3)* [2004] EWHC 1163 (Ch), [2004] FSR 861 (whether claimant an exclusive licensee). Preliminary trial has, however, been ordered of the issue whether the alleged infringing process was in use before the date of the patent: *Field v Daily Telegraph Ltd* (1950) 67 RPC 105, CA.

8 See *Canady v Erbe Elektromedizin GMBH* [2005] EWHC 2946 (Pat), [2006] FSR 150, [2005] All ER (D) 327 (Dec).

9 See PARA 347.

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540. Burden of proof.

The burden of proving title¹ and infringement² lies on the claimant. Probably the onus on all objections to validity lies on the defendant³, but it is the practice for the claimant to lead evidence to establish validity, where appropriate⁴; and it has been usual to give formal evidence as to validity even if the defendant does not appear at the trial⁵. The onus on issues relating to prior user and publication lies on the defendant⁶. If the invention for which a patent has been granted is a process for obtaining a new product, the defendant must show that he obtained the product by a different process⁷. Where only validity is in issue in an infringement action, it is more appropriate for the defendant to open its case and call its witnesses first⁸.

1 This is normally proved from the register, which is prima facie evidence of anything required or authorised to be registered: see the Patents Act 1977 s 32(9); and PARA 590.

2 If the point may be disputed, the claimant should give evidence that the articles complained of were not manufactured by him or his licensee: *Betts v Willmott* (1871) 6 Ch App 239, CA; and see PARA 385. The onus as to infringement may change during the course of the case: *Z Electric Lamp Manufacturing Co Ltd v Marples, Leach & Co Ltd* (1910) 27 RPC 737, CA. Where the claimant relies on statements by the defendant, they must be such as to negative the possibility of non-infringement: *Winby v Manchester etc Steam Tramways Co* (1889) 7 RPC 30, CA; *Wilson Bros Bobbin Co Ltd v Wilson & Co (Barnsley) Ltd* (1903) 20 RPC 1, HL. In *Parkinson v Simon* (1894) 11 RPC 238; affd 11 RPC 493, CA; (1895) 12 RPC 403, HL, it was held that, because the defendants called a part a 'deflector', it did not follow that it was a 'deflector' within the meaning of the specification.

3 See the Patents Act 1977 s 72; and PARA 564.

4 *Vidal Dyes Syndicate Ltd v Levinstein Ltd* (1912) 29 RPC 245 at 254, CA.

5 *Weber v Xetal Products Ltd* (1933) 50 RPC 211.

6 Rebutting evidence may be called on the issue of prior user: *Boyd v Horrocks* (1888) 5 RPC 557; affd (1892) 9 RPC 77, HL. Thus, where a description in a classical work was relied on as an anticipation, the claimant was allowed to read a passage from Ovid to show the true nature of the article there referred to: *Benno Jaffé and Darmstaedter Lanolin Fabrik v John Richardson & Co (Leicester) Ltd* (1894) 10 TLR 398, 11 RPC 261, CA. As to the burden of proof on issues of infringement and prior user generally see *Douglas Packing Co Inc, Douglas Pectin Corp and Postum Co Inc v Evans & Co (Hereford and Devon) Ltd* (1929) 46 RPC 493, CA. As to the burden of proof where prior use by the patentee is alleged see *Memcor Australia Pty Ltd v Norit Membraan Technologie BV* [2003] FSR 779 at 792; *Cameron Balloons Ltd v Kavanagh Balloons Propriety Ltd* [2003] EWCA Civ 1952, [2004] RPC 87, [2003] All ER (D) 212 (Dec).

7 See the Patents Act 1977 s 100(1). In considering whether a party has discharged the burden imposed upon him by s 100, the court may not require him to disclose any manufacturing or commercial secret if it appears to the court that it would be unreasonable to do so: s 100(2). As to the meaning of 'court' see PARA 637 note 1.

8 *Boehringer Mannheim GmbH v Genzyme Ltd* [1993] FSR 716.

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541. Admissibility of evidence.

Whether validity is attacked or not, evidence of the state of common general knowledge, and of the meaning of technical terms, is always admissible for the purpose of enabling the court to construe the specification¹, but for this purpose the evidence must be strictly confined to what the skilled addressee² might be presumed to have known at the date of filing³, and does not authorise a reference to patent specifications or little known scientific journals⁴, unless they form part of the addressee's common general knowledge⁵.

Oral evidence given for the claimant in a former action cannot be used against him in an action against another defendant⁶, but the court will take note of the way the case was put in a previous action on the same patent⁷. It would seem that the court may allow production of the UK Intellectual Property Office file relating to an unpublished patent application if the interests of justice require it⁸, notwithstanding that such files are not open to public inspection⁹. Where the claimant relies on intention to infringe as a threat entitling him to an injunction, evidence of the defendant's acts after action brought may be relevant¹⁰.

Judicial notice must be taken of:

- 326 (1) the European Patent Convention¹¹, the Community Patent Convention¹² and the Patent Co-operation Treaty¹³ (each of which is referred to as the 'relevant convention')¹⁴;
- 327 (2) any bulletin, journal or gazette published under the relevant convention and the register of European patents kept under the European Patent Convention¹⁵; and
- 328 (3) any decision of, or expression of opinion by, the relevant convention court¹⁶ on any question arising under or in connection with the relevant convention¹⁷.

Any document mentioned in head (2) above is admissible as evidence of any instrument or other act thereby communicated of any convention institution¹⁸.

Evidence of any instrument issued under the relevant convention by any convention institution, including any judgment or order of the relevant convention court, or of any document in the custody of any such institution or reproducing in legible form any information in such custody otherwise than in legible form, or any entry in or extract from such a document, may be given in any legal proceedings¹⁹ by production of a copy certified as a true copy by an official of that institution; and any document purporting to be such a copy must be received in evidence without proof of the official position or handwriting of the person signing the certificate²⁰. Evidence of any such instrument may also be given in any legal proceedings:

- 329 (a) by production of a copy purporting to be printed by the Queen's Printer²¹;
- 330 (b) where the instrument is in the custody of a government department, by production of a copy certified on behalf of the department to be a true copy by an officer of the department generally or specially authorised to do so²²,

and any document purporting to be such a copy as is mentioned in head (b) above of an instrument in the custody of a department must be received in evidence without proof of the official position or handwriting of the person signing the certificate, or of his authority to do so, or of the document being in the custody of the department²³.

Provision is also made for evidence to be obtained in the United Kingdom for proceedings under the European Patent Convention²⁴.

1 As to construction of the specification see PARA 412 et seq.

2 As to the skilled addressee see PARA 442.

3 As to the meaning of 'date of filing' see PARA 316.

4 *Adie v Clark* (1876) 3 ChD 134, CA (on appeal sub nom *Clark v Adie (No 2)* (1877) 2 App Cas 423, HL); *Jandus Arc Lamp and Electric Light Co v Johnson* (1900) 17 RPC 361; *Roberts v Graydon* (1904) 21 RPC 194; *British Vacuum Co Ltd v Exton Hotels Co Ltd* (1908) 25 RPC 617; *British Ore Concentration Syndicate Ltd v Minerals Separation Ltd* (1908) 26 RPC 124 at 138, CA; *Campbell v G Hopkins & Sons (Clerkenwell) Ltd* (1933) 50 RPC 213, CA. The same rule applies to a prior user not sufficiently common to have become part of the ordinary trade knowledge: *Hay v Gonville* (1907) 25 RPC 161 at 168.

5 *Sutcliffe v Abbott* (1902) 20 RPC 50 at 55. As to the meaning of 'common general knowledge' see PARAS 443, 457.

6 *British Thomson-Houston Co Ltd v British Insulated and Helsby Cables Ltd* [1924] 2 Ch 160, 41 RPC 345, CA; on appeal (1925) 42 RPC 180, HL. An earlier judgment on an application to revoke is not relevant save on the question of construction of claims: *SmithKline Beecham plc v Apotex Europe Ltd* [2005] EWHC 1655 (Ch), [2006] 2 All ER 53.

7 *British Thomson-Houston Co Ltd v British Insulated and Helsby Cables Ltd* (1925) 42 RPC 180, HL.

8 *Pneumatic Tyre Co Ltd v English Cycle and Tyre Co* (1897) 14 RPC 851 (decided under the corresponding provisions of the Patents, Designs, and Trade Marks (Amendment) Act 1885 s 4). That case referred to an application of the opposite party, sought to be used in cross-examination. Disclosure of a third person's application would be another matter. But see *Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals* [1999] RPC 253 at 274.

The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

9 See the Patents Act 1977 s 118(2); and PARA 581.

10 *Dowling v Billington* (1890) 7 RPC 191, CA; cf *Shoe Machinery Co Ltd v Cutlan* (1895) 12 RPC 342 (on appeal [1896] 1 Ch 108, 12 RPC 530, CA); *Welsbach Incandescent Gas Light Co Ltd v Dowle and London and Suburban Maintenance Co* (1899) 16 RPC 391.

11 As to this convention see PARA 668 et seq.

12 As to this convention see PARA 679.

13 As to the Patent Co-operation Treaty see PARA 653 et seq.

14 Patents Act 1977 s 91(1)(a). As to judicial notice see **CIVIL PROCEDURE** vol 11 (2009) PARA 779 et seq.

15 Patents Act 1977 s 91(1)(b) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 20).

16 For these purposes, 'relevant convention court' does not include a court of the United Kingdom or of any other country which is a party to the relevant convention: Patents Act 1977 s 91(6). As to the meaning of 'relevant convention court' generally see PARA 364 note 6; and as to the meaning of 'United Kingdom' see PARA 303 note 5.

17 Patents Act 1977 s 91(1)(c).

18 Patents Act 1977 s 91(2). For these purposes, 'convention institution' means an institution established by or having functions under the relevant convention: s 91(6).

19 For these purposes, 'legal proceedings', in relation to the United Kingdom, includes proceedings before the comptroller: Patents Act 1977 s 91(6).

20 Patents Act 1977 s 91(3).

21 Patents Act 1977 s 91(4)(a).

22 Patents Act 1977 s 91(4)(b).

23 Patents Act 1977 s 91(4).

24 See the Patents Act 1977 s 92(1), (2), applying the Evidence (Proceedings in Other Jurisdictions) Act 1975 ss 1-3 (see **CIVIL PROCEDURE** vol 11 (2009) PARA 1055 et seq), for the purpose of proceedings before a relevant convention court under the European Patent Convention.

An application to the comptroller for an order under the Evidence (Proceedings in Other Jurisdictions) Act 1975 as applied by the Patents Act 1977 s 92(1) must be: (1) made in writing; (2) supported by written evidence; (3) accompanied by the request as a result of which the application is made, and where appropriate, a translation of the request into English; and (4) accompanied by the prescribed fee: Patents Rules 2007, SI 2007/3291, r 62(1). The prescribed fee is nil: Patents (Fees) Rules 2007, SI 2007/3292, r 7(2). The application must be made without notice: Patents Rules 2007, SI 2007/3291, r 62(2). The comptroller may permit an officer of the European Patent Office to attend the hearing and either examine the witnesses or request the comptroller to put specified questions to the witnesses: r 62(3). Rule 62 is made under the Patents Act 1977 s 92(3), (4).

The Perjury Act 1911 s 1(4) (see **CIVIL PROCEDURE** vol 11 (2009) PARA 1055), applies in relation to such proceedings under the European Patent Convention: Patents Act 1977 s 92(5).

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542. Expert evidence.

A large portion of the evidence in patent cases comprises expert evidence. The object of such evidence is mainly to instruct the court as to the state of knowledge, the meaning of terms of art or even of complete sentences or paragraphs of a technical character¹ and other surrounding circumstances so as to enable the court to read the specification with the understanding of the craftsman to whom it is addressed, and to form a true opinion on the various issues raised; but it is not the function of the witness to construe the specification or other documents². In relation to inventive step, the primary evidence is that of the properly qualified experts who state whether or not in their opinions the relevant step would have been obvious to the skilled man having regard to the state of the art³.

1 *American Cyanamid Co v Ethicon Ltd* [1979] RPC 215 at 251-253. See also *Molnlycke AB v Proctor & Gamble Ltd (No 5)* [1994] RPC 49, CA; *Rockwater v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 919, [2004] All ER (D) 63 (Apr). As to the duties and responsibilities generally of expert witnesses see *The Ikarian Reefer* [1993] FSR 563.

2 What is important is the reasons put forward by the expert: *SmithKline Beecham plc v Apotex Europe Ltd* [2005] EWHC 1655 (Ch), [2006] 2 All ER 53.

3 *Molnlycke AB v Proctor & Gamble Ltd (No 5)* [1994] RPC 49 at 113, CA.

UPDATE

542 Expert evidence

NOTE 1--See *Novartis AG v Dexcel-Pharma Ltd* [2009] EWHC 336 (Pat), [2009] All ER (D) 26 (Mar).

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543. Injunctions.

In a claim for infringement of a patent, an injunction for the remaining life of the patent will be granted after trial¹ against a defendant who has infringed or threatened to infringe a claim not found to be invalid², unless the circumstances negative the probability of infringement in the future³ or the grant of an injunction would be oppressive⁴. Normally⁵ such an injunction would be against infringement of the patent generally⁶. Where an entry is made in the register that licences under a patent are available as of right⁷, no injunction may be granted, unless the proceedings are for infringement by importation from a country which is not a member state of the European Union, if the defendant undertakes to take a licence⁸.

An injunction cannot be granted in respect of a patent which has expired⁹ and, when a claim is brought immediately before the expiration of a patent, an injunction may be refused¹⁰. If the defendant against whom an injunction has been granted has modified the infringing article in an attempt to avoid infringement, a claimant who alleges that the modified article infringes the patent should bring a second claim rather than proceed to enforce the injunction¹¹.

1 As to when an interim injunction may be granted see PARA 538; and as to injunctions generally see **CIVIL PROCEDURE** vol 11 (2009) PARA 331 et seq. In the case of certain aircraft covered by the Convention on International Civil Aviation (the 'Chicago Convention') (Chicago 7 December 1944; TS 8 (1953); Cmd 8742) an injunction must not interfere with the aircraft: see PARA 515.

2 *Killick v Pye Ltd* [1958] RPC 23 at 33; on appeal [1958] RPC 366 at 382, CA; *Chiron Corp v Organon Teknika Ltd (No 10)* [1995] FSR 325. There is no modern case where a final injunction has been refused on the ground of delay. In *Gadd and Mason v Manchester Corp* (1892) 9 RPC 516 at 528, CA, the defendants were permitted to continue to use a gas holder already erected, but restrained from building others, but see to the contrary *Automatic Coal Gas Retort Co Ltd v Salford Corp* (1897) 14 RPC 450.

3 Eg where the defendant has before proceedings abandoned his business or the use of the infringing machine (*Caldwell v Vanvliessen* (1851) 21 LJ Ch 97; *Kernot v Potter* (1862) 3 De GF & J 447; *Proctor v Bayley* (1889) 42 ChD 390, 6 RPC 538, CA; *Scott v Hull Steam Fishing and Ice Co Ltd* (1897) 14 RPC 143; *Hudson v Chatteris Engineering Works Co* (1898) 15 RPC 438; *Welsbach Incandescent Gas Light Co Ltd v New Incandescent (Sunlight Patent) Gas Lighting Co* [1900] 1 Ch 843, 17 RPC 237), or where the defendant has acted innocently and has promptly offered a proper undertaking (*Jenkins v Hope* [1896] 1 Ch 278, 13 RPC 57). Cf *Killick v Pye Ltd* [1958] RPC 23 at 33 (on appeal [1958] RPC 366 at 382, CA). Where an injunction is refused the patentee is usually given liberty to apply: eg *Raleigh Cycle Co Ltd v H Miller & Co Ltd* (1949) 66 RPC 23 at 43.

4 *Shelfer v City of London Electric Lighting Co* [1895] 1 Ch 287, 64 LJ Ch 216; *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289 (copyright); *Navitaire Inc v Easyjet Airline Co* [2004] EWHC 1725 (Ch), [2006] RPC 111.

5 As to the position where some claims are invalid see PARA 552.

6 *Mergenthaler Linotype Co v Intertype Co Ltd* (1926) 43 RPC 239 at 275, CA; *Cofflexip SA v Stolt Comex Seaway MS Ltd* [2001] 1 All ER 952, [2001] RPC 182, CA. Sometimes the injunction is limited to specific claims (see *British United Shoe Machinery Co Ltd v Gimson Shoe Machinery Co Ltd (No 2)* (1929) 46 RPC 137 at 164), and sometimes to a special form (see *Dunlop Pneumatic Tyre Co Ltd v New Ixion Tyre and Cycle Co Ltd* (1898) 15 RPC 389; affd (1899) 16 RPC 16, CA). The injunction will, if necessary, be so limited as to permit the defendant to manufacture for the government: see *Commercial Solvents Corp v Synthetic Products Co Ltd* (1926) 43 RPC 185. The fact that wide injunctions have been granted to stop flagrant infringers of intellectual property rights does not justify the supposition that all infringers of intellectual property rights have to be subject to the same orders: *Cofflexip SA v Stolt Comex Seaway MS Ltd* [2001] 1 All ER 952, [2001] RPC 182, CA (which also provides guidance as to the form of injunction). See also *Kirin-Amgen Inc v Transkaryotic Therapies Inc (No 2)* [2002] RPC 187, [2001] All ER (D) 111 (May); *Kirin-Amgen Inc v Transkaryotic Therapies Inc (No 3)* [2005] FSR 875.

7 As to licences of right see PARA 392 et seq.

8 See the Patents Act 1977 s 46(3)(c); and PARA 392. See also *El Du Pont de Nemours & Co v Enka BV (No 2)* [1988] RPC 497. As to settling terms of the licence see the Patents Act 1977 s 46(3)(a); and PARA 392.

9 *Saccharin Corp'n Ltd v Quincey* [1900] 2 Ch 246 at 249, 17 RPC 337 at 339. It has been suggested, however, that an injunction may be granted after a patent has expired restraining the sale of infringing articles manufactured during its life (*Crossley v Derby Gas Light Co* (1834) 4 LJ Ch 25; *Price's Patent Candle Co Ltd v Bauwen's Patent Candle Co Ltd* (1858) 4 K & J 727) or to prevent the defendant from obtaining a springboard into the market after expiry of the patent (Case C-316/95 *Generics BV v Smith Kline & French Laboratories Ltd* [1997] RPC 801, (1997) 41 BMLR 116, ECJ). See also *Dyson Appliances Ltd v Hoover Ltd (No 2)* [2001] RPC 544 (injunction sought prior to expiry of patent was granted to extend beyond patent's expiry). See also note 10.

10 *Betts v Gallais* (1870) LR 10 Eq 392. See also *Welsbach Incandescent Gas Light Co Ltd v New Incandescent (Sunlight Patent) Gas Lighting Co* (1900) 17 RPC 237 at 254; but cf *Crossley v Beverley* (1829) 1 Russ & M 166n (where a defendant who had a large stock of pirated articles ready to be thrown on the market as soon as the patent expired was restrained); and *F Hoffmann-La Roche & Co AG v Inter-Continental Pharmaceuticals Ltd* [1965] Ch 795, [1965] 2 All ER 15, [1965] RPC 226, CA (where the defendants were entitled to have, but did not have, a compulsory licence, and an injunction was granted). See also *Dyson Appliances Ltd v Hoover Ltd (No 2)* [2001] RPC 544.

11 *Multiform Displays Ltd v Whitmarley Displays Ltd* [1957] RPC 260 at 262, HL.

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544. Stay of injunction.

The operation of an injunction may be stayed pending an appeal¹. This is a matter entirely within the court's discretion but the court should seek so to arrange matters that, when the appeal comes on to be heard, the appellate court may be able to do justice between the parties, whatever the outcome of the appeal may be². Where the injunction is stayed, the defendant may be required to keep an account³, or give security for damages⁴, or to pay damages into a secured account⁵, and to enter the appeal within a specified time⁶. An undertaking as to damages may be required as a condition of refusing a stay⁷.

¹ *Kaye v Chubb & Sons Ltd* (1886) 4 RPC 23; *Ducketts Ltd v Whitehead* (1895) 12 RPC 187 at 191. See also *Minnesota Mining & Manufacturing Co v Johnson & Johnson Ltd* [1976] RPC 671, CA; *Strix Ltd v Otter Controls Ltd* [1991] FSR 354, CA. A stay is usually granted if the claimant does not object.

² *Minnesota Mining & Manufacturing Co v Johnson & Johnson Ltd* [1976] RPC 671 at 676, CA, where the earlier authorities were reviewed. See also *Quantel Ltd v Spaceward Microsystems Ltd (No 2)* [1990] RPC 147, CA; *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331; *Mölnlycke AB v Procter & Gamble Ltd* [1992] FSR 549; *Optical Coating Laboratory Inc v Pilkington PE Ltd* [1993] FSR 310; *Kirin-Amgen Inc v Transkaryotic Therapies Inc (No 3)* [2005] FSR 875.

³ *Kaye v Chubb & Sons* (1886) 4 RPC 23, CA; *Bugges Insecticide Ltd v Herbon Ltd* [1972] RPC 197.

⁴ *National Opalite Glazed Brick and Tile Syndicate Ltd v Ceralite Syndicate Ltd* (1896) 13 RPC 649.

⁵ *Quantel Ltd v Spaceward Microsystems Ltd (No 2)* [1990] RPC 147, CA.

⁶ See *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd* [1959] RPC 189 at 219.

⁷ *Minnesota Mining and Manufacturing Co v Johnson and Johnson Ltd* [1976] RPC 671, CA; *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331; *Kirin-Amgen Inc v Transkaryotic Therapies Inc (No 3)* [2005] FSR 875.

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545. Damages or profits.

A successful claimant in proceedings for infringement of a patent may claim damages in respect of the infringement¹ or an account of the profits derived by the defendant from the infringement², but the court may not, in respect of the same infringement, both award damages and order an account of profits³.

An inquiry as to damages or account of profits is usually taken by a master, but, if difficult or complex questions are involved, may be taken by the patents judge in court⁴. The procedure is by way of written contentions supported by witness statements, supplemented by cross-examination of the deponents, if requested⁵. Both parties will normally be required to give disclosure⁶. The costs of the inquiry are always reserved. The inquiry extends to infringements not exemplified in the particulars of infringement, but merely covered by general words there⁷. The onus is on the claimant to establish the number of infringing articles sold⁸. Where judgment is signed on admissions, damages can only be claimed on admitted infringements⁹. The taking of an account or an inquiry as to damages will be stayed pending an appeal only in special circumstances¹⁰.

The award of damages does not license the articles in respect of which they are paid, and the claimant can bring a further claim for damages against purchasers or users¹¹.

In taking an account of profits, it is the profit from the use of the invention that must be considered, not necessarily that from the entire infringing sale¹². The taking of an account has the effect of condoning past infringements¹³ but not those which may take place in the future¹⁴. Accordingly the claimant can bring a further claim for damages or an account against purchasers and users¹⁵.

1 Patents Act 1977 s 61(1)(c). See also PARA 521 note 1. Where it is clear that nothing would be recovered on an inquiry as to damages, it may be refused (*United Telephone Co v Sharples* (1885) 29 ChD 164, 2 RPC 28; *Alfred Dunhill Ltd v Griffiths Bros* (1933) 51 RPC 93) but if the claim for damages is bona fide and arguable an inquiry will be ordered (*Kooltrade Ltd v XTS Ltd* [2001] FSR 158 at 167). As to the form of order directing an inquiry see *British Thomson-Houston Co Ltd v G and R Agency* (1925) 42 RPC 305; and as to damages generally see **DAMAGES** vol 12(1) (Reissue) PARA 714 et seq.

2 Patents Act 1977 s 61(1)(d). As to accounts of profit, which are rarely taken in practice, see **EQUITY** vol 16(2) (Reissue) PARA 553.

3 Patents Act 1977 s 61(2). Before electing for an inquiry or an account, the claimant may be entitled to disclosure relating to the extent of the defendant's sales for the purpose of making the election: *Minnesota Mining & Manufacturing Co v C Jeffries Pty Ltd* [1993] FSR 189, Aust Fed Ct; *Island Records Ltd v Tring International plc* [1995] 3 All ER 444, [1996] 1 WLR 1256, [1995] FSR 560 (copyright); *Brugger v Medicaid* [1996] FSR 362 (copyright). As to electing between remedies see *Redrow Homes Ltd v Bett Bros plc* [1999] 1 AC 197, [1998] 1 All ER 385, [1998] RPC 793, HL (copyright case); *Spring Form Inc v Toy Brokers Ltd* [2002] FSR 276 at 288. See also *Celanese International Corp v BP Chemicals Ltd* [1999] RPC 203.

4 *Cleveland Graphite Bronze Co Ltd v Glacier Metal Co Ltd* (1951) 68 RPC 181.

5 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] RPC 203, CA.

6 *British United Shoe Machinery Co Ltd v Lambert Howarth & Sons Ltd* (1929) 46 RPC 315; *Rosedale Associated Manufacturers Ltd v Airfix Products Ltd* [1959] RPC 249. See also *Saccharin Corp Ltd v Chemicals and Drugs Co Ltd* [1900] 2 Ch 556, 17 RPC 612, CA (disclosure of the names of the defendants' customers ordered on an account of profits); *British Thomson-Houston Co Ltd v Irradiant Lamp Works Ltd* (1923) 40 RPC 243; *Dyson Ltd v Hoover Ltd (No 3)* [2002] RPC 841. See, however, *Smith Kline & French Laboratories Ltd v*

Doncaster Pharmaceuticals Ltd [1989] FSR 401 (disclosure of the defendant's customers' names refused where the judge assessed damages as a lump sum).

7 *Cleveland Graphite Bronze Co Ltd v Glacier Metal Co Ltd* (1951) 68 RPC 181; *Fichera v Flogates Ltd* [1984] RPC 257 at 292, CA.

8 *British Thomson-Houston Co Ltd v Goodman (Leeds) Ltd* (1925) 42 RPC 75; cf *Dunlop Pneumatic Tyre Co Ltd v Green* (1900) 17 RPC 234.

9 *United Telephone Co v Donohoe* (1886) 31 ChD 399, 3 RPC 45, CA.

10 See *J Lucas (Batteries) Ltd v Gaedor Ltd* [1978] RPC 389, CA (appeal on another patent which, if successful, would alter the basis of the account). See also *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331 at 372 (stay refused); *Kirin-Amgen Inc v Transkaryotic Therapies Inc (No 3)* [2005] FSR 875 (stay refused); *Mölnlycke AB v Procter & Gamble Ltd* [1992] FSR 549 at 610 (stay refused). In practice some successful claimants do not proceed with the inquiry until after determination of the appeal.

11 *United Telephone Co Ltd v Walker and Oliver* (1886) 56 LT 508, 4 RPC 63; *Brockie Pell Arc Lamp Ltd v Johnson* (1900) 17 RPC 697; *Catnic Components Ltd v C Evans & Co (Builders Merchants) Ltd* [1983] FSR 401 at 422. But the patentee cannot recover in total more than his loss: *Spring Form Inc v Toy Brokers Ltd* [2002] FSR 276.

12 *United Horse-Shoe and Nail Co Ltd v Stewart* (1888) 13 App Cas 401, 5 RPC 260, HL; *Celanese International Corp v BP Chemicals Ltd* [1999] RPC 203; *Spring Form Inc v Toy Brokers Ltd* [2002] FSR 276. Cf PARA 546 text and note 6.

13 *Neilson v Betts* (1871) LR 5 HL 1; *De Vitre v Betts* (1872) LR 6 HL 319; *Watson v Holiday* (1882) 20 ChD 480; *Saccharin Corp v Chemicals and Drugs Co* [1900] 2 Ch 556 at 558-559, 17 RPC 612 at 615, CA.

14 *Codex Corp v Racal-Milgo Ltd* [1984] FSR 87.

15 *Codex Corp v Racal-Milgo Ltd* [1984] FSR 87. Where there are more than one claimant only one account will be ordered and an apportionment made: *Spring Form Inc v Toy Brokers Ltd* [2002] FSR 276. The account extends to all infringers sued: *Spring Form Inc v Toy Brokers Ltd*.

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546. Measure of damages.

Infringement of a patent is a statutory tort and accordingly damages recoverable are assessed in the same way as most other torts, following the elementary rules that the victim should be restored to the position he would have been in if no wrong had been done, and that the victim can recover loss which was foreseeable, caused by the wrong and not excluded from being recovered by public or social policy¹.

Where the claimant is a manufacturer, the ordinary measure of damages is prima facie the loss of the profit the claimant would have suffered had his sales not been diminished by the infringement², it being presumed, in the absence of evidence to the contrary, that sales by the infringer were taken from the claimant³. Where the claimant normally grants licences, even if he also manufactures, damages are usually assessed on a royalty basis, although the infringer cannot claim to be put on as favoured terms as a licensee⁴. To the extent that the infringements were not sold in competition with the patentee, he is entitled to a fair royalty on them, whether he grants licences or not⁵. Damages should be assessed on the basis of the amount which the defendant in reality has been obliged to pay, not the amount which he should or might have paid⁶.

Where the subject of the patent forms an integral part of the article sold, or of the machinery used in making it, the claimant is entitled to the whole damage caused by the sale; but it may be relevant to what extent the damage is due to the use of the invention⁷. A patentee who has been compelled by infringement to reduce his own prices may claim the resulting loss of profit as damages⁸. Loss to a subsidiary company may be recoverable⁹. Loss of reputation due to infringements may be a head of damage¹⁰ and so may the costs of disclosure proceedings against third parties to discover the identities of the defendants as infringers¹¹. It is, however, unlikely that exemplary damages are available in a claim for patent infringement¹².

In awarding damages or granting any other relief in infringement proceedings brought by the holder of an exclusive licence¹³, the court or the comptroller¹⁴ must take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such¹⁵.

¹ See *Gerber Garment Technology Inc v Lectra Systems Ltd* [1997] RPC 443 at 452, CA, per Staughton LJ. As to the assessment of damages for tort see **DAMAGES** vol 12(1) (Reissue) PARA 851 et seq; **TORT** vol 97 (2010) PARA 516.

² The subject is discussed at length in *Meters Ltd v Metropolitan Gas Meters Ltd* (1911) 104 LT 113, 28 RPC 157, CA; *Watson, Laidlaw & Co Ltd v Pott, Cassels and Williamson* (1914) 31 RPC 104 at 152, HL; *British Thomson-Houston Co Ltd v Naamloos Vennootschap Pope's Metaalraadlampenfabriek* (1923) 40 RPC 119; *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] 2 All ER 173, [1976] RPC 197, HL. Damages were given on the loss of profit basis in *Leeds Forge Co Ltd v Deighton's Patent Flue Co Ltd* (1908) 25 RPC 209, *Catnic Components Ltd v Hill & Smith Ltd* [1983] FSR 512 and *Gerber Garment Technology Inc v Lectra Systems Ltd* [1995] RPC 383 (affd in part [1997] RPC 443, CA). There is no rule of law restricting the scope of recovery to activities which themselves infringe the patent: *Gerber Garment Technology Inc v Lectra Systems Ltd* [1997] RPC 443 at 455, CA, per Staughton LJ.

³ *Leeds Forge Co Ltd v Deighton's Patent Flue Co Ltd* (1907) 25 RPC 209; *British United Shoe Machinery Co Ltd v A Fussell & Sons Ltd* (1910) 27 RPC 205; *Meters Ltd v Metropolitan Gas Meters Ltd* (1911) 104 LT 113, 28 RPC 157, CA. The burden of proof is on the defendant: see *Catnic Components Ltd v Hill & Smith Ltd* [1983] FSR 512.

4 *Boyd v Tootal, Broadhurst, Lee Co Ltd* (1894) 11 RPC 175; *Pneumatic Tyre Co Ltd v Puncture Proof Pneumatic Tyre Co Ltd* (1899) 16 RPC 209. See also *English and American Machinery Co Ltd v Union Boot and Shoe Machine Co* (1896) 13 RPC 64; *Automatic Coal Gas Retort Co Ltd v Salford Corp* (1897) 14 RPC 450; *General Tire and Rubber Co v Firestone Tyre and Rubber Co* [1975] 2 All ER 173, [1976] RPC 197, HL. There seems no reason in principle why a claimant who can prove loss of sales should not claim damages for them, even though the defendant could have made those sales lawfully by taking a licence: cf the text and note 5; and the Patents Act 1977 s 46(3)(c) (see PARA 549).

5 *Watson, Laidlaw & Co Ltd v Pott, Cassels and Williamson* (1914) 31 RPC 104, HL; *Catnic Components Ltd v Hill & Smith Ltd* [1983] FSR 512.

6 *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] 2 All ER 173, [1976] RPC 197, HL.

7 *Meters Ltd v Metropolitan Gas Meters Ltd* (1911) 104 LT 113, 28 RPC 157, CA; *United Horse-Shoe and Nail Co Ltd v Stewart* (1888) 13 App Cas 401, 5 RPC 260, HL; *Coflexip SA v Stolt Comex Seaway MS Ltd* [2003] EWCA Civ 296, [2003] FSR 728 (where this issue is fully considered).

8 *United Horse-Shoe and Nail Co Ltd v Stewart* (1888) 13 App Cas 401, 5 RPC 260, HL (damages not given for a reduction in price due to lack of confidence in the patent); *American Braided Wire Co v Thomson* (1890) 44 ChD 274, 7 RPC 152, CA; *Meters Ltd v Metropolitan Gas Meters Ltd* (1911) 104 LT 113, 28 RPC 157, CA.

9 *Gerber Garment Technology Inc v Lectra Systems Ltd* [1997] RPC 443, CA.

10 *Pneumatic Tyre Co Ltd v Puncture Proof Pneumatic Tyre Co Ltd* (1899) 16 RPC 209.

11 *Morton-Norwich Products Inc v Intercen Ltd (No 2)*, *Morton-Norwich Products Inc v United Chemicals (London) Ltd* [1981] FSR 337.

12 See *Morton-Norwich Products Inc v Intercen Ltd (No 2)*, *Morton-Norwich Products Inc v United Chemicals (London) Ltd* [1981] FSR 337; *Catnic Components Ltd v Hill & Smith Ltd* [1983] FSR 512.

13 The proceedings brought under the Patents Act 1977 s 67(1): see PARA 521.

14 As to the comptroller see PARA 577.

15 Patents Act 1977 s 67(2). This right is concurrent with the patentee's right to relief: *Optical Coating Laboratory Inc v Pilkington PE Ltd* [1993] FSR 310. See also *Spring Form Inc v Toy Brokers Ltd* [2002] FSR 276.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/547. Period over which damages taken.

547. Period over which damages taken.

No damages may be awarded for acts of infringement before publication of the application for a patent¹ or more than six years before the proceedings were brought². Damages run from the time when the claimants, or one of them, became the equitable owner of the patent, although the legal title must have been complete before action³ and, in any event, a patent may be assigned or licensed together with the right to claim damages for previous infringements⁴. Damages are assessed on all acts of infringement down to the time of the assessment⁵. Possibly damages may be claimed in respect of sales after the expiration of the patent which were made in infringement during its life⁶. The court has a discretion to award interest on damages for all or part of the period between each act of infringement and the date of assessment⁷. The rate of interest is based on the cost of borrowing the money represented by the sum awarded as damages⁸. Compound interest is not, however, payable as a head of damages⁹.

1 See the Patents Act 1977 s 69(1), (2); and PARA 548. As to publication of the application see PARA 327.

2 See the Limitation Act 1980 s 2; and **LIMITATION PERIODS** vol 68 (2008) PARA 979.

3 *United Horse-Shoe and Nail Co Ltd v Stewart* (1888) 13 App Cas 401 at 417, 5 RPC 260 at 269, HL, per Lord Macnaghten, where he expressed the view that the claimants succeeded to the rights of their predecessors in title, and could claim damages for all infringements. See to the contrary *Wilderman v FW Berk & Co Ltd* [1925] Ch 116, 42 RPC 79, where the earlier decision was not cited. In *Ellwood v Christy* (1864) 34 LJCP 130, it was held that an account ran only from the completion of the legal title.

4 See the Patents Act 1977 s 30(7); and PARA 374.

5 Revocation of the patent after judgment does not affect the order for damages: *Poulton v Adjustable Cover and Boiler Block Co* [1908] 2 Ch 430, 25 RPC 661, CA.

6 See PARA 543.

7 See the Law Reform (Miscellaneous Provisions) Act 1934 s 3(1); and **FINANCIAL SERVICES AND INSTITUTIONS** vol 50 (2008) PARA 1915. Where there was infringement between the publication and the grant but commercial practice was to pay royalties only after the grant, the court awarded interest from the date of the grant only: *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] 2 All ER 173, [1976] RPC 197, HL. See also *Gerber Garment Technology Inc v Lectra Systems Ltd* [1997] RPC 443 at 487, CA.

8 *Tate & Lyle Food and Distribution Ltd v Greater London Council* [1981] 3 All ER 716; *Catnic Components Ltd v Hill & Smith Ltd* [1983] FSR 512 (where the appropriate rate was found to be the clearing bank base rate plus 2%).

9 *Catnic Components Ltd v Hill & Smith Ltd* [1983] FSR 512.

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548. Damages for infringement of rights conferred by publication of application for patent.

An applicant for a patent has, as from the publication of the application¹ for the patent until grant², the same right as he would have had, if the patent had been granted on the date of publication, to bring proceedings for damages for infringement³. The applicant is, however, entitled to bring proceedings in respect of any act only:

- 331 (1) after the patent has been granted⁴; and
- 332 (2) if the act would, if the patent had been granted on the date of publication, have infringed not only the patent but also the claims as interpreted by the description and any drawings referred to in the description or claims in the form in which they were contained in the application immediately before the preparations for its publication were completed by the UK Intellectual Property Office⁵.

¹ ie under the Patents Act 1977 s 16: see PARA 327.

² As to grant see PARA 338.

³ Patents Act 1977 s 69(1). If the proceedings are before the comptroller, leave is required in certain cases: see PARA 520. As to the comptroller see PARA 577. Subject to s 69(2) and s 69(3) (see PARA 549), references in ss 60-62, 66-68 to a patent and its proprietor are to be respectively construed as including references to the application and the applicant; and references to a patent being in force, being granted, being valid or existing are to be construed accordingly: s 69(1).

⁴ Patents Act 1977 s 69(2)(a).

⁵ Patents Act 1977 s 69(2)(b). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

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549. Restrictions on the recovery of damages.

The right to recover damages in proceedings for infringement of a patent is subject to the following statutory restrictions:

- 333 (1) in proceedings for the infringement of a patent, damages may not be awarded, and no order may be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed¹;
- 334 (2) where an amendment of the specification of a patent² has been allowed, the court or the comptroller³, when awarding damages or making an order for an account of profits in proceedings for an infringement of the patent committed before the decision to allow the amendment, must take into account the following: (a) whether at the date of infringement the defendant knew, or had reasonable grounds to know, that he was infringing the patent; (b) whether the specification of the patent as published was framed in good faith and with reasonable skill and knowledge; (c) whether the proceedings are brought in good faith⁴;
- 335 (3) where one or more claims of the patent sued on are found to be invalid special provisions apply⁵;
- 336 (4) where an entry has been made in the register that licences under the patent are to be available as of right⁶ and the claim is for infringement otherwise than by the importation of goods from a country which is not a member state of the European Union⁷, and the defendant undertakes to take a licence, any amount recoverable by way of damages may not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement⁸;
- 337 (5) in respect of an infringement committed after a failure to pay a renewal fee and any additional fee within the prescribed period, and before any extension of that period⁹, the court or the comptroller (in proceedings before him) may, if it or he thinks fit, refuse to award damages or order an account of profits¹⁰.

1 Patents Act 1977 s 62(1). See also PARA 521 note 1. A person is not to be taken to have been aware, or to have had reasonable grounds for supposing, that the patent existed by reason only of the application to a product of the word 'patent' or 'patented', or any word or words expressing or implying that a patent has been obtained, unless the number of the patent accompanies the word or words: s 62(1). The test is objective: *Lancer Boss Ltd v Henley Forklift Co Ltd and H and M Sideloaders Ltd* [1975] RPC 307 at 317. The current tendency is to hold that a prudent businessman should investigate the possibility of third party rights: see *Benmax v Austin Motor Co Ltd* (1953) 70 RPC 143 at 156 (on appeal, where this point did not arise, 70 RPC 284, CA); and [1955] AC 370, [1955] 1 All ER 326, 72 RPC 39, HL; *John Khalil Khawam & Co v K Chellaram & Sons (Nigeria) Ltd* [1964] 1 All ER 945, [1964] 1 WLR 711, [1964] RPC 337 at 344, PC. See also *Infabrics Ltd v Jaytex Ltd* [1980] Ch 282, [1980] 2 All ER 669, CA (copyright).

2 As to amendment of specifications see PARA 346 et seq.

3 As to the comptroller see PARA 577.

4 Patents Act 1977 s 62(3) (amended by SI 2006/1028). The Patents Act 1977 s 62(3) and s 62(2) do not apply to an infringement of the rights conferred by s 69 (see PARA 548), but, in considering the amount of damages for any such infringement, the court or the comptroller must consider whether or not it would have been reasonable to expect, from a consideration of the specification as published under s 16 (see PARA 327), that a patent would be granted conferring on the proprietor protection from an act of the same description as

that found to infringe those rights, and, if the court or he finds that it would not have been reasonable, the court or he must reduce the damages to such an amount as the court or he thinks just: s 69(3).

As to reasonable skill and knowledge see *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] 2 All ER 173, [1975] RPC 203, CA (failure to correct an obvious clerical error held not to show lack of reasonable skill); revsd on another ground [1976] RPC 197, HL; *Illinois Tool Works Inc v Autobars Co (Services) Ltd* [1974] RPC 337 at 373-374 (specification involving more than one invention held to have been framed in good faith with reasonable skill and knowledge); *Hallen Co v Brabantia (UK) Ltd* [1990] FSR 134; *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369 (where failure to delete a subsidiary claim and the corresponding description was held to show lack of reasonable skill); *Chiron Corp v Organon Teknika Ltd (No 7)* [1994] FSR 458; *Kirin-Amgen Inc's Patent* [2002] EWHC 471 (Pat), [2002] RPC 43. The patentee should only be deprived of damages if the original passages in the specification were misleading: *Unilin Beheer BV v Berry Floor NV (No 2)* [2006] FSR 495 at 503, CA.

5 See the Patents Act 1977 s 63; and PARA 552. See also PARA 521 note 1.

6 As to licences of right see the Patents Act 1977 s 46; and PARA 392.

7 Probably this means that damages for infringement by importation of goods are not restricted. Any normal claim relating to imported goods would, however, involve acts of infringement apart from the importation itself.

8 Patents Act 1977 s 46(3)(c) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 12(1), (2)).

9 As to renewal fees and extensions of the prescribed period see the Patents Act 1977 s 25(4); and PARA 340.

10 Patents Act 1977 s 62(2) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 15). See also s 69(3); and note 4.

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550. Order for delivery up.

An order may be made in infringement proceedings for the defendant to deliver up¹ or destroy any patented product² in relation to which the patent is infringed or any article in which that product is inextricably comprised³. Since, however, the object of such an order is to prevent further infringement, and not to punish the defendant, where possible the order will be restricted to removal and delivery up of infringing parts⁴. Delivery up may be refused of a machine that does not infringe until put into operation⁵. A stay of the operation of such an order will generally be granted pending an appeal where there is no risk of the articles being removed or sold⁶.

1 This remedy is supplemental to the other reliefs, and the value of the articles delivered will not be deducted from the damages: *United Telephone Co Ltd v Walker and Oliver* (1886) 56 LT 508, 4 RPC 63. The defendant must pay the costs of complying with the order: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 29.1.

2 As to the meaning of 'patented product' see PARA 372 note 11.

3 Patents Act 1977 s 61(1)(b). See also PARA 521 note 1.

4 *Mergenthaler Linotype Co v Intertype Ltd* (1926) 43 RPC 381; *British United Shoe Machinery Co Ltd v Gimson Shoe Machinery Co Ltd* (1927) 45 RPC 85 (affd (1928) 45 RPC 290, CA). In *Morgan & Co Ltd v Windover & Co* (1890) 7 RPC 446, where the patent was for a combination of old parts, the defendant was allowed to keep the parts on removing them from the combination. Where, however, the full order for delivery up has been made, it will not, on an application to vary the minutes, be reduced to one for removal of infringing parts (*British Westinghouse Electric and Manufacturing Co Ltd v Electrical Co Ltd* (1911) 55 Sol Jo 689, 28 RPC 517 at 530), but a claimant who has omitted to ask for this order at the trial may obtain it by variation of the minutes (*Edison and Swan United Electric Light Co Ltd v Holland* (1888) 4 TLR 686, 5 RPC 459). See also *Walker v Wilson Dawes (Sales and Contracts) Ltd* [1964] RPC 246.

5 *Electric and Musical Industries Ltd v Lissen Ltd* (1936) 54 RPC 5 at 35.

6 *Lancashire Explosives Co Ltd v Roburite Explosives Co Ltd* (1895) 12 TLR 35, 12 RPC 470, CA (on appeal (1897) 14 RPC 303, HL); *S Parkes & Co Ltd v Cocker Bros Ltd* (1929) 46 RPC 241, CA. Sometimes the defendant's solicitor is required to give an undertaking: *Washburn and Moen Manufacturing Co v Patterson* (1883) 1 RPC 191; *Turner v Bowman* (1924) 42 RPC 29. In *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd (No 2)* (1922) 39 RPC 212, a stay was refused on the claimant's undertaking to preserve the articles pending an appeal; and in *Mölnlycke AB v Procter & Gamble Ltd* [1992] FSR 549 delivery up to the claimant's solicitors pending appeal was ordered.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(2) PROCEEDINGS FOR INFRINGEMENT/551. Certificate of contested validity.

551. Certificate of contested validity.

If in any proceedings before the court¹ or the comptroller² the validity of a patent³ to any extent is contested, and that patent is found by the court or the comptroller to be wholly or partially valid⁴, the court or the comptroller may certify the finding and the fact that the validity of the patent was so contested⁵. Where a certificate is so granted, then, if in any subsequent proceedings⁶ before the court or the comptroller for infringement of or for revocation of the patent⁷ a final order or judgment is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party is entitled, unless the court or the comptroller otherwise directs, to his costs or expenses as between solicitor and own client⁸, other than the costs or expenses of any appeal in the subsequent proceedings⁹. The grant of a certificate is discretionary¹⁰. It should not be granted unless the question of validity has been thoroughly canvassed¹¹, but it is not necessary that the court should have decided the issue of validity¹². Nor is it necessary that the claimant should have succeeded on the issue of infringement¹³.

A second certificate may be granted, and this is usually done where fresh objections are raised at a subsequent trial¹⁴. The certificate may be granted by any court¹⁵. It is doubtful whether the amendment of a patent after the grant of a certificate of validity affects a certificate¹⁶. A certificate may be granted for an expired patent¹⁷.

1 As to the meaning of 'court' see PARA 637 note 1.

2 As to the comptroller see PARA 577.

3 As to validity see PARA 426 et seq.

4 As to where the subsequent dispute involves both a certified claim and an uncertified claim see *SmithKline Beecham plc v Apotex Europe Ltd (No 2)* [2005] FSR 559 at 566.

5 Patents Act 1977 s 65(1).

6 'Subsequent proceedings' means proceedings begun after the certificate has been granted: *Automatic Weighing Machine Co v Combined Weighing Machine Co* (1889) 6 RPC 120 at 126; *Automatic Weighing Machine Co v International Hygienic Society* (1889) 6 RPC 475; *Saccharin Corp'n Ltd v Anglo-Continental Chemical Works* [1901] 1 Ch 414, 17 RPC 307; *SmithKline Beecham plc v Apotex Europe Ltd (No 2)* [2004] EWCA Civ 1703, [2005] FSR 559. It includes the continuation of proceedings in an existing action after a certificate of validity has been given in other proceedings: *Mölnlycke AB v Proctor & Gamble Ltd (No 5)* [1994] RPC 49 at 141, CA.

7 This does not apply in a threats claim, unless relief for infringement or revocation is asked for. As to proceedings for revocation see PARA 564 et seq.

8 'Solicitor and own client' costs no longer exist as a basis for taxation and the provision is taken to mean indemnity costs: *SmithKline Beecham plc v Apotex Europe Ltd (No 2)* [2005] FSR 559 at 564. As to costs see CPR Pts 43-48; and **CIVIL PROCEDURE**.

9 Patents Act 1977 s 65(2).

10 *VD Ltd v Boston Deep Sea Fishing and Ice Co Ltd* (1934) 52 RPC 1 at 33, CA.

11 *Gillette Industries Ltd v Bernstein* [1942] Ch 45 at 49, [1941] 3 All ER 248 at 251, 58 RPC 271 at 285, CA; *Martin v CB Projection (Engineering) Ltd* (1948) 65 RPC 361.

12 *Re Volpertas' Patent* (1948) 65 RPC 355.

13 *Automatic Weighing Machine Co v Knight* (1889) 5 TLR 359, 6 RPC 297 at 307, CA; *Shoe Machinery Co Ltd v Cutlan* [1896] 1 Ch 667, 13 RPC 141; *Birch v Harrap & Co* (1896) 13 RPC 615, CA; *Pneumatic Rubber Stamp Co Ltd v Lindner* (1898) 15 RPC 525; *Morrison v Asplen* (1904) 21 RPC 557; *Hoffmann Manufacturing Co Ltd v Auto Machinery Co Ltd* (1911) 28 RPC 141 at 153, CA; *Vaisey, Bristol and Saxone Shoe Co Ltd v Toddlers Footwear (1954) Ltd* [1957] RPC 90 at 104. Where the Court of Appeal allows an appeal on the ground of non-infringement, it may allow the certificate to stand (*Hardmuth v Baker & Son* (1904) 22 RPC 66, CA), but this is not always done (see eg *Gillette Safety Razor Co v Anglo-American Trading Co Ltd* (1912) 29 RPC 341; *Submarine Signal Co v Henry Hughes & Son Ltd* (1931) 49 RPC 149).

14 *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1921) 39 RPC 49, HL. See also *Mölnlycke AB v Procter & Gamble Ltd* [1992] FSR 549.

15 In *British Thomson-Houston Co Ltd v Corona Lamp Works Ltd* (1921) 39 RPC 49, HL, the House of Lords remitted the case to the Chancery Division with directions to certify. In *Submarine Signal Co v Henry Hughes & Son Ltd* (1931) 49 RPC 149, the Court of Appeal discharged a certificate given by a lower court, although not finding the claim in question invalid.

16 In *Badische Anilin und Soda Fabrik v G Thompson & Co Ltd* (1904) 21 RPC 473 at 480 it was held that the certificate remained effective; but in *JB Brooks & Co Ltd v Rendall, Underwood & Co Ltd* (1906) 24 RPC 27 it was held that it did not.

17 *Kane and Pattison v J Boyle & Co* (1901) 18 RPC 325; *Leggatt v Hood's Original Darts Accessories Ltd and Hood* (1950) 68 RPC 3 at 22, CA.

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552. Partially valid patents.

If in proceedings for infringement in which validity is in issue it is found that the patent is only partially valid, the court¹ or the comptroller² may grant relief in respect of part of the patent found to be valid and infringed³. Where it is so found, the court or the comptroller, when awarding damages, costs or expenses or making an order for an account of profits, must take into account the following: (1) whether at the date of the infringement the defendant or defender knew, or had reasonable grounds to know, that he was infringing the patent; (2) whether the specification of the patent was framed in good faith and with reasonable skill and knowledge⁴; (3) whether the proceedings are brought in good faith; and any relief granted is subject to the discretion of the court or the comptroller as to costs or expenses and as to the date from which damages or an account should be reckoned⁵. The court or the comptroller may further direct, as a condition of any relief, that the specification of the patent be amended⁶ to its or his satisfaction⁷. The court or the comptroller may also grant relief in the case of a European patent (UK)⁸ on condition that the claims of the patent are limited to its or his satisfaction by the European Patent Office at the request of the proprietor⁹.

Where at trial a patent had been valid and infringed but the patentee later sought to amend the claims, it was given the costs up to the date of judgment but no order for an injunction or delivery up¹⁰. To obtain such relief a patentee must start fresh proceedings¹¹.

1 As to the meaning of 'court' see PARA 637 note 1.

2 As to the comptroller see PARA 577.

3 Patents Act 1977 s 63(1). See also PARA 521 note 1.

4 As to good faith and reasonable skill and knowledge see *Page v Brent Toy Products Ltd* (1949) 67 RPC 4 at 20; *Ronson Products Ltd v A Lewis & Co (Westminster) Ltd* [1963] RPC 103; *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1973] FSR 79 at 120; *Hallen Co v Brabantia (UK) Ltd* [1990] FSR 134; *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369; *Kirin-Amgen Inc's Patent* [2002] EWHC 471 (Pat), [2002] RPC 43; *Chiron Corp v Organon Teknika Ltd (No 7)* [1994] FSR 458; *Kirin-Amgen Inc's Patent* [2002] EWHC 471 (Pat), [2002] RPC 43; *Unilin Beheer BV v Berry Floor NV (No 2)* [2006] FSR 495, CA.

5 Patents Act 1977 s 63(2) (amended by SI 2006/1028). The provision applies only where a finding has been made by the court or comptroller: *SmithKline Beecham plc v Apotex Europe Ltd (No 2)* [2004] EWCA Civ 1703, [2005] FSR 559. In recent practice relief is rarely, if ever, refused, and there is no instance of a special date for the reckoning of damages. As to the court's discretion and the relevance of the conduct of the proprietor of the patent see *VD Ltd v Boston Deep Sea Fishing and Ice Co Ltd* (1935) 52 RPC 303 at 331. See also *Auster Ltd v Perfecta Motor Equipments Ltd* (1924) 41 RPC 482; *Douglas Packing Co Inc, Douglas Pectin Corp and Postum Co Inc v Evans & Co (Hereford and Devon) Ltd* (1929) 46 RPC 493, CA; *Hallen Co v Brabantia (UK) Ltd* [1990] FSR 134. As to damages see *Leggatt v Hood's Original Darts Accessories Ltd and Hood* (1950) 68 RPC 3 at 17, CA. See also *Gerber Garment Technology Inc v Lectra Systems Ltd* [1995] FSR 492, CA (presence of invalid claims in patent had no effect on defendant's conduct and therefore unjust to deprive claimant of any part of his damages).

6 Ie on an application for the purpose under the Patents Act 1977 s 75 (see PARAS 348-349), which may be made whether or not all other issues in the proceedings have been determined.

7 Patents Act 1977 s 63(3).

8 As to the meaning of 'European patent (UK)' see PARA 675 note 1.

9 Patents Act 1977 s 63(4) (added by the Patents Act 2004 s 3(1)). As to the European Patent Office see PARA 668.

10 *PLG Research Ltd v Ardon International Ltd (No 2)* [1993] FSR 698.

11 *Dudgeon v Thomson and Donaldson* (1877) 3 App Cas 34, HL; *Kenrick v Jefferson Ltd's Patent* (1911) 29 RPC 25; *PLG Research Ltd v Ardon International Ltd (No 2)* [1993] FSR 698.

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553. Costs.

Costs are allowed or disallowed in patent infringement actions on the same basis as in any other litigation¹ and normally costs follow the event². Where, however, it is appropriate, the practice is to deal with costs on an issue basis so as to reflect the time and expense of the issues on which the parties succeeded³. However, that approach should not be applied automatically and it is always necessary to step back to see what is the overall effect of that approach⁴. The correct approach is to ask who is the overall winner in the litigation, whether he has lost on a suitably circumscribed issue and so should be deprived of his costs of that issue and whether it is an exceptional case such as to lead to an adverse costs order on an issue in favour of the overall loser⁵. Save in exceptional circumstances, the overall winner will be entitled to the general costs of the action, that is those costs which cannot be allocated to any particular issue⁶. In relation to costs which can be allocated to a particular issue but which the overall winner has lost he should be deprived of those costs only if it was unreasonable to have raised that issue⁷. The overall winner should only be ordered to pay the other party's costs of that issue if it is established that there is something more than conduct which justifies his being deprived of the costs of the issue in all the circumstances⁸.

The estimation of costs in patent actions is not a precise science and most often the best that can be achieved is a result lacking mathematical precision⁹. Apportionment between issues may in practice be difficult and there may be a great deal of overlap, for example, where issues relating to obviousness, insufficiency and common general knowledge have been considered¹⁰. In some cases, the court has made an award giving the successful party or, sometimes each party, a percentage of their costs¹¹ rather than costs on an issue-by-issue basis and ordering a detailed assessment¹². Where the costs are to be subject to a detailed assessment, it is common practice to make an interim order for costs¹³.

Where one party has conducted the proceedings in an unreasonable manner it may be ordered to pay indemnity costs¹⁴.

Where by virtue of any of certain transactions, instruments or events¹⁵ a person becomes a proprietor of the patent or an exclusive licensee¹⁶ and the patent is subsequently infringed before the transaction, instrument or event is registered, in proceedings for such an infringement, the court or comptroller must not award him costs or expenses unless it is registered within six months of its date or the court or the comptroller is satisfied that it was not practicable to register it before the end of that period and that it was registered as soon as practicable thereafter¹⁷.

The court will not stay detailed assessment of costs pending an appeal unless the parties agree¹⁸, subject, however, to the successful party's undertaking to repay if the appeal is successful¹⁹.

¹ As to the factors relevant to the court's discretion see CPR 44.3; and **CIVIL PROCEDURE**. See also *Monsanto Technology LLC v Cargill International SA* [2008] FSR 417 at 419.

² See CPR 44.3(2)(a). See eg *Tamglass Ltd OY v Luoyang Glass Technology Co Ltd* [2006] EWHC 445 (Ch), [2006] FSR 622, [2006] All ER (D) 201 (Feb).

³ *Stena Rederi AB v Irish ferries Ltd (No 2)* [2003] EWCA Civ 214, [2003] RPC 681 (order that claimant pay 20% of defendant's costs (defendant winning action on point of statutory construction) and that defendant pay 80% of claimant's costs (claimant winning on issues of validity and factual infringement) upheld). See also

Monsanto Technology LLC v Cargill International SA (No 2) [2008] FSR 417 at 421; *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1625 (Pat).

4 *Actavis Ltd v Merck & Co Inc* [2007] EWHC 1625 (Pat).

5 *Monsanto Technology LLC v Cargill International SA (No 2)* [2008] FSR 417 at 421. See also *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1606 (Pat).

6 *Monsanto Technology LLC v Cargill International SA (No 2)* [2008] FSR 417 at 421.

7 *Monsanto Technology LLC v Cargill International SA (No 2)* [2008] FSR 417 at 421.

8 *Monsanto Technology LLC v Cargill International SA (No 2)* [2008] FSR 417 at 421.

9 *SmithKline Beecham plc v Apotex Europe Ltd (No 2)* [2004] EWCA Civ 1703, [2005] FSR 559.

10 See, for example, *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1606 (Pat).

11 See, for example, *Stena Rederi AB v Irish ferries Ltd (No 2)* [2003] EWCA Civ 214, [2003] RPC 681; *Generics (UK) Ltd v H Lundbeck A/S* [2007] EWHC 1606 (Pat); *Monsanto Technology LLC v Cargill International SA (No 2)* [2008] FSR 417.

12 As to the approach of the court in relation to summary rather than detailed assessment see *Monsanto Technology LLC v Cargill International SA (No 2)* [2008] FSR 417 at 420.

13 See, for example, *Marks (UK) Ltd v Teknowledge Ltd* [2000] FSR 138; *Rambus Inc v Hynix Semiconductor UK Ltd* [2004] EWHC 2313 (Pat), [2005] FSR 417.

14 *Marshalltown Trowel Co v Ceka Works Ltd* [2001] FSR 633 (claimant ordered to pay indemnity costs in respect of certain issues as it had unreasonably delayed in instructing an expert to advise on infringement and had unreasonably refused to admit proof of publication of certain documents). See also *Connaught Laboratories Inc's Patent* [1999] FSR 284 (indemnity costs against patentee who belatedly surrendered patent during revocation proceedings).

15 In any transaction, instrument or event to which the Patents Act 1977 s 33 applies: see PARAS 588-589. These include certain assignments, mortgages, grants, vestings and transfers.

16 As to the meaning of 'exclusive licence' see PARA 380.

17 Patents Act 1977 s 68 (amended by SI 2006/1028). Prior to amendment the penalty for non-registration was the inability to recover damages or an account of profits. See also PARA 521 note 1. See *Minnesota Mining & Manufacturing Co v Rennicks (UK) Ltd* [1992] RPC 331 at 366; *Insituform Technical Services Ltd v Inliner UK plc* [1992] RPC 83 at 105; *Bondax Carpets Ltd v Advance Carpet Tiles* [1993] FSR 162; *Mölnlycke AB v Procter & Gamble Ltd (No 5)* [1994] RPC 49 at 136, CA. Where an exclusive licence replaces an earlier one, the later one must also be registered: *Spring Form Inc v Toy Brokers Ltd* [2002] FSR 276. See also *LG Electronics Inc v NCR Financial Solutions Group Ltd* [2003] FSR 428.

18 See eg *Quantel Ltd v Spaceward Microsystems Ltd (No 2)* [1990] RPC 147, CA (detailed assessment stayed on the defendant paying a very substantial sum into a joint account).

19 *British Thomson-Houston Co Ltd v Marconi's Wireless Telegraph Co Ltd, Electric and Musical Instruments Ltd v Guildford Radio Stores and EK Cole Ltd* (1938) 55 RPC 71 at 94; *Heginbotham Bros Ltd v Burne* (1939) 56 RPC 87 at 96.

UPDATE

553 Costs

NOTE 12--As to the making of an issue-based costs award see *Actavis UK Ltd v Novartis AG* [2009] EWHC 502 (Ch), [2009] All ER (D) 205 (Mar).

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554. Estoppel and abuse of process.

Where the issue of validity has been determined in the claimant's favour and a subsequent claim is brought against the same defendant, the defendant may be estopped, as a defence to the proceedings, from challenging validity even on new materials¹. If the issue of validity has been determined in favour of the patentee but the patent is subsequently revoked at the instance of a third party, the defendant is estopped from challenging any order as to damages which has already been made². Similarly, if the issue of validity has been decided against the claimant, he cannot bring a fresh claim against the defendant until the patent has been amended³. However, no decision of the comptroller (or on appeal from him)⁴ estops any party to civil proceedings in which infringement of a patent is in issue from alleging⁵ invalidity of that patent, whether or not any of the issues were decided in that decision⁶.

A decision as to infringement only creates an estoppel⁷ where the articles in question in the two claims are practically identical⁸; and the fact that the patent was broadly interpreted in the first proceedings does not prevent the defendant from contending in the second proceedings for a different construction⁹. However, it may be an abuse of process to bring a second action in respect of a different article which could have been the subject of the first action¹⁰.

An assignor may not dispute validity against his assignee¹¹. This is, however, now subject to the provisions of the EC Treaty relating to anti-competitive practices¹².

1 *Moore v Thomson* (1890) 7 RPC 325, HL; *Shoe Machinery Co Ltd v Cutlan* [1896] 1 Ch 667, 13 RPC 141; *Dunlop Pneumatic Tyre Co Ltd v Rimington Bros & Co Ltd* (1900) 17 RPC 665, CA; *Brown v Hastie & Co Ltd* (1906) 23 RPC 361, HL.

2 See PARA 570 text and note 1.

3 *Re Deeley's Patent* (1894) 11 RPC 72; *Horrocks v Stubbs* (1895) 12 RPC 540.

4 As to the comptroller see PARA 577; and as to appeals from him see PARA 573.

5 I.e. on any of the grounds referred to in the Patents Act 1977 s 72(1): see PARA 564.

6 Patents Act 1977 s 72(5).

7 As to estoppel generally see **ESTOPPEL** vol 16(2) (Reissue) PARA 951 et seq.

8 *Thomson v Hughes* (1890) 7 RPC 71; *Moore v Thomson* (1890) 7 RPC 325, HL.

9 *Brown v Hastie & Co Ltd* (1906) 23 RPC 361, HL. See also *Dudgeon v Thomson* (1877) 3 App Cas 34, HL.

10 *Building Product Design Ltd v Sandtoft Roof Tiles Ltd (No 2)* [2004] FSR 834.

11 *Oldham v Langmead* (1789) Dav Pat Cas 157; *Walton v Lavater* (1860) 29 LJCP 275 at 279; *Chambers v Crichley* (1864) 33 Beav 374; *Franklin Hocking & Co Ltd v Hocking* (1887) 4 RPC 255 (affd 4 RPC 434, CA; revsd (1888) 6 RPC 69, HL); *Gonville v Hay* (1903) 21 RPC 49. Such estoppel does not apply to a partner of the assignor, at any rate, if not such at the time of assignment (*Axmann v Lund* (1874) 43 LJ Ch 655; *Heugh v Chamberlain* (1877) 25 WR 742; *Cropper v Smith* (1884) 26 ChD 700, 1 RPC 81 at 89, CA (on appeal (1885) 10 App Cas 249, HL)), nor where the assignment has been from the patentee's trustee in bankruptcy (*Cropper v Smith*).

12 See PARA 375 note 4.

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555. Infringement proceedings before the comptroller.

The proprietor of a patent¹ and any other person may by agreement with each other refer to the comptroller² the question whether that other person has infringed the patent³, although the only relief which may be claimed on the reference is damages⁴ and a declaration⁵ that the patent is valid and has been infringed by that person⁶. If the comptroller awards any sum by way of damages on a reference then the sum is recoverable, if a county court so orders, by execution issued from the county court or otherwise as if it were payable under an order of that court⁷.

If it appears to the comptroller on a reference⁸ that the question referred to him would more properly be determined by the court⁹, he may decline to deal with it and the court has jurisdiction to determine the question as if the reference were proceedings brought in the court¹⁰.

A decision of the comptroller in respect of a patent, or on appeal from the comptroller, does not estop any party to civil proceedings in which infringement of a patent is in issue from alleging invalidity on any ground on which a patent may be revoked¹¹, whether or not any of the issues involved were decided in the decision¹².

1 See PARA 307 et seq.

2 As to the comptroller see PARA 577. Leave is required in certain cases: see PARA 520. As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

3 Patents Act 1977 s 61(3). Except so far as the context requires, in the Patents Act 1977 ss 62-132: (1) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under s 61(3) and the making of such a reference; (2) any reference to a claimant or pursuer includes a reference to the proprietor of the patent; and (3) any reference to a defendant or defender includes a reference to any other party to the reference: s 61(4) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 14).

4 Ie under the Patents Act 1977 s 61(1)(c), (3): see PARA 523.

5 Ie under the Patents Act 1977 s 61(1)(e), (3): see PARA 523.

6 Patents Act 1977 s 61(3).

7 Patents Act 1977 s 61(7)(a) (added by the Patents Act 2004 s 11). As from a day to be appointed, the Patents Act 1977 s 61(7)(a) is amended to provide that the county court may make an order under the County Courts Act 1984 s 85: see s 61(7)(a) (prospectively amended by the Tribunals, Courts and Enforcement Act 2007 s 62(3), Sch 13 paras 39, 41). At the date at which this volume states the law no such day had been appointed.

8 Ie a reference under the Patents Act 1977 s 61(3): see the text and notes 1-6.

9 As to the meaning of 'court' see PARA 637 note 1.

10 Patents Act 1977 s 61(5).

11 Ie any of the grounds referred to in the Patents Act 1977 s 72(1): see PARA 564.

12 Patents Act 1977 s 72(5).

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(3) DECLARATION OF NON-INFRINGEMENT

556. Proceedings for declaration of non-infringement.

Without prejudice to any other jurisdiction to make a declaration¹, the court² has power, in proceedings between any person and the proprietor of, or an exclusive licensee under³, a patent, to make a declaration that an act does not or a proposed act would not constitute an infringement of the patent⁴, and may do so notwithstanding that no assertion to the contrary has been made by the proprietor or licensee⁵, if it is shown that:

- 338 (1) that person has applied in writing to the proprietor of the patent or licensee for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question⁶; and
- 339 (2) the proprietor or licensee has refused or failed to give any such acknowledgment⁷.

Validity may be put in issue in the proceedings⁸, which becomes in substance, apart from the special relief asked for, a claim for infringement in reverse.

The proceedings may in the alternative be brought before the comptroller⁹.

1 See *SJ Filhol Ltd v Fairfax (Dental Equipment) Ltd* [1990] RPC 293; *Vax Appliances Ltd v Hoover plc* [1990] RPC 656. This is limited to acts within the United Kingdom: *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co* [1995] RPC 438.

2 As to the meaning of 'court' see PARA 637 note 1.

3 See the Patents Act 1977 s 67(1); and PARA 521. As to the meaning of 'exclusive licensee' see PARA 380 note 7. See also PARA 521 note 1.

4 The burden of proof is on the person alleging non-infringement: *Mallory Metallurgical Products Ltd v Black Sivalis and Bryson Inc* [1977] RPC 321 at 345; *Rohm & Haas Co v Collag Ltd* [2001] EWCA Civ 1589, [2002] FSR 445 at 454.

5 Patents Act 1977 s 71(1). The court does not normally have jurisdiction to refuse a declaration: see *Henry Showell Ltd v Rodi and Wienenberger AG* (1966) 110 Sol Jo 286, [1966] RPC 441, CA. The consent of the patentee to proceedings under the Patents Act 1977 s 71 is not necessary: *Hawker Siddeley Dynamics Engineering Ltd v Real Time Developments Ltd* [1983] RPC 395 at 399 obiter per Whitford J. The court's general jurisdiction to make a declaration arises only in respect of an infringement which takes place within the United Kingdom, and only once the patent holder has claimed that an infringement has occurred: *Plastus Kreativ AB v Minnesota Mining and Manufacturing Co* [1995] RPC 438. The general jurisdiction cannot be invoked where the assertion of right is made in without-prejudice negotiations: *Unilever plc v Proctor & Gamble Co* [2001] 1 All ER 783, [2000] FSR 344, CA.

6 Patents Act 1977 s 71(1)(a). There is no obligation to furnish a specimen in addition to written particulars: *Plasticisers Ltd v Pixdane Ltd* [1979] RPC 327.

7 Patents Act 1977 s 71(1)(b).

8 Patents Act 1977 s 74(1)(c). The only grounds on which validity of a patent may be put in issue are the grounds on which the patent may be revoked under s 72 (see PARA 564): s 74(3). See further PARA 520.

9 Patents Act 1977 s 71(1). There is no appeal on fact from the comptroller's decision, beyond the Patents Court: see s 97(3); and PARA 573. As to the comptroller see PARA 577. A decision of the comptroller on validity in

such proceedings is not fully conclusive (see s 72(5); and PARA 555) although he may grant a certificate of contested validity (see PARA 551). Subject to s 72(5), a declaration made by the comptroller under s 71(1) has the same effect as a declaration by the court: s 71(2). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

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(4) PROCEEDINGS FOR THREATS

557. Proceedings for groundless threats.

Where any person, whether or not the proprietor of or entitled to any right in a patent, by circulars, advertisements or otherwise¹ threatens² another person with proceedings for any infringement of a patent, a person aggrieved³ by the threats⁴, whether or not he is the person to whom they are made, may bring proceedings in the court⁵ against him⁶. Such proceedings may not, however, be brought for: (1) a threat to bring proceedings for an infringement of a patent alleged to consist of making or importing a product for disposal or of using a process⁷; or (2) a threat, made to a person who has made or imported a product for disposal or used a process, to bring proceedings for an infringement alleged to consist of doing anything else in relation to that product or process⁸.

In any such proceedings the claimant is entitled to the relief claimed, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them⁹. However, if the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent: (a) the claimant is entitled to the relief claimed only if he shows that the patent alleged to be infringed is invalid in a relevant respect; (b) even if the claimant does show that the patent is invalid in a relevant respect, he is not entitled to the relief claimed if the defendant proves that at the time of making the threats he did not know and had no reason to suspect that the patent was invalid in that respect¹⁰. The mere commencement by the defendant of infringement proceedings does not, however, bar the claimant's claim¹¹.

1 As to the meaning of this expression see PARA 560 note 4.

2 To circulate threats by others is not to threaten, but may nevertheless be restrained by injunction: see *Ellam v HF Martyn & Co* (1898) 68 LJ Ch 123, 16 RPC 28, CA.

3 As to who is aggrieved see PARA 560.

4 As to what constitutes a threat see PARA 559.

5 As to the meaning of 'court' see PARA 637 note 1.

6 Patents Act 1977 s 70(1). See also PARA 521 note 1. A party who has been threatened, whether directly or indirectly, does not need to prove damage in order to qualify to sue under s 70: *Brain v Ingledew Brown Bennison and Garrett (No 3)* [1997] FSR 511. As to the relief available see PARA 562. The validity of the patent may be put in issue in proceedings under s 70 (s 74(1)(b)), but only on one of the grounds on which the patent might be revoked under s 72 (see PARA 564) (s 74(3)). See further PARA 520.

7 Patents Act 1977 s 70(4)(a) (s 70(4) substituted by the Patents Act 2004 s 12(1), (3)); *Therm-a-Stor Ltd v Weatherseal Windows Ltd* [1981] FSR 579, CA. This exception extends to the making or importing of means essential for putting the invention into effect, thus making suppliers of components to a primary infringer susceptible to threats: *Therm-a-Stor Ltd v Weatherseal Windows Ltd*. The protection of the Patents Act 1977 s 70(4) may not be available, however, if the threats go wider than in respect of importation or manufacture for disposal and extend to articles already in existence: *Neild v Rockley* [1986] FSR 3; *Bowden Controls Ltd v Acco Cable Controls Ltd* [1990] RPC 427.

8 Patents Act 1977 s 70(4)(b) (as substituted: see note 7).

9 Patents Act 1977 s 70(2) (substituted by the Patents Act 2004 s 12(1), (2)). The patent infringed is not necessarily every patent mentioned in the threat: *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd* [1960] RPC 59 at 62, CA.

10 Patents Act 1977 s 70(2A) (added by the Patents Act 2004 s 12(1), (2)). The question whether the defence is available to the person making the threats is to be determined at trial and not at an interim stage: *Brain v Ingledew Brown Bennison and Garrett (No 2)* [1997] FSR 271.

11 *Cerosa Ltd v Poseidon Industrie AB* [1973] RPC 882. It is normal for a threats claim to be met by a counterclaim for relief for infringement, whether or not the making of the threat is admitted: see PARA 563.

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558. Remedy at common law.

The making of false statements about existing proceedings or goods, whilst not in itself an actionable threat¹, may be actionable at common law if the statements are malicious².

¹ *Surridge's Patents Ltd v Trico-Folberth Ltd* [1936] 3 All ER 26, 53 RPC 420.

² See *Mentmore Manufacturing Co Ltd v Fomento (Sterling Area) Ltd* (1955) 72 RPC 157, CA; *Jaybeam Ltd v Abru Aluminium Ltd* [1976] RPC 308; and see **LIBEL AND SLANDER** vol 28 (Reissue) PARA 274.

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559. What constitutes a threat.

The question whether what was done was a threat is one of fact. The essential of a threat is an indication that the maker has rights, and intends to enforce them¹. A person does not threaten another person with proceedings for infringement of a patent if he merely: (1) provides factual information about the patent; (2) makes inquiries of the other person for the sole purpose of discovering whether, or by whom, the patent has been infringed²; or (3) makes an assertion about the patent for the purpose of any inquiries so made³. It may be said generally that it is sufficient that the statement complained of would be reasonably believed by the person to whom it was addressed to be a threat of proceedings for infringement of a patent⁴, even though no reference is in fact made to any such proceedings⁵. The nature of the interview at which statements are made is relevant in considering whether they amount to threats⁶. The alleged threat must in some way point to the articles or class of articles manufactured or used by the claimant. A general statement that the proprietor of the patent will protect his rights, or that action will be taken against infringers is not sufficient⁷; but the form is unimportant if the document read as a whole would be understood as a threat⁸, and this may be so even if the document is in form a general warning⁹; and more especially is this the case if the document has been sent to customers of the claimant¹⁰. The state of the defendant's knowledge of the relations between the claimant and the person receiving the threats may be material¹¹. A communication may threaten a person other than the person to whom it is made¹².

It is not necessary that the alleged threat should refer to what is actually happening; there may be a threat of proceedings in some future event. For example, a statement that, if a particular machine should be manufactured, it would infringe a particular patent might constitute a threat¹³.

1 A threats action may not be brought in respect of threats made in genuine without-prejudice negotiations: *Schering Corp'n v CIPLA Ltd* [2004] EWHC 2587 (Ch), [2005] FSR 575; *Kooltrade Ltd v XTS Ltd* [2001] FSR 158. See *Rosedale Associated Manufacturers Ltd v Airfix Products Ltd* [1956] RPC 360 at 363 (on appeal [1957] RPC 239, CA, the point did not arise), a case decided under the corresponding provisions of the Registered Designs Act 1949 s 26 (see PARA 772); *Willis and Bates Ltd v Tilley Lamp Co* (1943) 61 RPC 8 at 11; *C and P Development Co (London) Ltd v Sisabro Novelty Co Ltd* (1953) 70 RPC 277 at 282, CA; *Unilever plc v Proctor & Gamble Co* [2001] 1 All ER 783, [2000] 1 WLR 2436, CA; *Kooltrade Ltd v XTS Ltd* [2001] FSR 158.

2 As mentioned in the Patents Act 1977 s 70(4)(a): see PARA 557.

3 Patents Act 1977 s 70(5) (substituted by the Patents Act 2004 s 12(1), (4)). See *Paul Trading Co Ltd v J Marksmith & Co Ltd* (1952) 69 RPC 301. See also PARA 521 note 1.

4 *C and P Development Co (London) Ltd v Sisabro Novelty Co Ltd* (1953) 70 RPC 277 at 280, 282, CA.

5 *Luna Advertising Co v Burnham & Co* (1928) 45 RPC 258.

6 *Paul Trading Co Ltd v J Marksmith & Co Ltd* (1952) 69 RPC 301 at 304, citing *Surridge's Patent's Ltd v Trico-Folberth Ltd* [1936] 3 All ER 26 at 29-30, 53 RPC 420 at 423-424.

7 *Brauer v Sharp* (1886) 3 RPC 193 at 197; *Dick v Haslam* (1891) 8 RPC 196; *Willoughby v Taylor* (1893) 11 RPC 45; *Crowther v United Flexible Metallic Tubing Co Ltd* (1905) 22 RPC 549; *WH Howson Ltd v Algraphy Ltd* [1965] RPC 183; *Speedcranes Ltd v Thomson* 1972 SC 324, [1978] RPC 221.

8 *Kurtz & Co v Spence & Sons* (1887) 57 LJ Ch 238 at 247, 5 RPC 161 at 173; *Johnson v Edge* [1892] 2 Ch 1, 9 RPC 142, CA; *Douglass v Pintsch's Patent Lighting Co* [1897] 1 Ch 176, 13 RPC 673; *Craig v Dowding* (1908)

98 LT 231, 25 RPC 259, CA; *Cars v Bland Light Syndicate Ltd* (1910) 28 RPC 33; *Luna Advertising Co v Burnham & Co* (1928) 45 RPC 258.

9 Eg if there are words in the warning which would point to the claimant's articles: see *Boneham and Hart v Hirst Bros & Co Ltd* (1917) 34 RPC 209.

10 *Johnson v Edge* [1892] 2 Ch 1, 9 RPC 142, CA.

11 *Weldrics Ltd v Quasi-Arc Co Ltd* (1922) 39 RPC 323. It has been said that it is for the defendant to show that the threats were not directed against the claimant: *Johnson v Edge* [1892] 2 Ch 1, 9 RPC 142, CA, per Lindley LJ.

12 *John Summers & Sons Ltd v Cold Metal Process Co* (1947) 65 RPC 75 at 96-97. See also *Brain v Ingledew Brown Bennison and Garrett (No 3)* [1997] FSR 511.

13 *Kurtz v Spence* (1887) 36 ChD 770, 4 RPC 427, CA, explaining *Challender v Royle* (1887) 36 ChD 425 at 442, 4 RPC 363 at 375, CA; *Desiderio v Currus Ltd* (1935) 52 RPC 201. See also *Johnson v Edge* [1892] 2 Ch 1, 9 RPC 142, CA, per Lindley LJ; *Skinner & Co v Shew & Co* [1893] 1 Ch 413, sub nom *Skinner & Co v Perry* 10 RPC 1, CA. As to threats of proceedings if a patent should be granted see *Lebel Products Ltd v W Steel & Co Ltd* (1955) 72 RPC 115 (arguable question, whether justification possible).

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560. To whom threats may be addressed.

A threat may be either addressed to the claimant¹, or to his customers², or to manufacturers³, or may be simply published to the world in general⁴. It may be contained in a solicitor's letter⁵, or in a statement without prejudice⁶, or in an answer to inquiries⁷. An ordinary solicitor's letter before action will usually constitute a threat, but, if a claim form follows within a reasonable time⁸ and the recipient does not comply with the demands in the letter, the recipient is unlikely to be a person aggrieved by the threat⁹. A threat from solicitors comes with more force than a threat from a layman¹⁰. An oral threat is actionable¹¹, but a mere notification of the existence of a patent is not¹². Where the threat is to some person other than the claimant, the claimant must show that his trade has been adversely affected¹³.

1 *Driffield and East Riding Pure Linseed Cake Co v Waterloo Mills Cake and Warehousing Co* (1886) 31 ChD 638, 3 RPC 46; *Horne v Johnston Bros* (1921) 38 RPC 366.

2 *Burt v Morgan & Co Ltd* (1887) 3 TLR 666, 4 RPC 278; *Hoffnung & Co v Salsbury* (1899) 16 RPC 375; *Craig v Dowding* (1908) 25 RPC 1 (revsd 25 RPC 259, CA). See also *Speedcranes Ltd v Thomson* 1972 SC 324, [1978] RPC 221; *Bowden Controls Ltd v Acco Cable Controls Ltd* [1990] RPC 427.

3 *Willoughby v Taylor* (1893) 11 RPC 45; *Webb v Levinstein & Co Ltd* (1898) 15 RPC 78. See also *Bowden Controls Ltd v Acco Cable Controls Ltd* [1990] RPC 427.

4 *Johnson v Edge* [1892] 2 Ch 1, 9 RPC 142, CA. The Patents Act 1977 s 70(1) (see PARA 557) refers to threats by circulars, advertisements or otherwise, but the last word is not to be construed as ejusdem generis with the former: *Skinner & Co v Shew & Co* [1893] 1 Ch 413; sub nom *Skinner & Co v Perry* 10 RPC 1, CA, applied in *Speedcranes Ltd v Thomson* 1972 SC 324, [1978] RPC 221. Bringing proceedings against customers without joining the alleged primary infringer may be vexatious and an abuse of the process of the court: *Jacey (Printers) v Norton and Wright Group Ltd* [1977] FSR 475.

5 *Crampton v Patents Investment Co* (1888) 5 RPC 382 at 393 (affd (1889) 6 RPC 287, CA); *Combined Weighing and Advertising Co v Automatic Weighing Machine Co* (1889) 42 ChD 665, 6 RPC 502; *Engels v Hubert Unchangeable Eyelet Syndicate Ltd* (1902) 19 RPC 201, CA; but see *Day v Foster* (1890) 43 ChD 435, 7 RPC 54; *Earles Utilities Ltd v Harrison* (1934) 52 RPC 77. See also *Cerosa Ltd v Poseidon Industrie AB* [1973] RPC 882.

6 *Kurtz & Co v Spence & Sons* (1887) 57 LJ Ch 238 at 242, 5 RPC 161 at 173.

7 *Skinner & Co v Shew & Co* [1893] 1 Ch 413, sub nom *Skinner & Co v Perry* 10 RPC 1, CA.

8 If not, the threat is actionable: *Driffield and East Riding Pure Linseed Cake Co v Waterloo Mills Cake and Warehousing Co* (1886) 31 ChD 638, 3 RPC 46.

9 *Benmax v Austin Motor Co Ltd* (1953) 70 RPC 143 at 151, 157; on appeal 70 RPC 284 at 295, CA; although neither court had occasion actually to decide the point. If the recipient does comply with the demands in the letter, damages may be very heavy.

10 *HVE (Electric) Ltd v Cufflin Holdings Ltd* [1964] 1 All ER 674, [1964] 1 WLR 378, CA.

11 *Ellis & Sons v Pogson* (1922) 40 RPC 62 (affd [1923] 2 Ch 496, 40 RPC 179, CA); *Luna Advertising Co v Burnham & Co* (1928) 45 RPC 258.

12 See the Patents Act 1977 s 70(5); and PARA 559.

13 *Reymes-Cole v Elite Hosiery Co Ltd* [1965] RPC 102, CA.

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561. Who may be liable.

A claim lies against the person who makes the threat, whether or not he is a proprietor of a patent, for example a solicitor¹, but a mere statement by a solicitor that he would advise his client to bring infringement proceedings is not a threat².

In proceedings³ for threats made by one person (A) to another (B) in respect of an alleged infringement of a patent for an invention, it is a defence for A to prove that he used his best endeavours, without success, to discover⁴:

- 340 (1) where the invention is a product, the identity of any person who made or, in the case of an imported product, imported it for disposal⁵;
- 341 (2) where the invention is a process and the alleged infringement consists of offering it for use, the identity of a person who used the process⁶;
- 342 (3) where the invention is a process and the alleged infringement consists of disposing or offering to dispose of, use or import any product obtained directly by means of that process or keeping any such product⁷, the identity of the person who used the process to produce the product in question⁸,

and that he notified B accordingly, before or at the time of making the threats, identifying the endeavours used⁹.

1 See eg *Brain v Ingledew Brown Bennison and Garrett* [1996] FSR 341, CA.

2 *Earles Utilities Ltd v Harrison* (1934) 52 RPC 77. See *Reckitt Benkiser UK v Home Pairfum Ltd* [2004] EWHC 302 (Pat), [2004] FSR 774 (defendants refused leave to join claimant's solicitors to the threats counterclaim).

3 Ie under the Patents Act 1977 s 70: see PARAS 557, 559.

4 Patents Act 1977 s 70(6) (added by the Patents Act 2004 s 12(1), (5)).

5 Patents Act 1977 s 70(6)(a) (as added: see note 4).

6 Patents Act 1977 s 70(6)(b) (as added: see note 4).

7 Ie an act falling within the Patents Act 1977 s 60(1)(c): see PARA 512.

8 Patents Act 1977 s 70(6)(c) (as added: see note 4).

9 Patents Act 1977 s 70(6) (as added: see note 4).

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562. Relief for actionable threats.

Unless the defendant proves the facts necessary to constitute a defence¹, the claimant in proceedings for groundless threats² is entitled, subject always to the court's discretion³, to:

- 343 (1) a declaration to the effect that the threats are unjustifiable⁴;
- 344 (2) an injunction against the continuance of the threats⁵; and
- 345 (3) damages in respect of any loss which the claimant has sustained by the threats⁶.

Such damages may include, for example, the loss of particular orders or of trade generally⁷, loss of seasonal trade or delay in putting goods on the market⁸, or the loss of an opportunity of disposing of a patent⁹ or of making future sales¹⁰, but not the cost of defending, or preparing to defend, a subsequent claim for infringement¹¹.

An interim injunction may be granted¹², but this will not usually be done where the defendant alleges infringement¹³. Where the threat was in wide terms, an injunction in wide terms will be granted¹⁴.

1 Ie under the Patents Act 1977 s 70(2A) (see PARA 557) or s 70(6) (see PARA 561).

2 Ie under the Patents Act 1977 s 70(1): see PARA 557.

3 *Benmax v Austin Motor Co Ltd* (1953) 70 RPC 284 at 295-296, CA (on appeal on other issues [1955] AC 370, [1955] 1 All ER 326, 72 RPC 39, HL); *Tudor Accessories Ltd v JN Somers Ltd* [1960] RPC 215; *HVE (Electric) Ltd v Cufflin Holdings Ltd* [1964] 1 All ER 674, [1964] 1 WLR 378, CA.

4 Patents Act 1977 s 70(3)(a). See also PARA 521 note 1.

5 Patents Act 1977 s 70(3)(b).

6 Patents Act 1977 s 70(3)(c) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 17). As to seeking to bring a new claim against new defendants where the original defendant went into liquidation leaving judgment for substantial damages unsatisfied see *Kooltrade Ltd v XTS Ltd* [2002] FSR 764.

7 *Ratcliffe v Evans* [1892] 2 QB 524, CA.

8 *Earles Utilities Ltd v Jacobs* (1934) 51 TLR 43, 52 RPC 72.

9 *Skinner & Co Ltd v Shew & Co* [1894] 2 Ch 581, sub nom *Skinner & Co v Perry* 11 RPC 406; *Solanite Signs Ltd v Wood* (1933) 50 RPC 315.

10 *Kooltrade Ltd v XTS Ltd* [2001] FSR 158 at 168.

11 *Benmax v Austin Motor Co Ltd* (1953) 70 RPC 143 at 157; on appeal 70 RPC 284 at 295, CA.

12 *Boneham and Hart v Hirst Bros & Co Ltd* (1917) 34 RPC 209; *Luna Advertising Co v Burnham & Co* (1928) 45 RPC 258; *HVE (Electric) Ltd v Cufflin Holdings Ltd* [1964] 1 All ER 674, [1964] 1 WLR 378, CA; *Bowden Controls Ltd v Acco Cable Controls Ltd* [1990] RPC 427.

13 *Stringer v Platnauer Ltd* (1932) 50 RPC 61; *Cabaret Electric Co Ltd v Marconi's Wireless Telegraph Co Ltd* (1934) 52 RPC 104. See to the contrary *International Sales Ltd v Trans-Continental Trading Co Ltd and Benno Maisel* (1934) 52 RPC 107; *Cerosa Ltd v Poseidon Industrie AB* [1973] RPC 882.

- 14 See *Mechanical Services (Trailer Engineering) Ltd v Avon Rubber Co Ltd* [1977] RPC 66.

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563. Procedure.

A defendant who seeks to justify the threats, and is interested in the patent said to be infringed, may counterclaim for relief for infringement, and the claimant may then counterclaim to the counterclaim for revocation of the patent¹. If justification is pleaded, whether or not there are counterclaims, the procedure follows that of a normal infringement action². In general a claimant has the right to begin; but, if the threats are admitted, the proprietor of the patent will begin, as in ordinary infringement proceedings³.

¹ *Lewis Falk Ltd v Jacobwitz* [1944] Ch 64, 61 RPC 116 (design); *John Summers & Sons Ltd v Cold Metal Process Co* (1947) 65 RPC 75.

² For example, a defendant alleging that threats were justified must give particulars of acts of the claimant relied on as constituting an infringement: *Reymes-Cole v Elite Hosiery Co Ltd* [1961] RPC 277. Since a defendant usually justifies if the issue of threats is in doubt, a claim of this sort is often used to enable a possible infringer to bring questions of validity and infringement before the court.

³ *Crompton v Patents Investment Co* (1888) 5 RPC 382 (affd (1889) 6 RPC 287, CA); *Lewis Falk Ltd v Jacobwitz* [1944] Ch 64, 61 RPC 116; *W Lusty & Sons Ltd v Morris Wilkinson & Co (Nottingham) Ltd* [1954] 2 All ER 347, [1954] 1 WLR 911, 71 RPC 174 (registered design).

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(5) PROCEEDINGS FOR REVOCATION

564. Application to the court for revocation of patent.

The court¹ may revoke a patent on the application of any person² on, but only on, any of the following grounds³:

- 346 (1) that the invention is not a patentable invention⁴;
- 347 (2) that the patent was granted to a person who was not entitled⁵ to be granted that patent⁶;
- 348 (3) that the specification⁷ does not disclose the invention clearly and completely enough for it to be performed by a person skilled in the art⁸;
- 349 (4) that the matter disclosed in the specification extends beyond that disclosed in the application for the patent, as filed⁹, or, if the patent was granted on a new application¹⁰, in the earlier application, as filed¹¹;
- 350 (5) that the protection conferred by the patent has been extended by an amendment¹² which should not have been allowed¹³.

Where the validity of a patent is challenged, the statement of case must contain particulars of the relief sought and the issues except those relating to validity¹⁴. The statement of case must have a separate document annexed to it headed 'Grounds of Invalidity' specifying the grounds on which validity of the patent is challenged¹⁵.

The order made may be an order for the unconditional revocation of the patent or, where it is determined that one of the grounds mentioned above has been established, but only so as to invalidate the patent to a limited extent, an order that the patent be revoked unless within a specified time the specification is amended¹⁶ to the court's satisfaction¹⁷.

1 As to the meaning of 'court' see PARA 637 note 1.

2 See *Cairnstores Ltd v Aktiebolaget Hassle* [2002] FSR 564, [2001] All ER (D) 212 (Mar).

3 Patents Act 1977 s 72(1) (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 18, Sch 3). These are the only grounds on which the validity of a patent may be put in issue, whether in revocation proceedings or otherwise: Patents Act 1977 s 74(3); and see PARA 520. As to validity generally see PARA 426 et seq.

4 Patents Act 1977 s 72(1)(a); and see PARA 431. As to the meaning of 'patentable invention' see PARA 430 note 2.

5 I.e. under the Patents Act 1977 s 7(2): see PARA 307.

6 Patents Act 1977 s 72(1)(b) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 18); and see PARA 489. An application for revocation on this ground may only be made by a person found by the court in an action for a declaration, or found by the court or the comptroller on a reference under the Patents Act 1977 s 37 to determine entitlement after a grant (see PARA 366), to be entitled to be granted either that patent or a patent for part of the matter comprised in the specification of the patent sought to be revoked: s 72(2)(a). Such an application may not be made if that action was commenced or that reference was made after the end of the period of two years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as its proprietor knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent: s 72(2)(b).

- 7 As to specifications see PARA 319 et seq.
- 8 Patents Act 1977 s 72(1)(c); and see PARA 490.
- 9 As to the filing of the application see PARA 318.
- 10 le filed under the Patents Act 1977 s 8(3) (see PARA 362), s 12 (see PARA 364) or s 37(4) (see PARA 366) or as mentioned in s 15(9) (see PARA 317).
- 11 Patents Act 1977 s 72(1)(d) (amended by SI 2004/2357); and see PARA 498.
- 12 As to amendment see PARA 346 et seq.
- 13 Patents Act 1977 s 72(1)(e); and see PARA 499.
- 14 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 11.2(1).
- 15 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 11.2(2). As to Grounds of Invalidity see PARA 532.
- 16 The reference to the specification being amended is to its being amended under the Patents Act 1977 s 75 (see PARA 347) and also, in the case of a European patent (UK), to its being amended under any provision of the European Patent Convention under which the claims of the patent may be limited by amendment at the request of the proprietor: s 72(4A) (added by the Patents Act 2004 s 4). As to the meaning of 'European patent (UK)' see PARA 675 note 1. As to the European Patent Convention see PARA 668 et seq.
- 17 Patents Act 1977 s 72(4) (amended by the Patents Act 2004 ss 4, 16(2), Sch 3).

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565. Application to the comptroller for revocation of patent.

The comptroller¹ may revoke a patent on the application of any person on, but only on, any of the grounds² on which the court may revoke a patent³.

On the application the comptroller may order the unconditional revocation of the patent, or its revocation unless the specification is amended to his satisfaction within a specified time⁴. Where the comptroller refuses to grant an application so made to him, no application, otherwise than by way of appeal⁵ or by way of putting validity in issue in infringement proceedings, may be made to the court by the applicant in relation to the patent concerned without the leave of the court⁶. Where the comptroller has not disposed of such an application, the applicant may not apply to the court for revocation of the patent concerned unless the proprietor of the patent agrees that he may do so⁷ or the comptroller certifies in writing that it appears to him that the question whether the patent should be revoked is one which would more properly be determined by the court⁸. A decision of the comptroller or on appeal from him does not estop any party to civil proceedings in which infringement is in issue from alleging invalidity of the patent on any of the grounds on which revocation may be ordered, whether or not any of the issues involved were decided in that decision⁹.

1 As to the comptroller see PARA 577.

2 For these grounds see the Patents Act 1977 s 72(1); and PARA 564 heads (1)-(5).

3 Patents Act 1977 s 72(1) (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 18, Sch 3). As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARAS 600-608.

4 See the Patents Act 1977 s 72(4); and PARA 564. Where, prior to the comptroller's deciding the matter, the applicant for revocation withdraws from the proceedings, the public interest requires that the comptroller should himself consider the matter: *Abbott Laboratories (Chu's) Patent* [1992] RPC 487.

5 As to appeals see PARA 572 et seq.

6 Patents Act 1977 s 72(6).

7 Patents Act 1977 s 72(7)(a).

8 Patents Act 1977 s 72(7)(b). Where the comptroller certifies that the court should determine the question whether a patent should be revoked, any person seeking the court's determination of that question must issue a claim form within 14 days of the comptroller's decision: CPR 63.11(c).

9 Patents Act 1977 s 72(5).

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566. Parties.

All persons beneficially interested should be made parties to the application for revocation, and the court will insist on this being done if the interest appears on the register¹. All parties having an interest will usually be allowed to appear², but it is unnecessary to join persons whose interest has ceased.

1 *Re Avery's Patent* (1887) 36 ChD 307, 4 RPC 322, CA; cf *Reitzman v Grahame-Chapman and Derustit Ltd* (1950) 67 RPC 178 at 189, 196 (where there was a counterclaim for revocation, and the proprietor of the patent, who was not a party to the proceedings, was made a defendant to the counterclaim to enable the patent to be revoked). As to the register see PARA 585 et seq.

2 *Re Miller's Patent* (1898) 15 RPC 205, CA. In *Re Haddan's Patent* (1885) 2 RPC 218, where the proprietor of the patent had assigned after presenting the petition, the new patentee was allowed to be substituted as respondent. Licensees, even if sole licensees, are not entitled to appear: *Re Stahlwerk Becker AG's Patent* (1917) 35 RPC 81; affd 35 RPC 210, CA; (1918) 36 RPC 13, HL. Where the patentee is subject to an administration order, the revocation proceedings may not be continued without the consent of the administrators or leave of the court: *Re Axis Genetics plc (in administration)* [2000] FSR 448.

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567. Procedure.

Where the proprietor of the patent resides abroad, the claim form for revocation in certain circumstances may be served out of the jurisdiction without permission¹. Security for costs can be directed to be given by an applicant for revocation, but not by a respondent². A patent can only be revoked in open court³, but it may be so revoked by consent or on affidavit evidence⁴. A proprietor may also surrender his patent⁵. The burden of proof in revocation proceedings is on the applicant for revocation⁶, but the respondent is entitled to begin⁷ and to give evidence in support of the patent and, if the applicant gives evidence impeaching the validity of the patent, the respondent is entitled to reply⁸. Apart from the above points, the procedure is the same as in a claim for infringement⁹. Normally any order for revocation is made with costs, even where there is no opposition¹⁰.

As an applicant for revocation is considered to be acting in the public interest, neither he nor the proprietor of the patent is estopped by a decision in previous proceedings¹¹. An expired patent may be revoked¹².

1 A claim form may be served on a defendant out of the jurisdiction where the conditions set out in CPR 6.19 are satisfied (see **CIVIL PROCEDURE** vol 11 (2009) PARAS 168-169); applied by CPR 63.16(1). A claim form relating to a registered right may be served: (1) on a party who has registered the right at the address for service given for that right in the UK Intellectual Property Office register, provided the address is within the jurisdiction; or (2) in accordance with CPR 6.19(1) or (1A) (see **CIVIL PROCEDURE** vol 11 (2009) PARAS 168-169) on a party who has registered the right at the address for service given for that right in the appropriate register at the UK Intellectual Property Office or the Office for Harmonisation in the Internal Market: CPR 63.16(2). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 See CPR 25.13; and **CIVIL PROCEDURE** vol 11 (2009) PARA 746.

3 *Re Clifton's Patent* [1904] 2 Ch 357, 21 RPC 515.

4 Revocation by consent was made on the application as to mode of trial in *Re Simmons' Patent* (1895) 12 RPC 446.

5 See the Patents Act 1977 s 29; and PARA 359. It seems that the proprietor may not surrender to avoid revocation: see *O and M Kleeman Ltd v Rosedale Associated Manufacturers Ltd* (1954) 71 RPC 271 (registered design); *Connaught Laboratories Inc's Patent* [1999] FSR 284. See also *Dyson Ltd's Patent* [2004] RPC 473; *Dyson Ltd's Patent (No 2)* [2003] RPC 821.

6 See eg *Re Jameson's Patent* (1902) 19 RPC 246.

7 This right may be waived: see *Re Edmond's Patent* (1888) 6 RPC 355 at 357.

8 Where, in a claim for threats (see PARA 559 et seq), a counterclaim in respect of infringement was withdrawn but the claimants sought revocation of the patent, the defendants were held to have the right to begin on the issue of validity: *John Summers & Sons Ltd v Cold Metal Process Co* (1948) 65 RPC 75 at 83. In *Boehringer Mannheim GmbH v Genzyme Ltd* [1993] FSR 716, however, it was stated that it was right for the defendant to open the case when, in infringement proceedings, only validity was in issue.

9 As to the procedure generally in an infringement claim see PARA 521 et seq.

10 *Re Scott's Patent* (1903) 20 RPC 604. Where two respondents are served and are separately represented, each is entitled to costs, even though one may have taken no part in the case: *Re Brown's Patent* (1907) 24 RPC 313.

11 *Re Lewis and Stirckler's Patent* (1897) 14 RPC 24.

12 *John Summers & Sons Ltd v Cold Metal Process Co* (1948) 65 RPC 75 at 121.

UPDATE

567 Procedure

NOTE 1--CPR 63.16(2) amended by SI 2008/2178.

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568. Stay of proceedings where concurrent proceedings in European Patent Office.

A person contesting the validity of a European patent can bring both a claim for revocation in the English courts and opposition proceedings in the European Patent Office¹. The approach to a stay of proceedings in such cases differs from ordinary commercial proceedings as the possibility of parallel proceedings in the European Patent Office and national courts is inherent in the legal arrangements in the European Patent Convention². The discretion of the Patents Court to stay proceedings should be exercised to achieve a balance of justice in the particular case³.

1 *Unilin Beheer BV v Berry Floor NV* [2007] EWCA Civ 364, [2008] 1 All ER 156, [2007] FSR 635. See PARA 668 et seq.

2 *Glaxo Group Ltd v Genentech Inc* [2008] EWCA Civ 23, [2008] All ER (D) 282 (Jan), [2008] FSR 459. As to the European Patent Convention see PARA 668 et seq.

3 *Glaxo Group Ltd v Genentech Inc* [2008] EWCA Civ 23, [2008] All ER (D) 282 (Jan), [2008] FSR 459.

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569. Amendment of specification in revocation proceedings.

There may be amendment of the specification of a patent in any proceedings in which validity may be put in issue¹. If, in revocation proceedings, the court² decides that the patent is invalid, it may allow an application for leave to amend to be made to it, instead of revoking the patent³.

1 See the Patents Act 1977 s 75; and PARAS 347-348.

2 As to the meaning of 'court' see PARA 637 note 1.

3 See the Patents Act 1977 s 75(1) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 19). In general a post-trial amendment where the patentee seeks to introduce a different claim from those under attack at the trial will not be allowed: *Nikken Kosakusho Works v Pioneer Trading Co* [2005] EWCA Civ 906, [2006] FSR 41.

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570. Effect of revocation.

An order for revocation puts an end to an injunction. It does not, however, relate back so as to affect a claim for past royalties, or for damages under an order already made, whether such damages have been ascertained or not¹.

Once an order for revocation issues, it must be lodged with the comptroller², and the patent then ceases to exist³. The practice is, however, to suspend the order for revocation pending appeal.

1 *Poulton v Adjustable Cover and Boiler Block Co* [1908] 2 Ch 430, 25 RPC 661, CA; *Coflexip SA v Stolt Offshore MS Ltd (No 2)* [2004] EWCA Civ 213, [2004] FSR 708.

2 As to the comptroller see PARA 577.

3 *Deeley v Perkes* [1896] AC 496, 13 RPC 581, HL. Even if the judgment is reversed and the order discharged, the proprietor of the patent may be unable to recover damages for acts committed between the time the order was made and its discharge: *Cincinnati Grinders Inc v BSA Tools Ltd* (1931) 48 RPC 33 at 59, 86, CA.

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571. Revocation of patent by the comptroller on his own initiative.

If it appears to the comptroller¹ that an invention for which a patent has been granted formed part of the state of the art only by reason of its comprising matter contained in an application for another patent published on or after the priority date² of that invention³, he may on his own initiative by order revoke the patent, but must first notify the proprietor of the patent that it appears to him that the patent ought to be revoked and must give the proprietor opportunity, within three months of the notification, of making observations and of amending the specification⁴ of the patent⁵ appropriately⁶.

If it appears to the comptroller that a patent and a European patent (UK)⁷ have been granted for the same invention⁸ having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he must give the proprietor of the patent an opportunity of making observations and of amending the specification of the patent; and, if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification⁹ so as to prevent there being two patents in respect of the same invention, the comptroller must revoke the patent¹⁰. The comptroller must not, however, take such action¹¹:

- 351 (1) before:
- 17
- 27. (a) the end of the period for filing an opposition¹² to the European patent (UK) under the European Patent Convention¹³; or
- 28. (b) if later, the date on which opposition proceedings are finally disposed of;
- 18
- 352 and he must not then take any action if the decision is not to maintain the European patent or if it is amended so that there are not two patents in respect of the same invention¹⁴;
- 353 (2) if the European patent (UK) has been surrendered¹⁵ before the date on which the patent is to be treated¹⁶ as having been granted or, if proceedings for the surrender of the European patent (UK) have been begun before that date, until those proceedings are finally disposed of; and he must not then take any action if the decision is to accept the surrender of the European patent¹⁷.

Where, however, the conditions set out above for the revocation of a patent are satisfied, the comptroller must revoke it even though the European patent (UK) has ceased to exist through failure to pay the renewal fees¹⁸ or an offer to surrender it has been made¹⁹. The comptroller may maintain the patent only where the decision not to maintain the European patent is a decision of the European Patent Office²⁰ and not a voluntary decision of the proprietor²¹.

1 As to the comptroller see PARA 577.

2 As to the meaning of 'priority date' see PARA 311 note 6.

3 It formed part of the state of the art only by virtue of the Patents Act 1977 s 2(3): see PARA 435.

4 As to the specification see PARA 319 et seq.

5 le so as to exclude any matter which formed part of the state of the art by virtue of the Patents Act 1977 s
2(3) without contravening s 76 (amendments not to include added matter: see PARA 352).

6 Patents Act 1977 s 73(1). The validity of a patent is not put in issue merely because the comptroller is
considering its validity in order to decide whether to revoke it under s 73: see s 74(8); and PARA 520.

7 As to the meaning of 'European patent (UK)' see PARA 675 note 1.

8 le if the claims of the United Kingdom patent and the European patent cover the same invention, whatever
other linked inventions may be covered by the claims of either patent: *Marley Roof Tile Co Ltd's Patent* [1994]
RPC 231 at 241, CA. Thus a claim to a product having a particular composition and particular qualities and a
claim to that product made by a particular process are claims to the same invention: *Marley Roof Tile Co Ltd's
Patent*. See also *Maag Gear Wheel and Machine Co Ltd's Patent* [1985] RPC 572.

9 See note 4.

10 Patents Act 1977 s 73(2) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para
19).

11 le action under the Patents Act 1977 s 73(2).

12 As to such opposition proceedings see PARA 673.

13 As to the European Patent Convention see PARA 668 et seq.

14 Patents Act 1977 s 73(3) (substituted by the Copyright, Designs and Patents Act 1988 Sch 5 para 19).

15 le under the Patents Act 1977 s 29(1): see PARA 359.

16 le by virtue of the Patents Act 1977 s 25(1): see PARAS 338-339.

17 Patents Act 1977 s 73(4) (substituted by the Copyright, Designs and Patents Act 1988 Sch 5 para 19).

18 *Citizen Watch Co Ltd's Patent* [1993] RPC 1.

19 *Turner & Newall Ltd's Patent* [1984] RPC 49.

20 As to the meaning of 'European Patent Office' see PARA 668 note 1.

21 *Citizen Watch Co Ltd's Patent* [1993] RPC 1.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(6) APPEALS/572. Rights of appeal from the Patents Court and the patents county court.

(6) APPEALS

572. Rights of appeal from the Patents Court and the patents county court.

In all proceedings in the Patents Court¹ or a patents county court² relating to infringement³, threats⁴ or revocation⁵, appeal lies, in the ordinary way, on a question of law or fact, to the Court of Appeal⁶ and thence, with leave, to the House of Lords⁷. In a proper case certified by the judge, appeal lies, with leave, direct from the Patents Court to the House of Lords⁸.

Subject to certain limitations appeal also lies to the Court of Appeal from a decision of the Patents Court on appeal from the comptroller⁹.

1 As to the Patents Court see PARA 637 et seq.

2 As to the patents county court see PARA 644 et seq.

3 As to infringement proceedings see PARA 521 et seq.

4 As to proceedings for groundless threats see PARA 557 et seq.

5 As to revocation proceedings see PARA 564 et seq.

6 As to appeals from the Patents Court see PARA 642; and as to appeals from a patents county court see PARA 651. As to the hearing of appeals generally see CPR 52.11; and **CIVIL PROCEDURE** vol 12 (2009) PARA 1672 et seq.

7 See the Appellate Jurisdiction Act 1876 s 3; and **COURTS** vol 10 (Reissue) PARA 360. As from a day to be appointed the appellate jurisdiction of the House of Lords is abolished and the Supreme Court of the United Kingdom is established: see Constitutional Reform Act 2005 Pt 3 (ss 23-60); and **COURTS** vol 10 (Reissue) PARA 601 et seq.

8 See the Administration of Justice Act 1969 ss 12, 13; and **COURTS** vol 10 (Reissue) PARA 361. Such appeals are known colloquially as 'leapfrog appeals'.

9 See PARA 573.

UPDATE

572 Rights of appeal from the Patents Court and the patents county court

NOTE 7--Appointed day is 1 October 2009: SI 2009/1604.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(6) APPEALS/573. Rights of appeal from the comptroller.

573. Rights of appeal from the comptroller.

Appeal lies to the Patents Court¹ from any decision of the comptroller² under the Patents Act 1977 or the Patents Rules 2007 relating to infringement or revocation³.

Appeal lies to the Court of Appeal from a decision of the Patents Court on such an appeal from the comptroller's decision only with the leave of the Patents Court or of the Court of Appeal⁴, and only where either the ground of appeal is that the decision of the Patents Court is wrong in law⁵ or the comptroller's decision was given under one of certain provisions⁶.

1 As to appeals from the comptroller to the Patents Court, and as to the procedure, see PARAS 639-640; and as to the Patents Court see PARA 637 et seq. The patents county court has no jurisdiction to hear appeals from the comptroller: see PARA 644 note 2. As to the patents county court see PARA 644 et seq.

2 As to the comptroller see PARA 577.

3 Patents Act 1977 s 97(1). There are exceptions in s 97(1)(a)-(d), but they do not concern infringement or revocation: see PARA 639. CPR Pt 52 applies to appeals from the comptroller: CPR 63.17(1). Patent appeals are made to the Patents Court: CPR 63.17(2). Where CPR Pt 52 requires a document to be served, it must also be served on the comptroller: CPR 63.17(3).

4 Patents Act 1977 s 97(3).

5 Patents Act 1977 s 97(3)(b).

6 Patents Act 1977 s 97(3)(a). The provisions relevant to infringement and revocation are s 61 (see PARA 555), s 72 (see PARA 565) and s 73 (see PARA 571). Decisions under s 71 (declaration of non-infringement: see PARA 556) are not included.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/9. PROCEEDINGS FOR INFRINGEMENT, THREATS AND REVOCATION/(6) APPEALS/574. Nature of appeal and fresh evidence.

574. Nature of appeal and fresh evidence.

Every appeal is limited to a review of the decision of the lower court unless the appellate court considers in any given case that it would be in the interests of justice to hold a re-hearing¹. The appellate court is extremely reluctant to reverse the judge's evaluation of the facts² or in matters involving the exercise of a discretion³. It is also slow to interfere with the judge's evaluation of mixed questions of law and fact such as obviousness and insufficiency⁴ which involve no question of principle but are simply a matter of degree⁵. Fresh points not involving new evidence may be taken provided that the other party is not thereby prejudiced⁶. Fresh evidence on appeal is only admitted on special grounds such as that the evidence could not have been discovered earlier and that it would probably have an important effect on the case⁷.

1 See CPR 52.11; and **CIVIL PROCEDURE** vol 12 (2009) PARA 1672 et seq.

2 *Biogen Inc v Medeva plc* [1997] RPC 1 at 45, HL; *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] FSR 113 at 122, HL (copyright). But see *United Wire Ltd v Screen Repair Services (Scotland) Ltd* [2001] RPC 439 at 459, HL (identification of 'product' subject to repairs) and *Buchanan v Alba Diagnostics Ltd* [2004] UKHL 5, [2004] RPC 681 (whether invention an 'improvement' over an earlier one).

3 *Hadmor Productions Ltd v Hamilton* [1983] 1 AC 191 at 209, [1982] 1 All ER 1042, HL. But see *Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International Holdings Inc* [2007] UKHL 43, [2008] RPC 1 (whether amendment pleaded new case of ownership in entitlement proceedings and whether amendment time-barred by statutory time limit).

4 *Synthon BV v Smithkline Beecham* [2005] UKHL 59, [2006] 1 All ER 685, sub nom *Smithkline Beecham plc's (paroxetine methanesulfonate) patent* [2006] RPC 323.

5 *Hadmor Productions Ltd v Hamilton* [1983] 1 AC 191 at 209, [1982] 1 All ER 1042, HL. See also *Wheatley v Drillsafe Ltd* [2001] RPC 133; *Pharmacia Corp v Merck & Co Inc* [2001] EWCA Civ 1610, [2002] RPC 775; *Merck & Co Inc's Patents* [2004] FSR 330; *SmithKline Beecham plc v Apotex Europe Ltd (No 2)* [2004] EWCA Civ 1703, [2004] FSR 559. The court is less reluctant to interfere in matters not involving mixed questions of law and fact such as the interpretation of a patent and amendment (*Pharmacia Corp v Merck & Co Inc* [2001] EWCA Civ 1610, [2002] RPC 775) or where the issue of novelty is what the prior art describes and whether it falls within the claim (*Technip France SA's Patent* [2004] EWCA Civ 381, [2004] RPC 919).

6 See eg *Cinpres Gas Injection Ltd v Melea Ltd* [2008] RPC 375, CA.

7 For the general principles applicable to the admission of fresh evidence see *Ladd v Marshall* [1954] 3 All ER 745, [1975] 1 WLR 1489, CA. A defendant who found fresh prior art pending appeal was not entitled to amend its particulars to include the prior art nor to adduce fresh evidence concerning it on appeal it being held that the proper test was whether the defendant had done all that was necessary to locate the prior art and not whether what it had done by way of prior art searches was reasonable: *Cofflexip SA v Stolt Comex Seaway MS Ltd* [2001] RPC 182, CA.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/575. The Department for Innovation, Universities and Skills and the Secretary of State.

10. ADMINISTRATION; PATENT AGENTS; THE COURTS

(1) ADMINISTRATION

(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office

575. The Department for Innovation, Universities and Skills and the Secretary of State.

The Department for Innovation, Universities and Skills is the department responsible for the UK Intellectual Property Office¹. The Secretary of State² appoints the comptroller³ and may authorise anyone to act for the comptroller⁴. The Secretary of State may appoint and remove examiners and other officers and clerks for the UK Intellectual Property Office⁵.

The Secretary of State has particular functions relating to applications for patents where defence or public safety is involved⁶ and in connection with Crown use of patents⁷.

Neither the Secretary of State nor any officer of his⁸ is to be taken to warrant the validity of any patent granted under the Patents Act 1977 or any treaty or international convention⁹ to which the United Kingdom is a party¹⁰. Nor does the Secretary of State or any such officer incur any liability by reason of or in connection with any examination or investigation required or authorised by that Act or any such treaty or convention, or any report or other proceedings consequent on any such examination or investigation¹¹.

1 The Patents and Designs Act 1907 s 62(2) placed the Patent Office under the immediate control of the comptroller and requires him to act under the superintendence and direction of the Secretary of State: see PARA 577. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 In any enactment, 'Secretary of State' means one of Her Majesty's principal secretaries of state: see the Interpretation Act 1978 s 5, Sch 1. In this title, unless the context otherwise requires, the Secretary of State referred to is to be taken to be the Secretary of State for Innovation, Universities and Skills. As to the office of Secretary of State see **CONSTITUTIONAL LAW AND HUMAN RIGHTS** vol 8(2) (Reissue) PARA 355.

3 See the Patents and Designs Act 1907 s 63(1) (amended by the Trade Marks Act 1994 s 106, Sch 4 para 2(1), (3)). As to the comptroller see PARA 577.

4 See the Patents and Designs Act 1907 s 62(3) (amended by the Trade Marks Act 1994 Sch 4 para 2(1), (2)); and PARA 577.

5 Patents and Designs Act 1907 s 63(1) (as amended: see note 3). The appointments are subject to the approval of the Treasury: Patents and Designs Act 1907 s 63(1) (as so amended). The salaries of those officers and clerks are determined by the Secretary of State with the concurrence of the Treasury: Patents and Designs Act 1907 s 63(2) (amended by the Trade Marks Act 1994 Sch 4 para 2(1), (3)).

6 See the Patents Act 1977 s 22(1), (5), (6), (7)(b) (see PARA 335) and s 118(3) (see PARA 581).

7 See the Patents Act 1977 s 56(2)(c); and PARA 405 note 3.

8 Members of the UK Intellectual Property Office staff are officers of the Secretary of State.

9 As to treaties and conventions see PARA 652 et seq.

10 Patents Act 1977 s 116(a).

11 Patents Act 1977 s 116(b).

UPDATE

575 The Department for Innovation, Universities and Skills and the Secretary of State

NOTE 2--The functions of the Secretary of State for Innovation, Universities and Skills have been transferred to the Secretary of State for Business, Innovation and Skills: see the Secretary of State for Business, Innovation and Skills Order 2009, SI 2009/2748.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/576. Secretary of State's power to make rules.

576. Secretary of State's power to make rules.

The Secretary of State¹ may make such rules as he thinks expedient for regulating the business of the UK Intellectual Property Office² in relation to patents and applications for patents, including European patents³, applications for European patents and international applications for patents⁴, and for regulating all matters placed by the Patents Act 1977 under the direction or control of the comptroller⁵.

Without prejudice to the generality of the above, rules may make provision:

- 354 (1) prescribing the form and contents of applications for patents and other documents which may be filed at the UK Intellectual Property Office and requiring copies to be furnished of any such documents⁶;
- 355 (2) regulating the procedure to be followed in connection with any proceeding or other matter before the comptroller or the UK Intellectual Property Office and authorising the rectification of irregularities of procedure⁷;
- 356 (3) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the UK Intellectual Property Office and providing for the remission of fees in the prescribed circumstances⁸;
- 357 (4) regulating the mode of giving evidence in any such proceeding and empowering the comptroller to compel the attendance of witnesses and the discovery of and production of documents⁹;
- 358 (5) requiring the comptroller to advertise any proposed amendments of patents and any other prescribed matters, including any prescribed steps in any such proceeding¹⁰;
- 359 (6) providing for the appointment of advisers to assist the comptroller in any proceeding before him¹¹;
- 360 (7) prescribing time limits for doing anything required to be done in connection with any such proceeding by the Patents Act 1977 or the rules and providing for the alteration of any period of time specified in the Patents Act 1977 or the rules¹²;
- 361 (8) giving effect to an inventor's¹³ right to be mentioned¹⁴ and providing for an inventor's waiver of any such right to be subject to acceptance by the comptroller¹⁵;
- 362 (9) without prejudice to any other provision of the Patents Act 1977, requiring and regulating the translation of documents in connection with an application for a patent or a European patent or an international application for a patent and the filing and authentication of any such translation¹⁶;
- 363 (10) providing for the publication and sale of documents in the UK Intellectual Property Office and of information about such documents¹⁷.

The comptroller may set out in directions any forms the use of which is required by rules; and any such directions must be published in the prescribed manner¹⁸.

Rules may make different provision for different cases¹⁹; and rules authorising the rectification of irregularities of procedure or providing for the alteration of any period of time may authorise the comptroller to extend or further extend any period notwithstanding that the period has already expired²⁰. Rules must:

- 364 (a) provide for the publication by the comptroller of the Official Journal (Patents)²¹;
- 365 (b) require or authorise the comptroller to make arrangements for the publication of reports of cases relating to patents, trade marks, registered designs, copyright and design right²².

Provision may be made by rules prescribing the circumstances in which the specification of an application for a patent, or of a patent, for an invention which involves the use of or concerns biological material is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art²³. The rules may in particular require the applicant or patentee to take such steps as may be prescribed for the purposes of making available to the public samples of the biological material and not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed²⁴. The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed; and the rules may identify a description of persons by reference to whether the comptroller has given his certificate as to any matter²⁵.

Any power conferred on the Secretary of State by the Patents Act 1977 to make rules, regulations or orders is exercisable by statutory instrument²⁶. Any Order in Council and any statutory instrument containing such an order, rules or regulations²⁷ is subject to annulment in pursuance of a resolution of either House of Parliament²⁸. Any Order in Council or order under any provision of the Patents Act 1977 may be varied or revoked by a subsequent order²⁹.

1 As to the Secretary of State see PARA 575.

2 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 As to the meaning of 'European patent' see PARA 668 note 5. There must be paid out of moneys provided by Parliament any sums required by any minister of the Crown or government department to meet any financial obligation of the United Kingdom under the European Patent Convention or the Patent Co-operation Treaty: Patents Act 1977 s 95(1) (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 21(a), Sch 3). Any sums received by any minister of the Crown or government department in pursuance of that convention or that treaty must be paid into the Consolidated Fund: Patents Act 1977 s 95(2) (amended by the Patents Act 2004 Sch 2 paras 1(1), 21(b)). As to the meaning of 'United Kingdom' see PARA 303 note 5. As to the European Patent Convention see PARA 668 et seq; and as to the Patent Co-operation Treaty see PARA 653 et seq.

4 As to the meaning of 'international application for a patent' see PARA 654 note 1.

5 Patents Act 1977 s 123(1). As to the comptroller see PARA 577. The power to make rules under s 123 includes power to make rules regulating the business of the UK Intellectual Property Office. As to current legislation see PARA 304.

6 Patents Act 1977 s 123(2)(a).

7 Patents Act 1977 s 123(2)(b).

8 Patents Act 1977 s 123(2)(c).

9 Patents Act 1977 s 123(2)(d).

10 Patents Act 1977 s 123(2)(e).

11 Patents Act 1977 s 123(2)(g).

12 Patents Act 1977 s 123(2)(h).

13 As to the meaning of 'inventor' see PARA 301 note 3.

14 Ie conferred by the Patents Act 1977 s 13: see PARA 308.

15 Patents Act 1977 s 123(2)(i) (substituted by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 26(1), (2)).

16 Patents Act 1977 s 123(2)(j).

17 Patents Act 1977 s 123(2)(l).

18 Patents Act 1977 s 123(2A) (added by the Patents Act 2004 Sch 2 paras 1(1), 26(1), (3)). The comptroller must publish any directions under the Patents Act 1977 s 123(2A) setting out forms in the Official Journal (Patents) (see PARA 580): Patents Rules 2007, SI 2007/3291, r 117(c).

19 Patents Act 1977 s 123(3).

20 Patents Act 1977 s 123(3A) (added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 29).

21 See the Patents Act 1977 s 123(6); and PARA 580.

22 See the Patents Act 1977 s 123(7); and PARA 580.

23 Patents Act 1977 s 125A(1) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 30; and amended by SI 2000/2037). An application for revocation of a patent under the Patents Act 1977 s 72(1)(c) (see PARA 564) may be made if any of the requirements of the rules cease to be complied with: s 125A(4) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 30). In exercise of the power so conferred the Secretary of State has made the Patents Rules 2007, SI 2007/3291, r 13(1), Sch 1: see PARAS 322, 497.

24 Patents Act 1977 s 125A(2) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 30; and amended by SI 2000/2037).

25 Patents Act 1977 s 125A(3) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 30).

26 Patents Act 1977 s 124(1).

27 Ie other than an order or rule required to be laid before Parliament in draft or an order under the Patents Act 1977 s 132(5) (commencement date).

28 Patents Act 1977 s 124(2).

29 Patents Act 1977 s 124(3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/577. The Comptroller General of Patents, Designs and Trade Marks.

577. The Comptroller General of Patents, Designs and Trade Marks.

The Comptroller General of Patents, Designs and Trade Marks is appointed by the Secretary of State with the approval of the Treasury¹, and acts under the superintendence and direction of the Secretary of State².

The UK Intellectual Property Office is under the immediate control of the comptroller³, who exercises a wide variety of statutory functions, both of an administrative and judicial nature⁴. Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Secretary of State⁵. So far as judicial functions are concerned⁶, the comptroller and any such officer are subject to the review of the Council on Tribunals⁷.

A certificate purporting to be signed by the comptroller and certifying that any entry which he is authorised⁸ to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, is prima facie evidence of the matters so certified⁹.

The comptroller may appoint an adviser to assist him in any proceeding before him and must settle any question or instructions to be submitted or given to the adviser¹⁰.

If the comptroller acts illegally the High Court may intervene by judicial review¹¹.

The Arbitration Act 1996¹² does not apply to any proceedings before the comptroller under the Patents Act 1977¹³.

1 Patents and Designs Act 1907 s 63(1) (amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 2(1), (3)(a)). As to the Secretary of State see PARA 575.

2 Patents and Designs Act 1907 s 62(2) (amended by the Trade Marks Act 1994 Sch 4 para 2(1), (2)).

3 Patents and Designs Act 1907 s 62(2) (as amended: see note 2). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 As to appeals from the comptroller see PARA 639.

5 Patents and Designs Act 1907 s 62(3) (amended by the Trade Marks Act 1994 Sch 4 para 2(1), (2)).

6 See the Tribunals and Inquiries Act 1992 s 14(1), which excludes executive functions from the control exercised by that Act.

7 See the Tribunals and Inquiries Act 1992 s 1(1), Sch 1 para 34; and **ADMINISTRATIVE LAW** vol 1(1) (Reissue) PARA 57. Procedural rules may be made only after consultation with the council: see s 8.

8 *le* under the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291. As to current legislation see PARA 304.

9 Patents Act 1977 s 32(10) (substituted by the Patents, Designs and Marks Act 1986 s 1, Sch 1 para 4). As to the register as evidence see the Patents Act 1977 s 32(11); and PARA 590. A person may apply on Patents Form 23 for a certificate which certifies that an entry has or has not been made in the register or something which the comptroller is authorised to do has or has not been done: Patents Rules 2007, SI 2007/3291, r 46(3).

10 Patents Rules 2007, SI 2007/3291, r 102.

11 See PARA 643.

- 12 le the Arbitration Act 1996 Pt I (ss 1-84): see **ARBITRATION** vol 2 (2008) PARA 1209 et seq.
- 13 Patents Act 1977 s 130(8) (amended by the Arbitration Act 1996 s 107(1), Sch 3 para 33).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/578. Annual report.

578. Annual report.

The comptroller¹ must make an annual report and lay it before both Houses of Parliament² before 1 December in every financial year³. The report is made with respect to the execution of the Patents Act 1977 and the discharge of the comptroller's functions under the European Patent Convention⁴ and the Patent Co-operation Treaty⁵, and must include an account of all fees, salaries and allowances, and other money received and paid by him under that Act, that convention and that treaty during the previous financial year⁶.

1 As to the comptroller see PARA 577.

2 As to the laying of documents before Parliament see **PARLIAMENT** vol 34 (Reissue) PARA 941.

3 Patents Act 1977 s 121 (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 25, Sch 3).

4 As to this convention see PARA 668.

5 As to this treaty see PARA 653 et seq.

6 Patents Act 1977 s 121 (as amended: see note 3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/579. The UK Intellectual Property Office.

579. The UK Intellectual Property Office.

The issuing of patents is the responsibility of the UK Intellectual Property Office¹, which is under the immediate control of the comptroller². The UK Intellectual Property Office is an operating name of the Patent Office³. The UK Intellectual Property Office has a seal, impressions of which are judicially noticed and are to be admitted in evidence⁴. The comptroller may give directions specifying the hour at which the office is taken to be closed, and the days which are excluded days, for the purposes of the public transaction of business⁵. Any business done on any day after the hour so specified in relation to business of that class, or on a day which is an excluded day in relation to business of that class, is taken to have been done on the next following day which is not an excluded day; and, where the time for doing anything expires on an excluded day, that time is extended to the next following day which is not an excluded day⁶. The register of patents is kept at the UK Intellectual Property Office⁷. Unauthorised use of the words 'Patent Office' is an offence⁸.

¹ The address of the UK Intellectual Property Office is Concept House, Cardiff Road, Newport, Gwent, NP10 8QQ.

² Patents and Designs Act 1907 s 62(2) (amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 2(1), (2)). As to the comptroller see PARA 577.

³ See the UK Intellectual Property Office Name Change Fact Sheet.

⁴ Patents and Designs Act 1907 s 64.

⁵ Patents Act 1977 s 120(1) (amended by the Patents Act 2004 s 16(1), Sch 2 paras 1(1), 24(1), (2)(a), (b)). Directions under the Patents Act 1977 s 120 must be published in the prescribed manner: s 120(3) (added by the Patents Act 2004 Sch 2 paras 1(1), 24(1), (3)). The comptroller must publish any directions given under the Patents Act 1977 s 120(1) specifying hours of business or excluded days in the Official Journal (Patents) (see PARA 580): Patents Rules 2007, SI 2007/3291, r 117(b).

⁶ Patents Act 1977 s 120(2).

⁷ See the Patents Act 1977 s 32(1), (5); and PARA 585. As to the register generally see PARA 585 et seq.

⁸ See the Patents Act 1977 s 112; and PARA 612.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/580. Publications and library.

580. Publications and library.

The comptroller¹ must publish 'The Official Journal (Patents)'², containing: (1) particulars of applications for and grants of patents and of other proceedings under the Patents Act 1977; (2) any directions specifying hours of business or excluded days³; (3) any directions setting out forms⁴; and (4) any other information that the comptroller considers to be generally useful or important⁵. The comptroller must make arrangements for the publication of reports of cases relating to patents, trade marks, registered designs and design right decided by him and of cases relating to patents, trade marks, registered designs, copyright and design right decided by any court or body, whether in the United Kingdom⁶ or elsewhere⁷. The comptroller may also arrange for the publication and sale of copies of documents, in particular, specifications of patents and applications for patents in the UK Intellectual Property Office⁸. There is kept at the UK Intellectual Property Office an extensive library of United Kingdom and foreign patent specifications and of technical books and periodicals. The UK Intellectual Property Office publishes and sells copies of its Manual of Patent Practice⁹.

1 As to the comptroller see PARA 577.

2 Patents Rules 2007, SI 2007/3291, r 117.

3 Ie under the Patents Act 1977 s 120(1): see PARA 579.

4 Ie under the Patents Act 1977 s 123(2A): see PARA 576.

5 Patents Act 1977 s 123(6); Patents Rules 2007, SI 2007/3291, r 117. The other proceedings referred to relate to patents other than proceedings for infringement and revocation (which are not under the Patents Act 1977) and any UK Intellectual Property Office proceedings or application requiring to be advertised. Among the matters required to be advertised in the Journal are notice of, and the comptroller's acceptance of, an offer to surrender a patent (see s 29(3); and PARA 359), the restoration of a lapsed patent (see r 40(9); and PARA 356), notice of an entry in the register that licences are to be available as of right (see r 43(2); and PARA 392) and proposed corrections of errors in patents or applications (see r 105(6); and PARA 354). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 As to the meaning of 'United Kingdom' see PARA 303 note 5.

7 Patents Act 1977 s 123(7) (amended by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 22); Patents Rules 2007, SI 2007/3291, r 118. For these purposes, the reference to a trade mark is to be construed as a reference to a trade mark within the meaning of the Trade Marks Act 1994 (see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 127): s 106(1), Sch 4 para 1(1), (2). The publication of the Reports of Patent, Design, Trade Mark and Other Cases, commonly known as 'Reports of Patent Cases' (RPC), began in 1884.

8 Patents Act 1977 s 123(2)(i), (3); Patents Rules 2007, SI 2007/3291, r 119. Copies of all published United Kingdom specifications are on sale at the UK Intellectual Property Office.

9 See PARA 304.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/581. Request for information as to patents and inspection of documents.

581. Request for information as to patents and inspection of documents.

After publication of an application for a patent¹, the comptroller² must upon request and payment of the prescribed fee³ give the person making the request such information, and permit him to inspect such documents, relating to the application as may be specified in the request, subject to any prescribed restrictions⁴. Until an application for a patent is published, documents or information constituting or relating to the application may not be published or communicated to any person by the comptroller without the applicant's consent⁵.

The prescribed restrictions are as follows⁶. No document⁷ may be inspected:

- 366 (1) where that document was prepared by the comptroller, an examiner or the UK Intellectual Property Office⁸ for internal use only⁹;
- 367 (2) where the specified circumstances¹⁰ exist, before the end of the period of 14 days beginning with the date of the notification¹¹;
- 368 (3) where that document is a request or application for information¹²; or
- 369 (4) where that document includes matter which in the comptroller's opinion disparages any person in a way likely to damage him, or the inspection of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour¹³.

Unless in a particular case the comptroller otherwise directs, no document may be inspected:

- 370 (a) where that document was filed at the UK Intellectual Property Office in connection with an application for compensation of an employee¹⁴;
- 371 (b) where that document is treated as a confidential document¹⁵;
- 372 (c) where that document was prepared by the comptroller, an examiner or the UK Intellectual Property Office other than for internal use, and it contains information which the comptroller considers should remain confidential¹⁶;
- 373 (d) where that document relates to an international application for a patent and the International Bureau would not be permitted to allow access to that document under the Patent Co-operation Treaty¹⁷; or
- 374 (e) where the comptroller has accepted a person's application to waive the right to be mentioned¹⁸, and that person's name and address can be identified from that document as those of the inventor or of the person believed to be the inventor (or, as the case may be, his address can be so identified)¹⁹.

Where a person is notified that an application for a patent has been made but not published²⁰, and that, if the patent is granted, the applicant will bring proceedings against that person in the event of his doing any act specified in the notification after the application is published, that person may make a request²¹ for information and inspection of documents²² even though the application has not been published²³. Similarly, where an application for a patent is filed but not published, and a new application is filed in respect of any part of the subject matter of the earlier application, and is published, any person may make a request²⁴ for information and inspection of documents relating to the earlier application²⁵.

A person may request to be notified of any of the following events in relation to an application for a patent or in relation to a patent²⁶:

- 375 (i) an applicant requesting, or failing to request, a substantive examination before the end of the prescribed period²⁷;
- 376 (ii) the application being published²⁸;
- 377 (iii) the notice of grant of the patent being published²⁹;
- 378 (iv) the application being terminated or withdrawn³⁰;
- 379 (v) a request for an opinion as to validity or infringement³¹;
- 380 (vi) the patent ceasing to have effect³²;
- 381 (vii) the renewal fee and any additional fee being paid during the specified period³³;
- 382 (viii) an application being made for the restoration of the patent which has ceased to have effect³⁴;
- 383 (ix) an entry being made in the register³⁵;
- 384 (x) a document becoming available for inspection³⁶ (by reason of a prescribed restriction no longer applying to the document)³⁷;
- 385 (xi) an application to register a transaction, instrument or event being made³⁸;
- 386 (xii) a matter being published in the Official Journal (Patents)³⁹.

Where a person has made such a request, the comptroller must notify him that the relevant event has occurred as soon as practicable after the event⁴⁰. However, the comptroller must not give him information or permit him to inspect a document unless he would be entitled to such information or to inspect such a document under the provisions set out above⁴¹.

Rules of court must make provision empowering the court⁴² in any proceedings before it under the Patents Act 1977, on or without the application of any party, to order the UK Intellectual Property Office to inquire into and report on any question of fact or opinion⁴³. Where the court makes such an order on the application of a party, the fee payable to the UK Intellectual Property Office is at such rate as may be determined in accordance with rules of court and is a cost of the proceedings unless otherwise ordered by the court⁴⁴. Where the court makes such an order of its own motion, the fee payable to the UK Intellectual Property Office is at such rate as may be determined by the Lord Chancellor with the approval of the Treasury and must be paid out of money provided by Parliament⁴⁵.

1 le under the Patents Act 1977 s 16: see PARA 327.

2 As to the comptroller see PARA 577.

3 A person may apply to the comptroller for a certified copy of any relevant document and, on payment of £20, he is entitled to such a copy: Patents Rules 2007, SI 2007/3291, r 48(1); Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1. A person may apply to the comptroller for an uncertified copy of any relevant document and, on payment of £5, he is entitled to such a copy: Patents Rules 2007, SI 2007/3291, r 48(2); Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1. But a person is not entitled to a copy of a relevant document where it is not available for inspection under the Patents Act 1977 s 118 or where making or providing such a copy would infringe copyright: Patents Rules 2007, SI 2007/3291, r 48(3). For these purposes, a relevant document is any of the following: (1) an application for a patent which has been published; (2) a specification of a patent; (3) any other document, or extract from any such document, kept at the UK Intellectual Property Office: r 48(4). An application under r 48(1) or (2) must be made on Patents Form 23: r 48(5).

4 Patents Act 1977 s 118(1). Section 118 does not entitle persons to demand the date of withdrawal of an unpublished application: see *Haberman v Comptroller-General of the Patent Office* [2003] EWHC 430 (Pat), [2004] RPC 414.

5 Patents Act 1977 s 118(2). Section 118(2) does not, however, prevent the comptroller from sending such information to the European Patent Office in accordance with any provision of the European Patent Convention (see PARA 668) (Patents Act 1977 s 118(3)(a)); or publishing or communicating to others any prescribed bibliographic information about an unpublished application for a patent (s 118(3)(b)). The bibliographic data so prescribed are: (1) the name of the applicant; (2) the title of the invention; (3) the number of the application; (4)

the date of filing of the application; (5) where a declaration has been made for the purposes of the Patents Act 1977 s 5(2) (see PARA 311), the date of filing of each earlier relevant application specified in the declaration, its application number and the country it was filed in or in respect of; (6) where an application has been terminated or withdrawn, that information; and (7) where a transaction, instrument or event mentioned in s 32(2)(b) (see PARA 585) or s 33(3) (see PARA 588) is notified to the comptroller, that information: Patents Rules 2007, SI 2007/3291, r 55.

The Patents Act 1977 s 118(2) does not prevent the Secretary of State from inspecting or authorising the inspection of an application for a patent or any connected documents under s 22(6) (see PARA 335): s 118(3) (amended by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 28). As to the Secretary of State see PARA 575.

6 Patents Rules 2007, SI 2007/3291, r 51(1). The prescribed restrictions for the purposes of the Patents Act 1977 s 118(1) are those set out in the Patents Rules 2007, SI 2007/3291, r 51(2), (3): r 51(1).

7 References to a document include part of a document: Patents Rules 2007, SI 2007/3291, r 51(4).

8 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

9 Patents Rules 2007, SI 2007/3291, r 51(2)(a).

10 In the circumstances specified in the Patents Act 1977 s 118(4).

11 Patents Rules 2007, SI 2007/3291, r 51(2)(b). Notification is under r 52(2): see note 21.

12 Patents Rules 2007, SI 2007/3291, r 51(2)(c). The request or application is one made under the Patents Act 1977 s 118 or the Patents Rules 2007, SI 2007/3291, r 46(2) (see PARA 577), r 48(2) (see PARA 581) or r 54(1) (see note 26).

13 Patents Rules 2007, SI 2007/3291, r 51(2)(d).

14 Patents Rules 2007, SI 2007/3291, r 51(3)(a). Applications for compensation of an employee are made under the Patents Act 1977 s 40(1), (2) or s 41(8): see PARAS 370-371.

15 Patents Rules 2007, SI 2007/3291, r 51(3)(b). Documents are treated as confidential under r 53: see PARA 582.

16 Patents Rules 2007, SI 2007/3291, r 51(3)(c).

17 Patents Rules 2007, SI 2007/3291, r 51(3)(d). As to the Patent Co-operation Treaty see PARA 653 et seq.

18 In under the Patents Rules 2007, SI 2007/3291, r 11(1)(a), (b): see PARA 308.

19 Patents Rules 2007, SI 2007/3291, r 51(3)(e).

20 In under the Patents Act 1977 s 16: see PARA 327.

21 Where the circumstances specified in the Patents Act 1977 s 118(4) exist, a request under s 118(1) must be accompanied by evidence verifying their existence: Patents Rules 2007, SI 2007/3291, r 52(1). The comptroller must notify the applicant for the patent of any request: r 52(2). The notification must be accompanied by a copy of the request and the accompanying evidence: r 52(3). The applicant may, before the end of the period of 14 days beginning with the date of the notification, inform the comptroller that the circumstances specified in the Patents Act 1977 s 118(4) do not exist; otherwise the comptroller may treat him as accepting that those circumstances exist: Patents Rules 2007, SI 2007/3291, r 52(4). The comptroller does not have the power to impose confidentiality restrictions on the inspection: *Buralls of Wisbech Ltd's Application* [2004] RPC 285.

22 In under the Patents Act 1977 s 118(1).

23 Patents Act 1977 s 118(4).

24 See note 21.

25 Patents Act 1977 s 118(5).

26 Patents Rules 2007, SI 2007/3291, r 54(1). A request must be made on Patents Form 49: r 54(1). A request on Patents Form 49 must be for information regarding a single event only: r 54(4).

- 27 Patents Rules 2007, SI 2007/3291, r 54(5)(a). The period is that prescribed for the purposes of the Patents Act 1977 s 18(1): see PARA 329.
- 28 Patents Rules 2007, SI 2007/3291, r 54(5)(b).
- 29 Patents Rules 2007, SI 2007/3291, r 54(5)(c). Notice of grant of a patent is published under the Patents Act 1977 s 24: see PARA 338.
- 30 Patents Rules 2007, SI 2007/3291, r 54(5)(d).
- 31 Patents Rules 2007, SI 2007/3291, r 54(6)(a). A request for an opinion is made under the Patents Act 1977 s 74A: see PARA 518.
- 32 Patents Rules 2007, SI 2007/3291, r 54(6)(b). A patent ceases to have effect by reason of non payment of renewal fees: see the Patents Act 1977 s 25(3); and PARA 340.
- 33 Patents Rules 2007, SI 2007/3291, r 54(6)(c). The period is that specified in the Patents Act 1977 s 25(4): see PARA 340.
- 34 Patents Rules 2007, SI 2007/3291, r 54(6)(d).
- 35 Patents Rules 2007, SI 2007/3291, r 54(7)(a). As to the register see PARA 585 et seq.
- 36 Is available for inspection under the Patents Act 1977 s 118.
- 37 Patents Rules 2007, SI 2007/3291, r 54(7)(b).
- 38 Patents Rules 2007, SI 2007/3291, r 54(7)(c). An application to register is made under r 47: see PARA 588.
- 39 Patents Rules 2007, SI 2007/3291, r 54(7)(d). As to the Journal see PARA 580.
- 40 Patents Rules 2007, SI 2007/3291, r 54(2).
- 41 Patents Rules 2007, SI 2007/3291, r 54(3).
- 42 As to the meaning of 'court' see PARA 637 note 1.
- 43 Patents Act 1977 s 99A(1) (s 99A added by the Copyright, Designs and Patents Act 1988 Sch 5 para 26). At the date at which this volume states the law no rules of court had been so made.
- 44 Patents Act 1977 s 99A(2) (as added: see note 43).
- 45 Patents Act 1977 s 99A(3) (as added: see note 43).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/582. Direction that document is confidential.

582. Direction that document is confidential.

Where a person files a document¹ at the UK Intellectual Property Office² or sends it to an examiner or the comptroller³, any person may request that the document be treated as a confidential document⁴.

The comptroller must refuse any request where it relates to a Patents Form or any document filed in connection with a request for an opinion as to validity or infringement⁵.

A request to treat a document as confidential must be made before the end of the period of 14 days beginning with the date on which the document was filed at the UK Intellectual Property Office, or received by the comptroller, an examiner or the UK Intellectual Property Office⁶. Reasons for the request must be included⁷.

If it appears to the comptroller that there is good reason for the document to remain confidential, he may direct that the document is to be treated as a confidential document; otherwise he must refuse the request⁸. Where a request has been made, the document must be treated as confidential until the comptroller refuses that request or gives such a direction⁹. Where the comptroller believes there is no longer a good reason for the direction to continue in force, he must revoke it¹⁰.

1 References to a document include part of a document: Patents Rules 2007, SI 2007/3291, r 53(7).

2 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 As to the comptroller see PARA 577.

4 Patents Rules 2007, SI 2007/3291, r 53(1).

5 Patents Rules 2007, SI 2007/3291, r 53(2). A request for an opinion is made under the Patents Act 1977 s 74A: see PARA 518.

6 Patents Rules 2007, SI 2007/3291, r 53(3)(a).

7 Patents Rules 2007, SI 2007/3291, r 53(3)(b).

8 Patents Rules 2007, SI 2007/3291, r 53(5).

9 Patents Rules 2007, SI 2007/3291, r 53(4).

10 Patents Rules 2007, SI 2007/3291, r 53(6).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/583. Fees, applications and notices.

583. Fees, applications and notices.

The UK Intellectual Property Office¹ is required to charge fees in almost all cases in which an application is made to it or a notice given to it². Applications are required to be made on forms provided for the purpose³.

Any notice required or authorised to be given by or under the Patents Act 1977 or the Patents Rules 2007 and any application or other document so authorised or required to be made or filed, may be given, made or filed by post⁴.

1 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 See the Patents (Fees) Rules 2007, SI 2007/3292. Except where otherwise specified, the fees to be paid in respect of any matters arising under the Patents Act 1977 are those specified in the Patents (Fees) Rules 2007, SI 2007/3292, r 2(1), Sch 1; and, in any case where a form is required by the Patents Rules 2007, SI 2007/3291, to be used and is specified in the Patents (Fees) Rules 2007, SI 2007/3292, Sch 1 as the corresponding form in relation to any matter, that form must be accompanied by the fee specified in respect of that matter: r 2(2). Where any provision of the Patents Rules 2007, SI 2007/3291, permits payment to be made before or after the form has been filed, the fee may be paid accordingly: Patents (Fees) Rules 2007, SI 2007/3292, r 2(3). Renewal fees and additional fees (see PARA 340) are specified in rr 4, 5, Sch 2.

A person may apply to the comptroller for the remission of a fee: Patents Rules 2007, SI 2007/3291, r 106(1). As to the comptroller see PARA 577. The comptroller may remit the whole or part of a search fee where: (1) in relation to an international application for a patent (UK) a copy of the International Search Report (see PARA 654) for that application is available to the comptroller; or (2) a new application for a patent is filed as mentioned in the Patents Act 1977 s 15(9) (see PARA 317) and, in connection with the earlier application, the applicant has already paid the search fee for the invention described in the new application: Patents Rules 2007, SI 2007/3291, r 106(2). As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1. The comptroller may remit the whole or part of any fee where: (a) a person has requested the comptroller or an examiner to do something in accordance with the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291; and (b) the request is withdrawn before it is carried out: r 106(3). The comptroller may remit the whole or part of the fee payable in respect of a request for an opinion under the Patents Act 1977 s 74A (see PARA 518) where he has refused the request: Patents Rules 2007, SI 2007/3291, r 106(4). Where a supplementary protection certificate lapses or is declared invalid (see PARA 341 et seq), the comptroller must remit any fee which has been paid in respect of the period beginning with the next anniversary of the start date following the date the certificate lapsed or was declared invalid and ending with the date the certificate would have expired but for its lapse or invalidity: r 106(5), (6). Any decision of the comptroller under r 106 is excepted from the right of appeal conferred by the Patents Act 1977 s 97 (see PARA 573): Patents Rules 2007, SI 2007/3291, r 106(7).

3 The forms of which the use is required by the Patents Rules 2007, SI 2007/3291, are those set out in directions under the Patents Act 1977 s 123(2A) (see PARA 576) and are referred to as Patents Forms: Patents Rules 2007, SI 2007/3291, r 4(1). Such a requirement to use a form is satisfied by the use of a form which is acceptable to the comptroller and contains the information required by the form as so set out: r 4(2). Such directions must be published in the Official Journal (Patents) in accordance with r 117(c) (see PARA 576): r 4(3). Unless the comptroller otherwise directs, to file any form or other document under the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291, only one side of each sheet of paper must be used and the other side must remain blank: r 4(4). But where the information is delivered in electronic form or using electronic communications a requirement under the Patents Rules 2007, SI 2007/3291, to use a form, and the requirements in r 4(4), do not apply: r 4(5). Where any form or other document is delivered to the comptroller in electronic form or using electronic communications, any requirement in the Patents Rules 2007, SI 2007/3291, for multiple copies of that form or document to be filed does not apply: r 4(6).

The forms may not be modified in substance, and must be used for a purpose akin to that for which they are primarily intended: see *Re Salles' Application* (1927) 45 RPC 61.

4 Patents Act 1977 s 119.

UPDATE

583 Fees, applications and notices

NOTE 2--SI 2007/3292 amended: SI 2009/2089.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(i) The Secretary of State, the Comptroller and the UK Intellectual Property Office/584. Use of electronic communications.

584. Use of electronic communications.

The comptroller¹ may give directions as to the form and manner in which documents to be delivered to the comptroller in electronic form or using electronic communications are to be delivered to him². Such a direction may provide that in order for a document to be delivered in compliance with the direction it must be accompanied by one or more additional documents specified in the direction³. If a document to which such a direction applies is delivered to the comptroller in a form or manner which does not comply with the direction the comptroller may treat the document as not having been delivered⁴.

Where a document is delivered using electronic communications, and there is a requirement for a fee to accompany the document, the comptroller may give directions specifying how the fee is to be paid and when the fee is deemed to have been paid⁵. The comptroller may also give directions specifying that a person who delivers a document to the comptroller in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged⁶. The comptroller may give directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications⁷.

A direction under these provisions may be given: (1) generally; (2) in relation to a description of cases specified in the direction; (3) in relation to a particular person or persons⁸; and may be varied or revoked by a subsequent direction⁹.

The delivery using electronic communications to any person by the comptroller of any document is deemed to be effected, unless the comptroller has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the comptroller by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication¹⁰.

A requirement of the Patents Act 1977 that something must be done in the prescribed manner is satisfied in the case of something that is done using a document in electronic form, or using electronic communications, only if the directions that apply to the manner in which it is done are complied with¹¹.

The provisions set out above apply to delivery at, in, with or to the UK Intellectual Property Office¹² as they apply to delivery to the comptroller¹³. They also apply to delivery by the UK Intellectual Property Office as they apply to delivery by the comptroller¹⁴.

1 As to the comptroller see PARA 577.

2 Patents Act 1977 s 124A(1) (added by SI 2003/512; and amended by SI 2006/1229).

3 Patents Act 1977 s 124A(2) (added by SI 2003/512).

4 Patents Act 1977 s 124A(3) (added by SI 2003/512; and amended by SI 2006/1229).

5 Patents Act 1977 s 124A(4), (5) (added by SI 2003/512; and amended by SI 2006/1229).

6 Patents Act 1977 s 124A(6) (added by SI 2003/512; and amended by SI 2006/1229).

7 Patents Act 1977 s 124A(7) (added by SI 2003/512; and amended by SI 2006/1229).

8 Patents Act 1977 s 124A(8) (added by SI 2003/512).

9 Patents Act 1977 s 124A(11) (added by SI 2003/512).

10 Patents Act 1977 s 124A(13) (added by SI 2003/512; and substituted by SI 2006/1229).

11 Patents Act 1977 s 124A(14) (added by SI 2003/512; and substituted by SI 2006/1229). In the case of an application made using a document in electronic form, or using electronic communications, a reference in the Patents Act 1977 to the application not having been made in compliance with rules or requirements of the Act includes a reference to its not having been made in compliance with any applicable directions under s 124A: s 124A(15) (added by SI 2003/512; and substituted by SI 2006/1229).

12 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and *PARA 579*.

13 Patents Act 1977 s 124A(16) (added by SI 2006/1229).

14 Patents Act 1977 s 124A(16) (as added: see note 13).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(ii) The Register of Patents/585. The register.

(ii) The Register of Patents

585. The register.

The comptroller¹ must maintain the register of patents which must comply with rules duly made² and must be kept in accordance with such rules³. The public has a right to inspect the register at the UK Intellectual Property Office at all convenient times⁴; but the register need not be kept in documentary form⁵. Any person who applies for a certified copy⁶ of an entry in the register or a certified extract⁷ from the register is entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts; and rules may provide that any person who applies for an uncertified copy or extract is to be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts⁸.

The comptroller may publish or advertise such things done⁹ in relation to the register as he thinks fit¹⁰.

Falsification of the register is an offence¹¹.

1 As to the comptroller see PARA 577.

2 I.e. rules made by virtue of the Patents Act 1977 s 32.

3 Patents Act 1977 s 32(1) (s 32 substituted by the Patents, Designs and Marks Act 1986 s 1, Sch 1 para 4). In the Patents Act 1977, except so far as the context otherwise requires, 'register', as a noun, means the register of patents; and 'register', as a verb, means, in relation to any thing, to register or register particulars, or enter notice, of that thing in the register and, in relation to a person, means to enter his name in the register; and cognate expressions are to be construed accordingly: s 32(14) (as so substituted), s 130(1). As to the application of s 32 to EU compulsory licences see para 402.

Without prejudice to any other provision of the Patents Act 1977 or rules, rules may make provision with respect to the following matters, including provision imposing requirements as to any of those matters: (1) the registration of patents and of published applications for patents; (2) the registration of transactions, instruments or events affecting rights in or under patents and applications; (3) the entering on the register of notices concerning opinions issued, or to be issued under s 74A (see PARA 518); (4) the furnishing to the comptroller of any prescribed documents or description of documents in connection with any matter which is required to be registered; (5) the correction of errors in the register and in any documents filed at the UK Intellectual Property Office in connection with registration; and (6) the publication and advertisement of anything done under the Patents Act 1977 or rules in relation to the register: s 32(2) (as so substituted; and amended by the Patents Act 2004 s 13(3)). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 Patents Act 1977 s 32(5) (as substituted: see note 3). In relation to any portion of the register kept otherwise than in documentary form, the right of inspection conferred by s 32(5) is a right to inspect the material on the register: s 32(8)(a) (as substituted: see note 3).

5 Patents Act 1977 s 32(4) (as substituted: see note 3).

6 For these purposes, 'certified copy' means a copy certified by the comptroller and sealed with the seal of the UK Intellectual Property Office: Patents Act 1977 s 32(13) (as substituted: see note 3).

7 For these purposes, 'certified extract' means an extract certified by the comptroller and sealed with the seal of the UK Intellectual Property Office: Patents Act 1977 s 32(13) (as substituted: see note 3).

8 Patents Act 1977 s 32(6) (as substituted: see note 3). In relation to any portion of the register kept otherwise than in documentary form, the right to a copy or extract conferred by s 32(6) or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible: s 32(8)(b) (as

substituted: see note 3). Applications under s 32(6) or rules made by virtue thereof must be made in such manner as may be prescribed: s 32(7) (as substituted: see note 3). An application under s 32(6) for a certified copy of an entry in the register, or a certified extract from the register, must be made on Patents Form 23: Patents Rules 2007, SI 2007/3291, r 46(1). A person may apply on Patents Form 23 for an uncertified copy of an entry in the register or an uncertified extract from the register and, on payment of the prescribed fee, he is entitled to such a copy or extract: r 46(2).

The supply of copies by the comptroller is subject to the restrictions on the making of documents available in r 51: see PARA 581.

9 le under the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.

10 Patents Rules 2007, SI 2007/3291, r 45.

11 See the Patents Act 1977 s 109; and PARA 611.

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586. Entries in the register.

When an application for a patent is published¹, the comptroller² must enter each of the following matters in the register:

- 387 (1) the name of the applicant;
- 388 (2) the name and address of the person identified as the inventor³;
- 389 (3) the address of the applicant and his address for service⁴;
- 390 (4) the title of the invention;
- 391 (5) the date of filing⁵ of the application for a patent;
- 392 (6) the application number;
- 393 (7) where a declaration has been made as to an earlier application⁶, the date of filing of each earlier relevant application specified in the declaration, its application number and the country it was filed in or in respect of; and
- 394 (8) the date of the application's publication⁷.

Where an application for a patent has been published, the comptroller must enter in the register as soon as practicable after the event to which they relate the date on which a request is made by an applicant for the substantive examination⁸ of his application and the date on which an application is terminated or withdrawn⁹.

When the patent is granted¹⁰, the comptroller must enter in the register: (a) the date on which the comptroller granted the patent; (b) the name of the proprietor of the patent; (c) where the address of the proprietor or his address for service was not previously entered in the register¹¹, that address or address for service¹².

In relation to a request for an opinion as to validity or infringement¹³, the comptroller must enter in the register as soon as practicable after the event occurs a notice that such a request has been received, a notice that such a request has been refused or withdrawn or a notice that an opinion has been issued¹⁴.

A notice of any transaction, instrument or event affecting rights in or under a patent or application¹⁵ must be entered in the register as soon as practicable after it occurs or, if later, when the application is published¹⁶.

The comptroller may, at any time, enter in the register such other particulars as he thinks fit¹⁷.

Where an application is made¹⁸ to the comptroller for an entry in the register to the effect that licences under the patent are to be available as of right, the comptroller must, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, make that entry¹⁹.

1 As to publication see PARA 327.

2 As to the comptroller see PARA 577.

3 Where a person's application under the Patents Rules 2007, SI 2007/3291, r 11(1)(a) or (b) has been accepted by the comptroller (see PARA 308), the comptroller may omit from the register his name and address (or, as the case may be, his address) as that of the person believed to be the inventor: r 44(2).

4 As to the address for service see PARA 595.

- 5 As to the meaning of 'date of filing' see PARA 316.
- 6 le for the purposes of the Patents Act 1977 s 5(2): see PARA 311.
- 7 Patents Rules 2007, SI 2007/3291, r 44(1).
- 8 As to this request see PARA 329.
- 9 Patents Rules 2007, SI 2007/3291, r 44(3).
- 10 As to grant see PARA 338.
- 11 le under the Patents Rules 2007, SI 2007/3291, r 44(1).
- 12 Patents Rules 2007, SI 2007/3291, r 44(4).
- 13 le under the Patents Act 1977 s 74A: see PARA 518.
- 14 Patents Rules 2007, SI 2007/3291, r 44(5).
- 15 le as mentioned in the Patents Act 1977 s 32(2)(b) (see PARA 585) or s 33(3) (see PARA 588).
- 16 Patents Rules 2007, SI 2007/3291, r 44(6).
- 17 Patents Rules 2007, SI 2007/3291, r 44(7).
- 18 le under the Patents Act 1977 s 46(1): see PARA 392.
- 19 Patents Act 1977 s 46(2).

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587. Trusts and equitable interests.

No notice of any trust, whether express, implied or constructive, may be entered in the register of patents¹; and the comptroller² is not affected by any such notice³. Equities in respect of a patent are enforced in like manner as in respect of any other personal property⁴, that is, against the legal owner of the property concerned⁵.

1 As to the register see PARA 585.

2 As to the comptroller see PARA 577.

3 Patents Act 1977 s 32(3) (substituted by the Patents, Designs and Marks Act 1986 s 1, Sch 1 para 4). Notice of documents constituting equitable assignments must, however, be entered if priority of interest is to be preserved: see the Patents Act 1977 s 33; and PARA 588. The document must refer specifically to the patent in question and must be one on which specific performance could be ordered: *Re Parnell's Patent* (1888) 4 TLR 197, 5 RPC 126; *Re Fletcher's Patent* (1893) 62 LJ Ch 938, 10 RPC 252.

4 See the Patents Act 1977 s 30; and PARAS 373-374.

5 See **EQUITY** vol 16(2) (Reissue) PARA 608. In practice it is more effective to secure registration of notice of a document disclosing the existence of the equity than to rely upon more ordinary methods of enforcing it.

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588. Registration of certain transactions etc.

A notice of any of the following transactions, instruments and events must be entered in the register of patents¹ as soon as practicable after it occurs or, if later, when the application is published²:

- 395 (1) the assignment of a patent or application for a patent, or a right in it³;
- 396 (2) the mortgage of a patent or application or the granting of security over it⁴;
- 397 (3) the grant or assignment or mortgage of a licence or sub-licence under a patent or application⁵;
- 398 (4) the death of the proprietor or one of the proprietors of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right⁶; and
- 399 (5) any order or directions of a court or other competent authority either:
19
29. (a) transferring to any person a patent or application or any right in or under it; or
30. (b) that an application should proceed in the name of any person,
20
400 and, in either case, the event by virtue of which the court or authority had power to make any such order or give any such directions⁷.

An application to register or to give notice to the comptroller⁸ of any such transaction, instrument or event must be made on the prescribed form⁹; and include evidence establishing the transaction, instrument or event¹⁰. The application may be made at any time¹¹ and, it appears, by any person.

1 There is no penalty for failure to register, but such failure may result in loss of rights: see PARA 589. As to the register see PARA 585 et seq.

2 See the Patents Rules 2007, SI 2007/3291, r 44(6). Provision is thus made for an interest not created by an instrument to be registered.

3 Patents Act 1977 s 33(3)(a). See *Tamglass Ltd OY v Luoyang North Glass Technology Co Ltd (No 3)* [2006] EWHC 445 (Ch), [2006] FSR 622; *Siemens Schweiz AG v Thorn Security Ltd* [2007] EWHC 2242 (Ch), [2008] RPC 58. As to the application of the Patents Act 1977 s 32 to EU compulsory licences see para 402.

4 Patents Act 1977 s 33(3)(b). As to the entry of a mortgage interest see *Van Gelder, Apsimon & Co v Sowerby Bridge United District Flour Society* (1890) 44 ChD 374, CA.

5 Patents Act 1977 s 33(3)(c).

6 Patents Act 1977 s 33(3)(d).

7 Patents Act 1977 s 33(3)(e). See *Tamglass Ltd OY v Luoyang North Glass Technology Co Ltd (No 3)* [2006] EWHC 445 (Ch), [2006] FSR 622; *Siemens Schweiz AG v Thorn Security Ltd* [2007] EWHC 2242 (Ch), [2008] RPC 58.

8 As to the comptroller see PARA 577.

9 Patents Rules 2007, SI 2007/3291, r 47(1)(a). The application must be made on Patents Form 21: see r 47(1)(a).

10 Patents Rules 2007, SI 2007/3291, r 47(1)(b). The comptroller may direct that such evidence as he may require in connection with the application be sent to him within such period as he may specify: r 47(2).

11 If, however, the application is delayed, there may be possible loss of rights: see PARA 589.

UPDATE

588 Registration of certain transactions etc

NOTES 3, 7--*Tamglass*, cited, overruled, *Siemens*, cited, reversed: [2008] EWCA Civ 1161, [2009] IP & T 527 (see PARA 373).

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589. Effect of registration of certain transactions etc.

Any person who claims to have acquired the property in a patent or an application for a patent by virtue of any of certain transactions, instruments or events¹ is entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event if at the time of the later transaction, instrument or event²:

- 401 (1) the earlier transaction, instrument or event was not registered³; or
- 402 (2) in the case of any application which has not been published, notice of the earlier transaction, instrument or event had not been given to the comptroller⁴; and
- 403 (3) in any case, the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event⁵.

The above provisions apply equally to the case where any person claims to have acquired any right in or under a patent or application by virtue of such a transaction, instrument or event and that right is incompatible with any such right acquired by virtue of an earlier such transaction, instrument or event⁶.

Where a person becomes the proprietor or one of the proprietors or an exclusive licensee⁷ of a patent by virtue of any such transaction, instrument or event and the patent is subsequently infringed, before the transaction, instrument or event is registered in proceedings for such an infringement, the court or comptroller may not award him costs or expenses unless it was so registered within the period of six months beginning with its date or, if it was not practicable to register it within that period, it was registered as soon as practicable thereafter⁸.

1 I.e. a transaction, instrument or event to which the Patents Act 1977 s 33 applies: see s 33(3); and PARA 588.

2 Patents Act 1977 s 33(1).

3 Patents Act 1977 s 33(1)(a). As to registration see PARA 588. Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of s 33(1)(a), registration of the application is treated as registration of the transaction, instrument or event: s 33(4).

4 Patents Act 1977 s 33(1)(b). As to the comptroller see PARA 577.

5 Patents Act 1977 s 33(1)(c).

6 Patents Act 1977 s 33(2).

7 As to the meaning of 'exclusive licensee' see PARA 380 note 7.

8 See the Patents Act 1977 s 68 (amended by SI 2996/1028); and PARA 553.

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590. The register as evidence.

The register of patents is prima facie evidence¹ of anything required or authorised² to be registered³. A certificate purporting to be signed by the comptroller⁴ and certifying that any entry which he is authorised to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, is prima facie evidence of the matters so certified⁵. Each of the following, that is to say:

- 404 (1) a copy of an entry in the register or an extract from the register which is supplied⁶;
- 405 (2) a copy of any document kept in the UK Intellectual Property Office⁷ or an extract from any such document, any specification of a patent or any application for a patent which has been published⁸,

which purports to be a certified copy⁹ or a certified extract¹⁰ must be admitted in evidence without further proof and without production of any original¹¹.

A person may apply to the comptroller, on the prescribed form¹² and on payment of the appropriate fee¹³, for a certified or uncertified copy of an application for a patent which has been published, a specification of a patent or any other document or extract from any such document kept at the UK Intellectual Property Office¹⁴.

1 A person who causes notice of a licence to be registered may be estopped from denying the existence of the licence: *Wilson v Fenton Bros (Glasgow) Ltd* 1957 SLT (Sh Ct) 3.

2 Ie by the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.

3 Patents Act 1977 s 32(9) (s 32 substituted by the Patents, Designs and Marks Act 1986 s 1, Sch 1 para 4; the Patents Act 1977 s 32(9) amended by the Criminal Justice Act 2003 s 332, Sch 37 Pt 6).

4 As to the comptroller see PARA 577.

5 Patents Act 1977 s 32(10) (as substituted: see note 3).

6 Ie under the Patents Act 1977 s 32(6): see PARA 585.

7 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

8 As to the meaning of 'published' see PARA 327 note 7.

9 As to the meaning of 'certified copy' see PARA 585 note 6.

10 As to the meaning of 'certified extract' see PARA 585 note 7.

11 Patents Act 1977 s 32(11) (as substituted (see note 3); and amended by the Criminal Justice Act 2003 Sch 37 Pt 6).

12 The application must be made on Patents Form 23: see the Patents Rules 2007, SI 2007/3291, r 48(5).

13 The fee payable is £20: see the Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1. As to fees see PARA 583.

14 See the Patents Rules 2007, SI 2007/3291, r 48; and PARA 581. A person is not entitled to such a document where it is not available for inspection under the Patents Act 1977 s 118 (see PARA 581) or where making or providing such a copy would infringe copyright: Patents Rules 2007, SI 2007/3291, r 48(3).

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591. Correction and rectification of the register.

On the application of any person aggrieved¹, the court² may order the register of patents to be rectified by the making, variation or deletion of any entry in it³; and in such proceedings the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register⁴. Where the court makes a vesting order⁵ in respect of a patent, it may go on to order rectification accordingly⁶. Where a claim is made for the rectification of the register of patents, the claimant must at the same time as serving the other parties, serve a copy of the claim form and accompanying documents on the comptroller and he is then entitled to take part in the proceedings⁷.

Any person may request that a correction⁸ be entered in the register or made to any application or other document filed at the UK Intellectual Property Office in respect of: (1) his name⁹; (2) his address; or (3) his address for service¹⁰. If the comptroller has reasonable doubts about whether he should make the correction he must inform the person making the request of the reason for his doubts and he may require that person to file evidence in support of the request¹¹. If the comptroller has no doubts, or no longer has doubts, about whether he should make the correction, he must enter the correction in the register or make it to the application or document¹².

Any person may request the correction of an error in the register or in any document filed at the UK Intellectual Property Office in connection with registration¹³. The request must be made in writing and be accompanied by sufficient information to identify the nature of the error and the correction requested¹⁴. If the comptroller has reasonable doubts about whether there is an error he must inform the person making the request of the reason for his doubts and he may require that person to furnish a written explanation of the nature of the error or evidence in support of the request¹⁵. If the comptroller has no doubts, or no longer has doubts, about whether an error has been made he must make such correction as he may agree with the proprietor of the patent (or, as the case may be, the applicant)¹⁶.

Where a body corporate has re-registered¹⁷ with the same name as that with which it was registered immediately before the re-registration save for the substitution as, or the inclusion as, the last part of the name of the words 'public limited company' or their Welsh equivalent or the abbreviation 'plc' or its Welsh equivalent, then references to the name of the body corporate in any application to the comptroller, in the register and in any other record kept at, or any document issued by, the UK Intellectual Property Office and relating to patents are to be treated on and after the date of such re-registration as references to the name with which the body corporate is so re-registered¹⁸.

1 As to the meaning of 'person aggrieved' cf **JUDICIAL REVIEW** vol 61 (2010) PARA 656.

2 As to the meaning of 'court' see PARA 637 note 1.

3 Patents Act 1977 s 34(1). For cases in which orders for rectification have been made see *Re Green's Patent* (1857) 24 Beav 145; *Re Morey's Patent* (1858) 25 Beav 581; *Re Horsley and Knighton's Patent* (1869) LR 8 Eq 475; *Re Hutchinson's Patent*, *Haslett v Hutchinson* (1891) 8 RPC 457, CA; *Re Fletcher's Patent* (1893) 62 LJ Ch 938, 10 RPC 252. No order for rectification will be made if, although incorrect when proceedings were begun, the entry is no longer incorrect at the date of the hearing: *Re Manning's Patent* (1902) 20 RPC 74. Applications for rectification were also refused in *Anderson v Patent Oxonite Co Ltd* (1886) 3 RPC 279; *Re Casey's Patent*, *Stewart v Casey* [1892] 1 Ch 104, 9 RPC 9, CA.

4 Patents Act 1977 s 34(2). Rules of court may provide for the notification of any application under s 34 to the comptroller and for giving effect to any order of the court on the application: s 34(3). As to the comptroller see PARA 577.

5 le under the Trustee Act 1925 s 51: see **TRUSTS** vol 48 (2007 Reissue) PARA 884 et seq.

6 *Re IG Farbenindustrie AG's Agreement* [1941] Ch 147, [1940] 4 All ER 486, 58 RPC 31; revsd [1944] Ch 41, [1943] 2 All ER 525, 60 RPC 193, CA.

7 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 16.

8 For these purposes, a request for a correction includes a correction made for the purposes of the Patents Act 1977 s 117 (see PARA 354): Patents Rules 2007, SI 2007/3291, r 49(6).

9 A request to correct a name must be made on Patents Form 20: Patents Rules 2007, SI 2007/3291, r 49(2). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

10 Patents Rules 2007, SI 2007/3291, r 49(1). A request for the correction of an address or an address for service must be made in writing: r 49(3).

11 Patents Rules 2007, SI 2007/3291, r 49(4).

12 Patents Rules 2007, SI 2007/3291, r 49(5).

13 Patents Rules 2007, SI 2007/3291, r 50(1), which is expressed to be subject to r 49 (see the text and notes 8-12).

14 Patents Rules 2007, SI 2007/3291, r 50(2).

15 Patents Rules 2007, SI 2007/3291, r 50(3).

16 Patents Rules 2007, SI 2007/3291, r 50(4).

17 As to re-registration see **COMPANIES** vol 14 (2009) PARA 167 et seq.

18 Patents (Companies Re-registration) Rules 1982, SI 1982/297, r 2.

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(iii) Proceedings in the UK Intellectual Property Office

592. Discretionary powers.

The comptroller¹ is given² wide discretionary powers in the conduct of proceedings. Thus he may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the UK Intellectual Property Office³, extend time limits except in specified cases⁴, remit fees⁵ and consent to the modification of prescribed forms⁶.

The comptroller has a general discretion to refuse to take, or suspend the taking of, any proceedings on or in relation to an application of an enemy⁷ for a patent⁸. Under the Patents Act 1977 the comptroller has some degree of discretion in respect of the determination of questions concerning entitlement to a patent⁹, amendment to acknowledge a registered trade mark¹⁰, the prohibition or restriction of publication of information prejudicial to defence or public safety¹¹, the amendment of a specification after grant¹², the award of compensation to an employee-inventor¹³, matters relating to licences of right and compulsory licences¹⁴, the revocation of a patent either on application¹⁵ or on his own initiative¹⁶ and the conversion of a European patent application¹⁷.

1 As to the comptroller see PARA 577.

2 Ie by the Patents Rules 2007, SI 2007/3291.

3 Patents Rules 2007, SI 2007/3291, r 107(1). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579. Any rectification made under the Patents Rules 2007, SI 2007/3291, r 107(1) must be made: (1) after giving the parties such notice; and (2) subject to such conditions, as the comptroller may direct: r 107(2). A period of time specified in the Patents Act 1977 or listed in the Patents Rules 2007, SI 2007/3291, r 107, Sch 4 Pts 1-3 (whether it has already expired or not) may be extended under r 107(1) if, and only if: (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the UK Intellectual Property Office; and (b) it appears to the comptroller that the irregularity should be rectified: r 107(3). See PARA 599.

4 See the Patents Rules 2007, SI 2007/3291, r 108; and PARA 599.

5 See the Patents Rules 2007, SI 2007/3291, r 106; and PARA 583.

6 See the Patents Rules 2007, SI 2007/3291, r 4; and PARA 583.

7 For these purposes, 'enemy' has the meaning assigned by the Trading with the Enemy Act 1939 (see s 2; and **WAR AND ARMED CONFLICT** vol 49(1) (2005 Reissue) PARA 577): Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 10(1).

8 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 4(3).

9 See the Patents Act 1977 s 8 (determination before grant: see PARAS 361-362), s 9 (determination after grant of questions referred before grant: see PARA 361) and s 37 (determination of right to patent after grant: see PARA 366).

10 See the Patents Act 1977 s 19(2); and PARA 330.

11 See the Patents Act 1977 s 22; and PARA 335.

12 See the Patents Act 1977 s 27; and PARAS 347-348.

- 13 See the Patents Act 1977 s 40; and PARA 370.
- 14 See the Patents Act 1977 ss 46-49, s 51; and PARA 392 et seq.
- 15 See the Patents Act 1977 s 72; and PARAS 564-565.
- 16 See the Patents Act 1977 s 73; and PARA 571.
- 17 See the Patents Act 1977 s 81; and PARA 678.

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593. Hearing before exercise of discretionary powers.

Without prejudice to any rule of law, the comptroller¹ must give to any party to a proceeding before him an opportunity of being heard² before the comptroller exercises adversely to that party any discretion vested in him by the Patents Act 1977 or the Patents Rules 2007³.

1 As to the comptroller see PARA 577.

2 Thus he must allow a formal hearing before a senior official, followed by a formal decision. In addition, it is the practice to permit informal discussion of objections between applicants and parties and the official making the objection. Objections by and discussions with officials other than the comptroller cannot, however, impose requirements under the Patents Act 1977. A letter from the comptroller raising objections is not a formal exercise of his discretion: see *Re S's Application* [1977] RPC 367, CA (a case relating to an application for a patent under the Patents Act 1949).

3 Patents Act 1977 s 101. As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARA 600 et seq.

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594. Contested proceedings.

There is a standard procedure for contested proceedings, which is used, with more or less variation, in proceedings of different sorts¹.

The comptroller² may make an order for security for costs or expenses against any party to proceedings before him under the Patents Act 1977 if the prescribed conditions are met³ and he is satisfied that it is just to make the order, having regard to all the circumstances of the case; and in default of the required security being given the comptroller may treat the reference, application or notice in question as abandoned⁴.

A party to proceedings before the comptroller⁵ may appear before him in person or be represented by any person whom he desires to represent him⁶. No offence is committed under the enactments relating to the preparation of documents by persons not legally qualified⁷ by reason only of the preparation by any person of a document, other than a deed, for use in such proceedings⁸.

The rule of law which confers privilege from disclosure in legal proceedings⁹ in respect of communications made with a solicitor¹⁰ or a person acting on his behalf, or in relation to information obtained or supplied for submission to a solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in the United Kingdom extends to such communications so made for the purpose of any pending or contemplated proceedings before the comptroller under the Patents Act 1977 or any of the relevant conventions¹¹, or proceedings before the relevant convention court¹² under any of those conventions¹³.

In proceedings before him the comptroller may by order award to any party such costs as he considers reasonable and direct how and by what parties they are to be paid¹⁴.

1 As to proceedings before the comptroller see the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91); and PARA 600 et seq.

2 As to the comptroller see PARA 577.

3 The conditions prescribed for the purposes of making an order for security for costs under the Patents Act 1977 s 107(4) are that the party against whom the order is made: (1) is resident outside the United Kingdom, but not resident in a Brussels Contracting State, a Lugano Contracting State, or a Regulation State, as defined in the Civil Jurisdiction and Judgments Act 1982 s 1(3) (see **CONFLICT OF LAWS** vol 8(3) (Reissue) PARA 65); (2) is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay another party's costs if ordered to do so; (3) has changed his address for service with a view to evading the consequences of the litigation; (4) has furnished an incorrect address for service; or (5) has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him: Patents Rules 2007, SI 2007/3291, r 85. As to the meaning of 'United Kingdom' see PARA 303 note 5.

4 Patents Act 1977 s 107(4) (substituted by the Patents Act 2004 s 15).

5 In any proceedings under the Patents Act 1977 or any treaty or international convention to which the United Kingdom is a party: s 102(1). In its application to proceedings in relation to applications for, or otherwise in connection with, European patents, s 102 has effect subject to any restrictions imposed by or under the European Patent Convention: s 102(4) (s 102 substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 27). As to the meaning of 'European patent' see PARA 668 note 5. As to the European Patent Convention see PARA 668 et seq.

6 Patents Act 1977 s 102(1) (as substituted: see note 5). The Patents Act 1977 s 102(1) (as so substituted) has effect subject to rules made under the Copyright, Designs and Patents Act 1988 s 281 (power of comptroller to refuse to recognise certain agents: see PARA 619): Patents Act 1977 s 102(3) (as substituted: see note 5).

7 As from a day to be appointed, for the purposes of the Patents Act 1977 s 102(2), as it has effect in relation to England and Wales, 'the enactment relating to the preparation of documents by persons not qualified' means the Legal Services Act 2007 s 14 (not yet in force) (offence to carry on a reserved legal activity if not entitled) as it applies in relation to an activity which amounts to the carrying on of reserved instrument activities within the meaning of that Act: Patents Act 1977 s 102(2A) (prospectively added by the Legal Services Act 2007 s 208(1), Sch 21 para 40(a)). At the date at which this volume states the law no such day had been appointed.

8 Patents Act 1977 s 102(2) (as substituted: see note 5). Nothing in the Patents Act 1977 s 102 is to be taken to limit the right to draw or prepare deeds given to a registered patent agent by the Courts and Legal Services Act 1990 s 68 (see PARA 617): Patents Act 1977 s 102(5) (added by the Courts and Legal Services Act 1990 s 125(3), Sch 18 para 20(1)). As from a day to be appointed, nothing in the Patents Act 1977 s 102 is to be taken to limit any entitlement to prepare deeds conferred on a registered patent attorney by virtue of the Legal Services Act 2007: see the Patents Act 1977 s 102(5) (prospectively substituted by the Legal Services Act 2007 Sch 21 para 40(b)). At the date at which this volume states the law no such day had been appointed.

9 For these purposes, 'legal proceedings' includes proceedings before the comptroller; and the references to legal proceedings and pending or contemplated proceedings include references to applications for a patent or a European patent and to international applications for a patent: Patents Act 1977 s 103(2).

10 For these purposes, the reference to a solicitor includes a reference to a body corporate recognised by the Council of the Law Society under the Administration of Justice Act 1985 s 9 (see **LEGAL PROFESSIONS** vol 65 (2008) PARA 688 et seq): Solicitors' Incorporated Practices Order 1991, SI 1991/2684, arts 2(1), 3, 4(a), Sch 1.

11 For these purposes, 'relevant conventions' means the European Patent Convention (see PARA 668 et seq) and the Patent Co-operation Treaty (see PARA 653 et seq): Patents Act 1977 s 103(2) (amended by the Patents Act 2004 s 16(1), (2), Sch 2 paras 1(1), 22, Sch 3).

12 As to the meaning of 'relevant convention court' see PARA 364 note 6.

13 Patents Act 1977 s 103(1). As to patent agents' privilege see PARA 618.

14 Patents Act 1977 s 107(1). Any costs so awarded are recoverable, if a county court so orders, by execution issued from the county court or otherwise as if they were payable under an order of that court: s 107(2). As from a day to be appointed, costs are recoverable under the County Courts Act 1984 s 85 (see **CIVIL PROCEDURE** vol 12 (2009) PARA 1283): see the Patents Act 1977 s 107(2) (prospectively amended by the Tribunals, Courts and Enforcement Act 2007 s 62(3), Sch 13 paras 39, 43). At the date at which this volume states the law no such day had been appointed.

UPDATE

594 Contested proceedings

NOTES 7, 8--Day appointed is, and Legal Services Act 2007 s 14 in force on, 1 January 2010: SI 2009/3250.

NOTE 10--SI 1991/2684 renamed Solicitors' Recognised Bodies Order 1991: SI 2009/500. SI 1991/2684 art 3 amended: SI 2009/500. See also SI 1991/2684 art 5.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(iii) Proceedings in the UK Intellectual Property Office/595. Evidence before the comptroller.

595. Evidence before the comptroller.

Where under the Patents Rules 2007¹ evidence may be filed, the evidence must be by witness statement, statement of case, affidavit, statutory declaration or in any other form which would be admissible as evidence in proceedings before the court². A witness statement or a statement of case may only be given in evidence if it includes a statement of truth³. Evidence is to be by witness statement unless the comptroller directs or any enactment requires otherwise⁴.

The comptroller has the powers of a judge of the High Court as regards the attendance of witnesses and the discovery and production of documents, but he has no power to punish summarily for contempt⁵.

For the purposes of any proceeding under the Patents Act 1977 or the Patents Rules 2007, an address for service must be furnished by: (1) an applicant for the grant of a patent⁶; (2) a person who makes any other application, reference or request or gives any notice of opposition under the Patents Act 1977⁷; and (3) any person opposing such an application, reference, request or notice⁸. The proprietor of a patent, or any person who has registered any right in or under a patent or application, may furnish an address for service by notifying the comptroller⁹. Where a person has furnished an address for service, he may substitute a new address for service by notifying the comptroller¹⁰.

Where a person has failed to furnish an address for service¹¹ and the comptroller has sufficient information enabling him to contact that person, the comptroller must direct that person to furnish an address for service¹². Where such a direction has been given, the person directed, before the end of the period of two months beginning with the date of the direction, must furnish an address for service¹³. Where a direction was given and the period prescribed has expired, or the comptroller had insufficient information to give a such direction and the person has failed to furnish an address for service, then: (a) in the case of an applicant for the grant of a patent, the application is treated as withdrawn; (b) in the case of a person mentioned in head (2) above, his application, reference, request or notice of opposition is treated as withdrawn; and (c) in the case of a person mentioned in head (3) above, he is deemed to have withdrawn from the proceedings¹⁴.

1 Ie the Patents Rules 2007, SI 2007/3291: see PARA 304.

2 Patents Rules 2007, SI 2007/3291, r 87(1). A witness statement, affidavit or statutory declaration must comply with the requirements of r 14, Sch 2 Pt 1 (see PARA 315) unless the comptroller otherwise directs: r 87(4). As to the comptroller see PARA 577. As to expert witness evidence see Tribunal Practice Notice (TPN 6/2007) *Practice in Patent Proceedings before the Comptroller* para 4 [2008] RPC 191.

3 Patents Rules 2007, SI 2007/3291, r 87(2). For the purposes of Pt 7 (rr 73-91) a statement of truth must be dated and signed by: (1) in the case of a witness statement, the person making the statement; and (2) in any other case, the party or his legal representative: r 87(5). As to statements of truth see **CIVIL PROCEDURE** vol 11 (2009) PARA 613.

4 Patents Rules 2007, SI 2007/3291, r 87(3).

5 Patents Rules 2007, SI 2007/3291, r 86.

6 An address for service furnished under head (1) in the text must be an address in the United Kingdom, another EEA state or the Channel Islands: Patents Rules 2007, SI 2007/3291, r 103(4). As to the meaning of 'United Kingdom' see PARA 303 note 5.

7 An address for service furnished under head (2) or head (3) in the text must be an address in the United Kingdom, unless in a particular case the comptroller otherwise directs: Patents Rules 2007, SI 2007/3291, r 103(5).

8 Patents Rules 2007, SI 2007/3291, r 103(1). See note 7.

9 Patents Rules 2007, SI 2007/3291, r 103(2). The address for service must be an address in the United Kingdom, another EEA state or the Channel Islands: Patents Rules 2007, SI 2007/3291, r 103(4).

10 Patents Rules 2007, SI 2007/3291, r 103(3).

11 le under the Patents Rules 2007, SI 2007/3291, r 103(1). 'Address for service' means an address which complies with the requirements of r 103(4) or (5) (see notes 6-7): r 104(5).

12 Patents Rules 2007, SI 2007/3291, r 104(1).

13 Patents Rules 2007, SI 2007/3291, r 104(2). The prescribed time limit may not be extended: see PARA 599.

14 Patents Rules 2007, SI 2007/3291, r 104(3), (4).

UPDATE

595 Evidence before the comptroller

NOTES 6, 7, 11--SI 2007/3291 r 103(4) substituted, r 103(5) revoked, r 104(5) amended: SI 2009/546.

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596. Copies available to the comptroller.

Where an applicant is not required to file a copy of an application at the UK Intellectual Property Office¹ because that application or a copy of that application is available to the comptroller², the comptroller must make a copy (or further copy) of that application and certify it accordingly³.

1 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 As to the comptroller see PARA 577.

3 Patents Rules 2007, SI 2007/3291, r 112.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(iii) Proceedings in the UK Intellectual Property Office/597. Translations of documents.

597. Translations of documents.

Subject to certain exceptions¹, where any document² filed at the UK Intellectual Property Office³, or sent to the comptroller⁴, is in a language other than English or Welsh it must be accompanied by a translation into English of that document⁵. Where more than one copy of the document is filed or sent, a corresponding number of translations must accompany it⁶. Where a document is not accompanied by a translation, the comptroller may, if he thinks fit, take no further action in relation to that document⁷.

In relation to an international application for a patent (UK)⁸, where any document which is in a language other than English or Welsh is referred to in an International Search Report or International Preliminary Report on Patentability or cited in an International Preliminary Examination Report, and the relevant report is filed at the UK Intellectual Property Office, the comptroller may direct that a translation into English of that document be filed⁹. Where such a direction is given, a translation of that document must be filed before the end of the period of two months beginning with the date on which the direction is given; otherwise the comptroller may, if he thinks fit, take no further action in relation to the application¹⁰.

Subject to the power of the comptroller to require a translation¹¹, where a patent application or any document related to such application is filed at the UK Intellectual Property Office or sent to the comptroller in Welsh, and is not accompanied by a translation into English, the comptroller must obtain such a translation¹².

1 The requirement for translation does not apply to the following documents: (1) where the documents filed to initiate an application for a patent include something which is or appears to be a description of the invention, the document containing that thing; (2) a priority application; (3) a copy of an application provided under the Patents Act 1977 s 15(10)(b)(ii) (see PARA 316); (4) a copy of a specification of a European patent (UK) filed in connection with an application by the proprietor to amend the specification (see PARA 675); (5) a copy of an application for a European patent (UK) provided under s 81(2)(b)(ii) (see PARA 678); (6) an international application for a patent (UK), where a translation of the application or an amendment to it is a necessary translation (see PARA 666); (7) a document referred to in the Patents Rules 2007, SI 2007/3291, r 113(5) (see the text to note 9); r 113(2).

2 A reference to a document includes a reference to a part of a document: Patents Rules 2007, SI 2007/3291, r 113(8).

3 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

4 As to the comptroller see PARA 577.

5 Patents Rules 2007, SI 2007/3291, r 113(1). As to the consequences of not filing a translation of a priority document within the prescribed time see *Mitsui Engineering & Shipbuilding Co Ltd's Application* [1984] RPC 471. As to the difficulties with translated documents see *Siemens Schweiz AG v Thorne Security Ltd* [2008] RPC 58.

6 Patents Rules 2007, SI 2007/3291, r 113(3).

7 Patents Rules 2007, SI 2007/3291, r 113(4).

8 As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1.

9 Patents Rules 2007, SI 2007/3291, r 113(5).

10 Patents Rules 2007, SI 2007/3291, r 113(6).

- 11 le under the Patents Rules 2007, SI 2007/3291, r 82(1)(b): see PARA 606.
- 12 Patents Rules 2007, SI 2007/3291, r 113(7).

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598. Certificates.

A certificate purporting to be signed by the comptroller¹ and certifying that any entry which he is authorised to make² has or has not been made, or that any other thing which he is so authorised to do has or has not been done, is prima facie evidence of the matters so certified³. A person may apply on the prescribed form⁴ and on payment of the appropriate fee⁵, for a certificate which certifies that something which the comptroller is authorised to do has or has not been done⁶.

1 As to the comptroller see PARA 577.

2 Ie by the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.

3 Patents Act 1977 s 32(10) (substituted by the Patents, Designs and Marks Act 1986 s 1, Sch 1 para 4). As to the register of patents as evidence see PARA 590.

4 An application must be made on Patent Form 23: see the Patents Rules 2007, SI 2007/3291, r 46(3).

5 The fee payable on application for a certificate in accordance with the Patents Rules 2007, SI 2007/3291, r 46(3) is £20: see the Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1.

6 Patents Rules 2007, SI 2007/3291, r 46(3)(b).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(iii) Proceedings in the UK Intellectual Property Office/599. Extension of time limits.

599. Extension of time limits.

Many of the time limits prescribed for the purposes of patents¹ may not be extended². Other time limits³ may be extended by the comptroller⁴, if he thinks fit⁵, for a period of two months where the request is made upon the prescribed form⁶, no previous request has been made and the request is filed before the end of the period of two months beginning with the date on which the relevant period of time expired⁷. The comptroller may, if he thinks fit, extend or further extend any such period of time⁸ where a request is filed on the prescribed form⁹ and the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs¹⁰. Each request¹¹ for a period of time to be extended must be made on a separate form unless each of those requests relates to the same patent or application for a patent and the grant of each of those requests would result in the expiry of all the extended periods of time on the same date, in which case those requests may be combined and made on a single form¹². Any extension¹³ must be made after giving the parties such notice, and subject to such conditions, as the comptroller may direct¹⁴. An extension may be granted notwithstanding the period of time prescribed by the relevant rule has expired¹⁵.

The comptroller must extend a period specified by the comptroller in connection with an application for a patent, or a patent if the applicant or the proprietor of the patent requests him to do so and the request complies with the prescribed requirements¹⁶.

The comptroller may certify any day as an interrupted day where: (1) there is an event or circumstance causing an interruption in the normal operation of the UK Intellectual Property Office¹⁷; or (2) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom¹⁸. Any such certificate of the comptroller must be displayed in the UK Intellectual Property Office and advertised in the Official Journal (Patents)¹⁹. The comptroller, where the time for doing anything under the Patents Act 1977 expires on an interrupted day, must extend that time to the next following day not being an interrupted day (or an excluded day)²⁰.

The comptroller must extend any period of time specified in the Patents Act 1977 or the Patents Rules 2007 where he is satisfied that the failure to do something under that Act or those Rules was wholly or mainly attributable to a delay in, or failure of, a communication service²¹. Any extension must be made after giving the parties such notice, and subject to such conditions, as the comptroller may direct²².

¹ ie the time limits prescribed by the Patents Rules 2007, SI 2007/3291, r 6(2)(b) (declaration of priority for the purposes of the Patents Act 1977 s 5(2) made after the date of filing) (see PARA 311), the Patents Rules 2007, SI 2007/3291, r 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority) (see PARA 311), r 32(1) (application to reinstate a terminated application) (see PARA 334), rr 37, 38 (renewal of patents) (see PARA 340), r 40(1) (application to restore a lapsed patent) (see PARA 356), r 43(4) (application to cancel entry that licence available as of right) (see PARA 393), r 58(3) (request for a direction under the Patents Act 1977 s 81) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 59(1) (request from a foreign industrial property office for a direction under the Patents Act 1977 s 81) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 66(3) (period for making a request to the comptroller for permission to make a late declaration of priority in respect of an international application for a patent (UK)) (see PARA 311), r 76(2) (notice of opposition), except in relation to an opposition under the Patents Act 1977 s 27(5) where there are pending before the court or the comptroller proceedings in which the validity of the patent is put in issue (see PARA 601), the Patents Rules 2007, SI 2007/3291, r 77(8), (10) (opposition periods) (see PARA 602), r 104(2) (period for filing an address for service), in relation to an application for a patent (see PARA 595), r 109

(extension of time limits specified by comptroller), r 116(2) (fee for supplementary protection certificate) (see PARA 342), Sch 1 para 8(5) (new deposits of biological material) (see PARA 322).

2 Patents Rules 2007, SI 2007/3291, r 108(1), Sch 4 Pt 1.

3 In any period of time prescribed by the following provisions: the Patents Rules 2007, SI 2007/3291, r 8(1), (2) (filing of information and priority documents) (see PARA 311), r 10(3) (filing of statement of inventorship and the right to be granted a patent) (see PARA 308), r 18(1) (missing parts) (see PARA 316), r 21 (extensions for new applications) (see PARA 308), r 22(1), (2), (5) (periods prescribed for the purposes of the Patents Act 1977 ss 15(10), 17(1)) (see PARAS 316, 328), the Patents Rules 2007, SI 2007/3291, r 28(2), (3), (5) (request for substantive examination) (see PARA 329), r 30 (period for putting an application in order) (see PARA 329), r 58(4) (request under the Patents Act 1977 s 81(2)(b)(i)) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 59(3) (request under the Patents Act 1977 s 81(2)(b)(ii)) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 60 (request for substantive examination following a direction under the Patents Act 1977 s 81) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 66(1), (2) (international applications for patents: entry into national phase) (see PARA 665), r 68 (international applications for patents: altered prescribed periods) (see PARA 308), Sch 1 para 3(2) (filing of information in relation to the deposit of biological matter) (see PARA 322): r 108(1), Sch 4 Pt 2.

4 As to the comptroller see PARA 577.

5 Patents Rules 2007, SI 2007/3291, r 108(1).

6 A request must be filed on Patents Form 52: Patents Rules 2007, SI 2007/3291, r 108(2)(a). The fee payable on request for extension of a period of time in accordance with r 108(2), (3) is £135: Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1.

7 Patents Rules 2007, SI 2007/3291, r 108(2).

8 In any period of time prescribed by the rules listed in the Patents Rules 2007, SI 2007/3291, Sch 4 Pt 2: see note 3.

9 In on Patents Form 52: see the Patents Rules 2007, SI 2007/3291, r 108(3).

10 Patents Rules 2007, SI 2007/3291, r 108(3).

11 In under the Patents Rules 2007, SI 2007/3291, r 108(2) or (3).

12 Patents Rules 2007, SI 2007/3291, r 108(4).

13 In under the Patents Rules 2007, SI 2007/3291, r 108(1) or (3).

14 Patents Rules 2007, SI 2007/3291, r 108(5). A period of time prescribed by the following rules listed in Sch 4 Pt 3 may be extended (or further extended) for a period of two months only: r 108(5). Those rules are: r 10(3) (filing of statement of inventorship and the right to be granted a patent) (see PARA 308), r 12(3), (9) (filing of name and address and translations) (see PARAS 315, 319), r 19 (new applications filed as mentioned in the Patents Act 1977 s 15(9)) (see PARA 316), the Patents Rules 2007, SI 2007/3291, r 21(1)(a), (2)(a) (extensions for new applications) (see PARA 308), r 22 (periods prescribed for the purposes of the Patents Act 1977 ss 15(10), 17(1)) (see PARAS 316, 328), the Patents Rules 2007, SI 2007/3291, r 28 (request for substantive examination) (see PARA 329), r 30 (period for putting application in order) (see PARA 329), r 58(4) (request under the Patents Act 1977 s 81(2)(b)(i)) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 59(3) (request under the Patents Act 1977 s 81(2)(b)(ii)) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 60 (request for substantive examination following a direction under the Patents Act 1977 s 81) (see PARA 678), the Patents Rules 2007, SI 2007/3291, r 66(1), (2) (international applications for patents: entry into national phase) (see PARA 665), r 68 (international applications for patents: altered prescribed periods) (see PARA 308): Sch 4 Pt 3.

15 Patents Rules 2007, SI 2007/3291, r 108(6). No extension may be granted in relation to the periods of time prescribed by the rules listed in Sch 4 Pt 3 (see note 14) after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired: r 108(7).

16 Patents Act 1977 s 117B(1), (2) (s 117B added by SI 2004/2357). A request under the Patents Act 1977 s 117B(2) must be: (1) made in writing; and (2) made before the end of the period prescribed by the Patents Rules 2007, SI 2007/3291, r 109(2): r 109(1). The period prescribed for the purposes of the Patents Act 1977 s 117B(3) is two months beginning immediately after the expiry of the period to which s 117B(2) applies: Patents Rules 2007, SI 2007/3291, r 109(2). An extension of a period under the Patents Act 1977 s 117B(2) expires at the end of the period prescribed for these purposes or, if sooner, at the end of the period prescribed for the purposes of s 20 (see PARA 332): s 117B(3) (as so added). If a period has already been extended under s 117B(2), that provision does not apply in relation to it again, and the comptroller may further extend the period

subject to such conditions as he thinks fit: s 117B(4) (as so added). The provisions of s 117B(2) do not apply to a period specified in relation to proceedings before the comptroller: s 117B(5) (as so added).

17 Patents Rules 2007, SI 2007/3291, r 110(1)(a). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

18 Patents Rules 2007, SI 2007/3291, r 110(1)(b). As to the meaning of 'United Kingdom' see PARA 303 note 5.

19 Patents Rules 2007, SI 2007/3291, r 110(2). As to the Journal see PARA 580.

20 Patents Rules 2007, SI 2007/3291, r 110(3). As to excluded days see PARA 579 note 5. This may be retrospective: see *Omron Tateisi Electronic Co's Application* [1981] RPC 125. See also *Armaturjonsson AB's Application* [1985] RPC 213.

21 Patents Rules 2007, SI 2007/3291, r 111(1). 'Communication service' means a service by which documents may be sent and delivered and includes post, electronic communications, and courier: Patents Rules 2007, SI 2007/3291, r 111(3).

22 Patents Rules 2007, SI 2007/3291, r 111(2).

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(iv) Proceedings Heard before the Comptroller

600. Application of procedural rules, overriding objective and publication of notices.

Procedural rules govern certain proceedings before the comptroller¹ in relation to applications, references and requests² and oppositions³. Rules also apply to proceedings heard before the comptroller under the Patents Act 1977⁴.

The procedural rules⁵ set out a procedural code with the overriding objective of enabling the comptroller to deal with cases justly⁶. Dealing with a case justly includes, so far as is practicable:

- 406 (1) ensuring that the parties are on an equal footing⁷;
- 407 (2) saving expense⁸;
- 408 (3) dealing with the case in ways which are proportionate to the amount of money involved, to the importance of the case, to the complexity of the issues and to the financial position of each party⁹;
- 409 (4) ensuring that it is dealt with expeditiously and fairly¹⁰; and
- 410 (5) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases¹¹.

The comptroller must seek to give effect to the overriding objective when he exercises any power given to him in relation to proceedings before him¹² or interprets any procedural rule¹³. The parties are required to help the comptroller to further the overriding objective¹⁴.

The comptroller must advertise in the Official Journal (Patents)¹⁵ any event to which it is possible to object under any of the oppositions which start proceedings¹⁶ or the oppositions after proceedings have started¹⁷.

1 As to the comptroller see PARA 577.

2 The proceedings under the provisions mentioned in r 73, Sch 3 Pt 1: r 73(1)(a). Those provisions are: the Patents Act 1977 s 8(1) (reference regarding entitlement in relation to a patent under the Patents Act 1977) (see PARA 362), s 10 (request for directions for handling a joint application) (see PARA 361), s 11(5) (reference regarding entitlement to a licence to continue working after transfer of application) (see PARA 363), s 12(1) (reference regarding entitlement in relation to a foreign or convention patent) (see PARA 364), s 12(4) (reference involving joint applications on entitlement in relation to a foreign or convention patent) (see PARA 364), s 13(3) (application to comptroller to remove person mentioned as inventor) (see PARA 308), s 37(1) (determination of right to patent after grant) (see PARA 366), s 38(5) (reference regarding entitlement to a licence to continue working after transfer of patent) (see PARA 368), s 40 (application for compensation by an employee) (see PARA 370), s 41(8) (application to vary order for compensation for certain inventions) (see PARA 371), s 46(3) (application to settle terms of licence available as of right) (see PARA 392), s 47(3) (application to cancel licence available as of right) (see PARA 393), s 48(1) (application for a compulsory licence) (see PARA 395), s 50A(2) (application following merger and market investigation) (see PARA 398), s 51(1) (application by minister following report of Competition Commission) (see PARA 399), s 52(2)(a) (application to cancel compulsory licence) (see PARA 400), s 61(3) (reference on question of infringement before the comptroller) (see PARA 523), s 71 (declaration of non-infringement) (see PARA 556), s 72 (application to revoke patent) (see PARA 564); the Patents Rules 2007, SI 2007/3291, r 10(2) (application to be mentioned as inventor) (see PARA 308), r 88(1) (application to hold proceedings in Scotland), Sch 1 para 7(4) (notice of objection to expert) (see PARA 322); EC Regulation 816/2006 of the European Parliament and of the Council on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (OJ L157,

9.6.2006, p 1) (the 'Compulsory Licensing Regulation') art 5(c) (application to terminate EU compulsory licence), art 6(1) (application for an EU compulsory licence), art 10(8) (application to access books and records), art 16(1), second paragraph, (application for a review of an EU compulsory licence), art 16(4) (application for modification of an EU compulsory licence) (see PARA 402); EC Council Regulation 1768/92 concerning the creation of a supplementary protection certificate for medicinal products (OJ L182, 2.7.92, p 1) (the 'Medicinal Products Regulation') art 14(d) (request to review lapse of supplementary protection certificate), art 15 (application for declaration of invalidity of supplementary protection certificate), art 15a (application for revocation of an extension of the duration of a supplementary protection certificate) (see PARA 341); and EC Regulation 1610/96 of the European Parliament and Council concerning the creation of a supplementary protection certificate for plant protection products (OJ L198, 8.8.96, p 30) (the 'Plant Protection Products Regulation') arts 14(d), 15.

3 Ie oppositions under the provisions mentioned in the Patents Rules 2007, SI 2007/3291, Sch 3 Pt 2: r 73(1) (b). Those provisions are: the Patents Act 1977 s 27(5) (opposition to amendment of specification after grant) (see PARA 348), s 29(2) (opposition to surrender of patent) (see PARA 359), s 47(6) (opposition to cancellation of licence available as of right), where the application was made by the proprietor of the patent (see PARA 393), s 75(2) (opposition to amendment during infringement or revocation proceedings) (see PARA 348), s 117(2) (opposition to correction of error in patents and applications) (see PARA 354).

4 Patents Rules 2007, SI 2007/3291, r 73(2). The rules listed in Sch 3 Pt 4 apply to such proceedings: r 73(2). The rules are: r 74 (overriding objective), r 79 (copies of documents) (see PARA 604), r 80(2)-(6) (evidence and the hearing) (see PARA 605), r 81 (alteration of time limits) (see PARA 606), r 82 (general powers of the comptroller in relation to proceedings before him) (see PARA 606), r 84 (hearings in public) (see PARA 608), r 87 (evidence in proceedings before the comptroller) (see PARA 595).

5 Ie the rules set out in the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91).

6 Patents Rules 2007, SI 2007/3291, r 74(1).

7 Patents Rules 2007, SI 2007/3291, r 74(2)(a).

8 Patents Rules 2007, SI 2007/3291, r 74(2)(b).

9 Patents Rules 2007, SI 2007/3291, r 74(2)(c). As to security for costs or expenses see r 85; and PARA 594.

10 Patents Rules 2007, SI 2007/3291, r 74(2)(d).

11 Patents Rules 2007, SI 2007/3291, r 74(2)(e).

12 Ie any power given to the comptroller by the Patents Rules 2007, SI 2007/3291, Pt 7.

13 Patents Rules 2007, SI 2007/3291, r 74(3).

14 Patents Rules 2007, SI 2007/3291, r 74(4).

15 As to the Journal see PARA 580. Where the comptroller determines that no person could reasonably object to the correction, no advertisement need be published: Patents Rules 2007, SI 2007/3291, rr 75, 105(5).

16 Ie any of the provisions mentioned in the Patents Rules 2007, SI 2007/3291, Sch 3 Pt 2: see note 3.

17 Patents Rules 2007, SI 2007/3291, r 75. The oppositions after proceedings have started are under the Patents Act 1977 s 47(6) (opposition to cancellation of licence available as of right), where the application was made by a person other than the proprietor of the patent (see PARA 393), s 52(1) (opposition to an application for compulsory licence or under s 50A or s 51) (see PARAS 398-399), s 52(2)(b) (opposition to an application to cancel a compulsory licence) (see PARA 400): Patents Rules 2007, SI 2007/3291, Sch 3 Pt 3.

UPDATE

600 Application of procedural rules, overriding objective and publication of notices

NOTE 2--Regulation 1768/92 replaced: see PARA 341.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(iv) Proceedings Heard before the Comptroller/601. Starting proceedings.

601. Starting proceedings.

Proceedings are started when a person files in duplicate the relevant form¹ and his statement of grounds².

Any person may give notice of opposition to the amendment of a patent³ before the end of the period of two weeks beginning with the date of the advertisement of proposed amendment in the Official Journal (Patents)⁴. In the case of other oppositions⁵, any person may give notice of opposition before the end of the period of four weeks beginning with the date of the advertisement in the journal⁶.

A statement of grounds must:

- 411 (1) include a concise statement of the facts and grounds on which the claimant relies⁷;
- 412 (2) where applicable⁸, include the grounds of objection to the draft licence⁹;
- 413 (3) where appropriate, include the period or terms of the licence which he believes are reasonable¹⁰;
- 414 (4) specify the remedy which he seeks¹¹;
- 415 (5) where it accompanies an application under the Compulsory Licensing Regulation¹², include any information required by that Regulation¹³;
- 416 (6) be verified by a statement of truth¹⁴; and
- 417 (7) comply with the statutory requirements for documents¹⁵.

1 'Relevant form' means: (1) in relation to applications or requests under the provisions of the Medicinal Products Regulation or the Plant Protection Products Regulation mentioned in the Patents Rules 2007, SI 2007/3291, Sch 3 Pt 1 (see PARA 600 note 2), Patents Form SP3; (2) in relation to applications, references or requests under any other provision mentioned in Sch 3 Pt 1 (see PARA 600 note 2), Patents Form 2; and (3) in relation to oppositions under the provisions mentioned in Sch 3 Pt 2 (see PARA 600 note 3), Patents Form 15: r 76(3).

2 Patents Rules 2007, SI 2007/3291, r 76(1). 'Statement of grounds' means a statement filed by the claimant; and 'claimant' means a person who starts proceedings or is treated as starting proceedings under r 76(1): r 73(3).

3 In the case of opposition under the Patents Act 1977 s 75(2): see PARA 348.

4 Patents Rules 2007, SI 2007/3291, r 76(2)(a). As to the Journal see PARA 580.

5 In any of the other oppositions mentioned in the Patents Rules 2007, SI 2007/3291, Sch 3 Pt 2: see PARA 600 note 3.

6 Patents Rules 2007, SI 2007/3291, r 76(2). The prescribed time limit may not be extended: see PARA 599.

7 Patents Rules 2007, SI 2007/3291, r 76(4)(a).

8 In the case of the Patents Rules 2007, SI 2007/3291, r 89(5): see PARA 392.

9 Patents Rules 2007, SI 2007/3291, r 76(4)(b).

10 Patents Rules 2007, SI 2007/3291, r 76(4)(c).

11 Patents Rules 2007, SI 2007/3291, r 76(4)(d).

12 le EC Regulation 816/2006 of the European Parliament and of the Council on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems (OJ L157, 9.6.2006, p 1) (the 'Compulsory Licensing Regulation'): see PARA 402.

13 Patents Rules 2007, SI 2007/3291, r 76(4)(e).

14 Patents Rules 2007, SI 2007/3291, r 76(4)(f). 'Statement of truth' means a statement that the person making the statement believes that the facts stated in a particular document are true: r 73(3).

15 Patents Rules 2007, SI 2007/3291, r 76(4)(g). The statutory requirements for documents are those set out in Sch 2 Pt 1: see PARA 315.

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602. Notification of the parties.

The comptroller¹ must notify the applicant for, or proprietor of, the patent which is the subject matter of the case that proceedings have started². In addition, the comptroller may notify any persons who appear to him to be likely to have an interest in the case that proceedings have started³. However, where such a person is the claimant⁴, or has indicated in writing to the comptroller that he supports the claimant's case, the comptroller has no duty to notify him⁵. The comptroller must send the relevant form⁶ and the statement of grounds⁷ with the notification⁸. In that notification, the comptroller must specify a period within which the persons notified may file a counter-statement⁹; and any counter-statement must be filed in duplicate before the end of the period specified¹⁰.

Where a person was notified that proceedings have started and that person fails to file a counter-statement¹¹, the comptroller must treat him as supporting the claimant's case¹².

1 As to the comptroller see PARA 577.

2 Patents Rules 2007, SI 2007/3291, r 77(1).

3 Patents Rules 2007, SI 2007/3291, r 77(2).

4 As to the meaning of 'claimant' see PARA 601 note 2.

5 Patents Rules 2007, SI 2007/3291, r 77(3).

6 As to the meaning of 'relevant form' see PARA 601 note 1.

7 As to the meaning of 'statement of grounds' see PARA 601 note 2.

8 Patents Rules 2007, SI 2007/3291, r 77(4).

9 Patents Rules 2007, SI 2007/3291, r 77(5). As to the counter-statement see PARA 603. Rule 77(5), (6) does not apply to an opposition under any of the provisions mentioned in Sch 3 Pt 3 (see PARA 600 note 17): r 77(7). In such oppositions, any counter-statement must be filed in duplicate before the end of the period of four weeks beginning with the date of the advertisement in the Official Journal (Patents) (see PARA 580) mentioned in r 75 (see PARA 600): r 77(8). The prescribed time limit may not be extended: see PARA 599.

10 Patents Rules 2007, SI 2007/3291, r 77(6). See note 9.

11 Ie under the Patents Rules 2007, SI 2007/3291, r 77(6) or (8).

12 Patents Rules 2007, SI 2007/3291, r 77(9).

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603. The counter-statement.

Any counter-statement filed by the defendant¹ must:

- 418 (1) state which of the allegations in the statement of grounds² he denies³;
- 419 (2) state which of the allegations he is unable to admit or deny, but which he requires the claimant⁴ to prove⁵;
- 420 (3) state which of the allegations he admits⁶;
- 421 (4) be verified by a statement of truth⁷; and
- 422 (5) comply with the formal requirements for documents⁸.

Where the defendant denies an allegation he must state his reasons for doing so and, if he intends to put forward a different version of events from that given by the claimant, he must state his own version⁹.

A defendant who fails to deal with an allegation in a counter-statement is taken to admit that allegation¹⁰. However, a defendant who fails to deal with an allegation but has set out in his counter-statement the nature of his case in relation to the issue to which the allegation is relevant, is taken to require the allegation to be proved¹¹.

1 'Defendant' means a person who files a counter-statement under the Patents Rules 2007, SI 2007/3291, r 77(6) or (8): r 73(3).

2 As to the meaning of 'statement of grounds' see PARA 601 note 2.

3 Patents Rules 2007, SI 2007/3291, r 78(1)(a).

4 As to the meaning of 'claimant' see PARA 601 note 2.

5 Patents Rules 2007, SI 2007/3291, r 78(1)(b).

6 Patents Rules 2007, SI 2007/3291, r 78(1)(c).

7 Patents Rules 2007, SI 2007/3291, r 78(1)(d). As to the meaning of 'statement of truth' see PARA 601 note 14.

8 Patents Rules 2007, SI 2007/3291, r 78(1)(e). The formal requirements are those set out in r 14, Sch 2 Pt 1: see PARA 315.

9 Patents Rules 2007, SI 2007/3291, r 78(2).

10 Patents Rules 2007, SI 2007/3291, r 78(3).

11 Patents Rules 2007, SI 2007/3291, r 78(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(iv) Proceedings Heard before the Comptroller/604. Copies of documents.

604. Copies of documents.

Where a witness statement¹, statement of case², affidavit or statutory declaration (a 'relevant statement') refers to any other document, a copy of that document must accompany the relevant statement³. Where more than one copy of a relevant statement is filed, each copy of the statement must be accompanied by a copy of any document referred to in the statement⁴. These requirements do not apply where the relevant statement is sent to the comptroller⁵ and the document referred to in the relevant statement was published by the comptroller or is kept at the UK Intellectual Property Office⁶.

1 'Witness statement' means a written statement signed by a person that contains the evidence which that person would be allowed to give orally: Patents Rules 2007, SI 2007/3291, r 73(3).

2 'Statement of case' means the statement of grounds or the counter-statement and references to a statement of case include part of the statement of case: Patents Rules 2007, SI 2007/3291, r 73(3).

3 Patents Rules 2007, SI 2007/3291, r 79(1), (4).

4 Patents Rules 2007, SI 2007/3291, r 79(2).

5 As to the comptroller see PARA 577.

6 Patents Rules 2007, SI 2007/3291, r 79(3). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(iv) Proceedings Heard before the Comptroller/605. Evidence rounds and the hearing.

605. Evidence rounds and the hearing.

When the defendant¹ files a counter-statement², the comptroller³ must as soon as practicable send the counter-statement to the claimant⁴. The comptroller must also specify the periods within which evidence may be filed by the claimant and the defendant⁵.

The comptroller may, at any time he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit⁶. Under this provision, evidence is only to be considered to be filed when: (1) it has been received by the comptroller; and (2) it has been sent to all the other parties to the proceedings⁷.

The comptroller must then give the parties an opportunity to be heard⁸. If any party requests to be heard, the comptroller must send to the parties notice of a date for the hearing⁹.

When the comptroller has decided the matter he must notify all the parties of his decision, including his reasons for making the decision¹⁰.

1 As to the meaning of 'defendant' see PARA 603 note 1.

2 As to the counter-statement see PARA 603.

3 As to the comptroller see PARA 577.

4 Patents Rules 2007, SI 2007/3291, r 80(1)(a). As to the meaning of 'claimant' see PARA 601 note 2.

5 Patents Rules 2007, SI 2007/3291, r 80(1)(b).

6 Patents Rules 2007, SI 2007/3291, r 80(2). As to evidence in proceedings before the comptroller see PARA 595.

7 Patents Rules 2007, SI 2007/3291, r 80(3).

8 Patents Rules 2007, SI 2007/3291, r 80(4).

9 Patents Rules 2007, SI 2007/3291, r 80(5).

10 Patents Rules 2007, SI 2007/3291, r 80(6).

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606. General powers of the comptroller.

The comptroller¹ has a number of general procedural powers. The comptroller may extend or shorten (or further extend or shorten) any period of time which has been specified under any of the statutory provisions relating to proceedings².

Except where otherwise provided³, the comptroller may give such directions as to the management of the proceedings as he thinks fit⁴, and in particular he may:

- 423 (1) require a document, information or evidence to be filed⁵;
- 424 (2) require a translation of a specification of a patent or application or any other document which is not in English⁶;
- 425 (3) require a party or a party's legal representative to attend a hearing⁷;
- 426 (4) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication⁸;
- 427 (5) allow a statement of case⁹ to be amended¹⁰;
- 428 (6) stay the whole, or any part, of the proceedings either generally or until a specified date or event¹¹;
- 429 (7) consolidate proceedings¹²;
- 430 (8) direct that part of any proceedings be dealt with as separate proceedings¹³;
- and
- 431 (9) direct that the parties attend a case management conference or pre-hearing review¹⁴.

The comptroller may control the evidence by giving directions as to the issues on which he requires evidence, the nature of the evidence which he requires to decide those issues and the way in which the evidence is to be placed before him¹⁵. The comptroller may also use his power to exclude evidence which would otherwise be admissible¹⁶.

When the comptroller gives directions¹⁷, he may make them subject to conditions and may specify the consequence of failure to comply with the directions or a condition¹⁸.

The comptroller has the powers of a judge of the High Court as regards the attendance of witnesses and the discovery and production of documents, but he has no power to punish summarily for contempt¹⁹.

1 As to the comptroller see PARA 577.

2 Patents Rules 2007, SI 2007/3291, r 81(1). The statutory provisions relating to proceedings are those in Pt 7 (rr 73-91). An extension may be granted notwithstanding the period of time specified has expired: r 81(2).

3 Ie by the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.

4 Patents Rules 2007, SI 2007/3291, r 82(1).

5 Patents Rules 2007, SI 2007/3291, r 82(1)(a).

6 Patents Rules 2007, SI 2007/3291, r 82(1)(b).

7 Patents Rules 2007, SI 2007/3291, r 82(1)(c).

- 8 Patents Rules 2007, SI 2007/3291, r 82(1)(d). As to evidence rounds and the hearing see PARA 605.
- 9 As to the meaning of 'statement of case' see PARA 604 note 2.
- 10 Patents Rules 2007, SI 2007/3291, r 82(1)(e).
- 11 Patents Rules 2007, SI 2007/3291, r 82(1)(f).
- 12 Patents Rules 2007, SI 2007/3291, r 82(1)(g).
- 13 Patents Rules 2007, SI 2007/3291, r 82(1)(h).
- 14 Patents Rules 2007, SI 2007/3291, r 82(1)(i).
- 15 Patents Rules 2007, SI 2007/3291, r 82(2).
- 16 Patents Rules 2007, SI 2007/3291, r 82(2).
- 17 le under any provision of the Patents Rules 2007, SI 2007/3291, Pt 7 (rr 73-91).
- 18 Patents Rules 2007, SI 2007/3291, r 82(3).
- 19 Patents Rules 2007, SI 2007/3291, r 86. See also PARA 595.

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607. Striking out a statement of case and summary judgment.

A party may apply to the comptroller¹ for him to strike out a statement of case² or to give summary judgment³.

The comptroller may strike out the statement of case if it appears to him that: (1) the statement of case discloses no reasonable grounds for bringing or defending the claim; (2) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or (3) there has been a failure to comply with a statutory provision⁴ or a previous direction given by the comptroller⁵.

The comptroller may give summary judgment against a claimant⁶ or defendant⁷ on the whole of a case or on a particular issue if: (a) he considers that that claimant has no real prospect of succeeding on the case or issue, or that defendant has no real prospect of successfully defending the case or issue; and (b) there is no other compelling reason why the case or issue should be disposed of at a hearing⁸.

1 As to the comptroller see PARA 577.

2 As to the meaning of 'statement of case' see PARA 604 note 2.

3 Patents Rules 2007, SI 2007/3291, r 83(1).

4 Ie a provision of the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291.

5 Patents Rules 2007, SI 2007/3291, r 83(2).

6 As to the meaning of 'claimant' see PARA 601 note 2.

7 As to the meaning of 'defendant' see PARA 603 note 1.

8 Patents Rules 2007, SI 2007/3291, r 83(3).

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608. Hearings in public.

Any hearing¹ before the comptroller² in proceedings relating to an application for a patent, or a patent, must be held in public³. However, any party to the proceedings may apply to the comptroller for a hearing to be held in private⁴. The comptroller may grant such an application where (1) he considers there is good reason for the hearing to be held in private; and (2) all the parties to the proceedings have had an opportunity to be heard on the matter, and where the application is granted the hearing must be held in private⁵. Any hearing of an application for a hearing to be held in private, or relating to an application for a patent which has not been published⁶, must be held in private⁷.

1 For these purposes, a reference to a hearing includes any part of a hearing: Patents Rules 2007, SI 2007/3291, r 84(5).

2 As to the comptroller see PARA 577.

3 Patents Rules 2007, SI 2007/3291, r 84(1).

4 Patents Rules 2007, SI 2007/3291, r 84(2).

5 Patents Rules 2007, SI 2007/3291, r 84(3).

6 As to publication see PARA 327.

7 Patents Rules 2007, SI 2007/3291, r 84(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(v) Offences/609. Unauthorised claim of patent rights.

(v) Offences

609. Unauthorised claim of patent rights.

If a person falsely represents that anything disposed of by him for value is a patented product¹, he is liable on summary conviction to a fine². For these purposes, a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word 'patent' or 'patented' or anything expressing or implying that it is a patented product is taken to represent that the article is a patented product³.

The above provisions⁴ do not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made, or does not continue to be made⁵. Where, however, the word 'patent' forms part of the accepted name of the article, its use will not be such a representation⁶.

In proceedings for such an offence it is a defence for the accused to prove that he used due diligence to prevent the commission of the offence⁷.

Even where a patent exists, to threaten to sue for infringement of it may be an actionable wrong⁸.

1 As to the meaning of 'patented product' see PARA 372 note 11.

2 Patents Act 1977 s 110(1). The fine must not exceed level 3 on the standard scale: Patents Act 1977 s 110(1) (amended by the Criminal Justice Act 1982 ss 39, 46). As to offences by bodies corporate see PARA 613.

'Standard scale' means the standard scale of maximum fines for summary offences as set out in the Criminal Justice Act 1982 s 37: see the Interpretation Act 1978 s 5, Sch 1 (definition added by the Criminal Justice Act 1988 s 170(1), Sch 15 para 58); and **SENTENCING AND DISPOSITION OF OFFENDERS** vol 92 (2010) PARA 142. At the date at which this volume states the law, the standard scale is as follows: level 1, £200; level 2, £500; level 3, £1,000; level 4, £2,500; level 5, £5,000: Criminal Justice Act 1982 s 37(2) (substituted by the Criminal Justice Act 1991 s 17(1)). As to the determination of the amount of the fine actually imposed, as distinct from the level on the standard scale which it may not exceed, see the Criminal Justice Act 2003 s 164; and **SENTENCING AND DISPOSITION OF OFFENDERS** vol 92 (2010) PARA 144.

3 Patents Act 1977 s 110(2).

4 Ie the Patents Act 1977 s 110(1): see the text and notes 1-2.

5 Patents Act 1977 s 110(3).

6 *Sykes v Sykes* (1824) 3 B & C 541; *Cheavin v Walker* (1877) 5 ChD 850, CA; *Gridley v Swinborne* (1888) 52 JP 791, DC.

7 Patents Act 1977 s 110(4).

8 See PARA 557 et seq.

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610. Unauthorised claim that patent applied for.

If a person represents that a patent has been applied for in respect of any article disposed of for value by him and:

- 432 (1) no such application has been made; or
- 433 (2) if made, has been refused or withdrawn,

he is liable on summary conviction to a fine¹. For these purposes, a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words 'patent applied for' or 'patent pending' or anything expressing or implying that a patent has been applied for in respect of the article is taken to represent that a patent has been applied for in respect of it². Where, however, the word 'patent' forms part of the accepted name of the article, its use will not be such a representation³.

Head (2) above does not, however, apply where the representation is made, or continues to be made, before the expiry of a period which commences with the refusal or withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made, or does not continue to be made⁴.

In any proceedings for such an offence it is a defence for the accused to prove that he used due diligence to prevent the commission of such an offence⁵.

1 Patents Act 1977 s 111(1). The fine must not exceed level 3 on the standard scale: s 111(1) (amended by the Criminal Justice Act 1982 ss 39, 46). As to the standard scale see PARA 609 note 2. As to offences by bodies corporate see PARA 613.

2 Patents Act 1977 s 111(3).

3 *Sykes v Sykes* (1824) 3 B & C 541; *Cheavin v Walker* (1877) 5 ChD 850, CA; *Gridley v Swinborne* (1888) 52 JP 791, DC.

4 Patents Act 1977 s 111(2).

5 Patents Act 1977 s 111(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(v) Offences/611. Falsification of the register etc.

611. Falsification of the register etc.

If a person makes or causes to be made a false entry in any register kept under the Patents Act 1977¹, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he is guilty of an offence².

1 As to the register of patents see PARA 585 et seq.

2 Patents Act 1977 s 109. A person guilty of such an offence is liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or to both or on summary conviction to a fine not exceeding the prescribed sum: s 109 (amended by the Magistrates' Courts Act 1980 s 32(2)). As to the prescribed sum see PARA 336 note 17. As to offences by bodies corporate see PARA 613.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(1) ADMINISTRATION/(v) Offences/612. Use of the words 'Patent Office'.

612. Use of the words 'Patent Office'.

If any person uses on his place of business, or on any document issued by him, or otherwise, the words 'Patent Office' or any other words suggesting that his place of business is, or is officially connected with, the UK Intellectual Property Office¹, he is liable on summary conviction to a fine².

¹ The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

² Patents Act 1977 s 112. The fine must not exceed level 4 on the standard scale: s 112 (amended by the Criminal Justice Act 1982 ss 39, 46). As to the standard scale see PARA 609 note 2. As to offences by bodies corporate see PARA 613.

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613. Offences by corporations.

Where an offence under the Patents Act 1977 which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he, as well as the body corporate, is guilty of that offence and is liable to be proceeded against and punished accordingly¹.

Where the affairs of a body corporate are managed by its members, the above provisions apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate².

1 Patents Act 1977 s 113(1).

2 Patents Act 1977 s 113(2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(i) In general/614. Meaning and function of 'patent agent'.

(2) PATENT AGENTS

(i) In general

614. Meaning and function of 'patent agent'.

Any individual, partnership or body corporate may carry on the business of acting as agent for others for the purpose of:

- 434 (1) applying for or obtaining patents, in the United Kingdom¹ or elsewhere; or
- 435 (2) conducting proceedings before the comptroller² relating to applications for, or otherwise in connection with, patents³.

The above provisions do not, however, affect any restriction under the European Patent Convention⁴ as to who may act on behalf of another for any purpose relating to European patents⁵.

Most applications for patents are filed and prosecuted, and most UK Intellectual Property Office⁶ proceedings are conducted, through patent agents⁷. A patent agent is expected to be familiar with the practice of obtaining patents, so that ignorance of decisions which have an important bearing on that practice would as a rule render him liable to a client injured in consequence⁸.

1 As to the meaning of 'United Kingdom' see PARA 303 note 5.

2 As to the comptroller see PARA 577.

3 Copyright, Designs and Patents Act 1988 s 274(1). This provision is expressed to be subject to ss 275-286 and, as from a day to be appointed, to the Legal Services Act 2007: see the Copyright, Designs and Patents Act 1988 s 274 (prospectively amended by the Legal Services Act 2007 s 185(1), (2)). At the date at which this volume states the law no such day had been appointed. See further **LEGAL PROFESSIONS**.

4 As to the European Patent Convention see PARA 668 et seq.

5 Copyright, Designs and Patents Act 1988 s 274(2). As to the meaning of 'European patent' see PARA 668 note 5.

6 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

7 Any party to proceedings before the comptroller may, however, appear before the comptroller in person or be represented by any person whom he desires to represent him: see the Patents Act 1977 s 102(1); and PARA 594. Any act required or authorised by the Patents Act 1977 or the Patents Rules 2007, SI 2007/3291, to be done by or to any person in connection with an application for a patent, or any procedure relating to a patent, may be done by or to an agent authorised by that person orally or in writing: (1) where an agent is appointed when a person starts or joins any proceeding under the Patents Act 1977, once the comptroller has been notified of his appointment in writing; or (2) where an agent is appointed after a person has started or joined any proceeding under the Patents Act 1977, once Patents Form 51 has been filed in duplicate: Patents Rules 2007, SI 2007/3291, r 101(1). Where an agent has been authorised, the comptroller may, in any particular case, require the signature or presence of his principal: r 101(2). As to discovery of the patent agent's files in legal proceedings about the patent see PARA 618; and as to the appearance of patent agents on appeals to the Patents Court see PARA 640.

8 *Lee v Walker* (1872) LR 7 CP 121. As to the liability where an agent allows a patent to lapse see *Turnbull & Co v Cruikshank and Fairweather* (1905) 22 RPC 363 (on appeal 22 RPC 521, CA); as to the liability where an agent fails to put in order an application by the last possible date so that it becomes void see *Andrew Master Hones Ltd v Cruikshank and Fairweather* [1980] RPC 16; and as to liability for negligent statements apart from contract see *Hedley Byrne & Co Ltd v Heller & Partners Ltd* [1964] AC 465, [1963] 2 All ER 575, HL; *Caparo Industries plc v Dickman* [1990] 2 AC 605, [1990] 1 All ER 568, HL; and **NEGLIGENCE** vol 78 (2010) PARA 14. As to the steps a patent agent ought to take to verify the accuracy of data given to it by a specialist patent searching firm see *Arbiter Group plc v Gill Jennings & Every* [2001] RPC 67, CA; *Finocard International Ltd (t/a The Ninja Corpn) v Urquhart Dyke & Lord (a firm)* [2005] EWHC 2481 (Ch), [2006] FSR 505 (failure to record licence timeously).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(i) In general/615. Restrictions on practice.

615. Restrictions on practice.

An individual who is not a registered patent agent¹ must not:

- 436 (1) carry on a business, otherwise than in partnership, under any name or other description which contains the words 'patent agent' or 'patent attorney'; or
- 437 (2) in the course of a business otherwise describe himself, or permit himself to be described, as a 'patent agent' or 'patent attorney'².

A partnership must not:

- 438 (a) carry on a business under any name or other description which contains the words 'patent agent' or 'patent attorney'; or
- 439 (b) in the course of a business otherwise describe itself, or permit itself to be described, as a firm of 'patent agents' or 'patent attorneys',

unless all the partners are registered patent agents or the partnership satisfies such conditions as may be prescribed³.

A body corporate must not:

- 440 (i) carry on a business, otherwise than in partnership, under any name or other description which contains the words 'patent agent' or 'patent attorney'; or
- 441 (ii) in the course of a business otherwise describe itself, or permit itself to be described, as a 'patent agent' or 'patent attorney',

unless all the directors⁴ of the body corporate are registered patent agents or the body satisfies such conditions as may be prescribed⁵.

Where the above provisions would be contravened by the use of the words 'patent agent' or 'patent attorney' in reference to an individual, partnership or body corporate, they are equally contravened by the use of other expressions in reference to that person, or his business or place of business, which are likely to be understood as indicating that he is entitled to be described as a 'patent agent' or 'patent attorney'⁶.

A person who contravenes the above provisions commits an offence and is liable on summary conviction to a fine⁷; and proceedings for such an offence may be begun at any time within a year from the date of the offence⁸.

The term 'patent attorney' may be used in reference to a solicitor, and a firm of solicitors may be described as a firm of 'patent attorneys', without any contravention of the above provisions⁹. No offence is committed under the enactments¹⁰ restricting the use of certain expressions in reference to persons not qualified to act as solicitors by the use of the term 'patent attorney' in reference to a registered patent agent or by the use of the term 'European patent attorney' in reference to a person on the European list¹¹.

¹ For these purposes, 'registered patent agent' means a person whose name is entered in the register of patent agents kept under the Copyright, Designs and Patents Act 1988 s 275 (see PARA 620): ss 275(1), 286.

As from a day to be appointed, the Copyright, Designs and Patents Act 1988 is amended by the Legal Services Act 2007 which will replace registered patent agents with registered patent attorneys. As from that day, there will continue to be a register of persons who act as agent for others for the purpose of applying for or obtaining patents: s 275(1) (s 275 prospectively substituted by the Legal Services Act 2007 s 185(1), (3)). A registered patent attorney means an individual whose name is entered on the register kept under the Copyright, Designs and Patents Act 1988 s 275: s 275(2) (as so prospectively substituted). The register is to be kept by the Chartered Institute of Patent Attorneys: s 275(3) (as so prospectively substituted). The Secretary of State may, by order, amend s 275(3) so as to require the register to be kept by the person specified in the order: s 275(4) (as so prospectively substituted). Before making an order under s 275(4), the Secretary of State must consult the Legal Services Board: s 275(5) (as so prospectively substituted). Such an order must be made by statutory instrument and may not be made unless a draft of it has been laid before, and approved by a resolution of, each House of Parliament: s 275(6), (7) (as so prospectively substituted). The person who keeps the register under s 275 may make regulations which regulate the keeping of the register and the registration of persons and the carrying on of patent attorney work by registered persons: s 275A(1) (s 275A prospectively added by the Legal Services Act 2007 s 185(1), (3)). Those regulations may, amongst other things, make: (1) provision as to the educational and training qualifications, and other requirements, which must be satisfied before an individual may be registered or for an individual to remain registered; (2) provision as to the requirements which must be met by a body (corporate or unincorporate) before it may be registered, or for it to remain registered, including provision as to the management and control of the body; (3) provision as to the educational, training and other requirements to be met by regulated persons; (4) provision regulating the practice, conduct and discipline of registered persons or regulated persons; (5) provision authorising in such cases as may be specified in the regulations the erasure from the register of the name of any person registered in it, or the suspension of a person's registration; (6) provision requiring the payment of such fees as may be specified in or determined in accordance with the regulations; (7) provision about the provision to be made by registered persons in respect of complaints made against them; (8) provision about the keeping by registered persons or regulated persons of records and accounts; (9) provision for reviews of or appeals against decisions made under the regulations; (10) provision as to the indemnification of registered persons or regulated persons against losses arising from claims in respect of civil liability incurred by them: s 275A(2) (as so prospectively added). Regulations may make different provision for different purposes: s 275A(3) (as so prospectively added). Regulations under this provision which are not regulatory arrangements within the meaning of the Legal Services Act 2007 are to be treated as such arrangements for the purposes of that Act: s 275A(4) (as so prospectively added). Before the appointed day (ie the day appointed for the coming into force of the Legal Services Act 2007 Sch 4 para 1), such regulations may be made only with the approval of the Secretary of State: s 275A(5), (7) (as so prospectively added). The powers conferred to make regulations under this provision are not to be taken to prejudice: (a) any other power which the person who keeps the register may have to make rules or regulations (however they may be described and whether they are made under an enactment or otherwise); and (b) any rules or regulations made by that person under any such power: s 275A(6) (as so prospectively added). 'Manager', in relation to a body, has the same meaning as in the Legal Services Act 2007 s 207; 'patent attorney work' means work done in the course of carrying on the business of acting as agent for others for the purpose of applying for or obtaining patents, in the United Kingdom or elsewhere, or conducting proceedings before the comptroller relating to applications for, or otherwise in connection with, patents; 'registered person' means a registered patent attorney, or a body (corporate or unincorporate) registered in the register kept under the Copyright, Designs and Patents Act 1988 s 275; 'regulated person' means a person who is not a registered person but is a manager or employee of a body which is a registered person: s 275A(7) (as so prospectively added). At the date at which this volume states the law no such day had been appointed.

As from a day to be appointed, the Chartered Institute of Patent Attorneys is an approved regulator in relation to certain reserved legal activities under the Legal Services Act 2007: see the Legal Services Act 2007 s 20(2), Sch 4 para 1(1) (not yet in force). Those activities are the exercise of a right of audience, the conduct of litigation, reserved instrument activities and the administration of oaths: Legal Services Act 2007 Sch 4 para 1(2), table (not yet in force). At the date at which this volume states the law no such day had been appointed.

2 Copyright, Designs and Patents Act 1988 s 276(1). Section 276 has effect subject to s 277 (persons entitled to describe themselves as European patent attorneys etc: see PARA 636) and s 278(1) (use of term 'patent attorney' in reference to solicitors): s 276(7). For the purposes of s 276(7)(b), the reference to a solicitor includes a reference to a body corporate recognised by the Council of the Law Society under the Administration of Justice Act 1985 s 9: Solicitors' Incorporated Practices Order 1991, SI 1991/2684, arts 2(1), 3, 4(a), Sch 1.

3 Copyright, Designs and Patents Act 1988 s 276(2). As from a day to be appointed, this provision also applies to other incorporated bodies and the partnership or other body must be registered in the register kept under s 275: see s 276(2) (prospectively amended by the Legal Services Act 2007 s 185(1), (4)).

As to the power to prescribe conditions see PARA 616. For the purposes of the Copyright, Designs and Patents Act 1988 s 276(2) and s 276(3), the conditions to be satisfied, in the case of a partnership where not all the partners are patent agents or in the case of a body corporate where not all the directors are patent agents are: (1) that each partner or, as the case may be, director must be a person whose name is entered in at least one of the registers kept pursuant to rules made under s 275 (see PARA 620) and the Trade Marks Act 1994 s 83 (register of trade mark agents: see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 39); (2) that at

least one-quarter of the partners or, as the case may be, the directors must be patent agents; and (3) where the names of any of the partners or, as the case may be, of any of the directors appear on any professional advertisement, circular or letter issued by or with the consent of the partnership or body corporate and which relates to it or its business, that each partner and director so named who is a patent agent is clearly identified as such: Patent Agents (Mixed Partnerships and Bodies Corporate) Rules 1994, SI 1994/362, r 3; Interpretation Act 1978 s 17(2)(a).

4 For these purposes, 'director', in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate: Copyright, Designs and Patents Act 1988 s 286.

5 Copyright, Designs and Patents Act 1988 s 276(3). As from a day to be appointed, the body corporate must be registered in the register kept under s 275: see s 276(3) (prospectively amended by the Legal Services Act 2007 s 185(1), (4)). As to the prescribed conditions see note 3. The Copyright, Designs and Patents Act 1988 s 276(3) does not, however, apply to a company which began to carry on business as a patent agent before 17 November 1917 if the name of a director or the manager of the company who is a registered patent agent is mentioned as being so registered in all professional advertisements, circulars or letters issued by or with the company's consent on which its name appears: s 276(4). As from a day to be appointed, this provision is amended to refer to a registered patent attorney: see s 276(4) (prospectively amended by the Legal Services Act 2007 s 208(1), Sch 21 paras 75, 76).

6 Copyright, Designs and Patents Act 1988 s 276(5).

7 The fine must not exceed level 5 on the standard scale: Copyright, Designs and Patents Act 1988 s 276(6). As to the standard scale see PARA 609 note 2.

8 Copyright, Designs and Patents Act 1988 s 276(6). Proceedings for an offence under Pt V (ss 274-286) alleged to have been committed by a partnership must be brought in the name of the partnership and not in that of the partners; but without prejudice to any liability of theirs under s 285(4): s 285(1). The following provisions apply for the purposes of such proceedings as in relation to a body corporate, namely any rules of court relating to the service of documents and the Magistrates' Courts Act 1980 s 46, Sch 3 (procedure on charge of offence by corporations: see **MAGISTRATES** vol 29(2) (Reissue) PARA 666): Copyright, Designs and Patents Act 1988 s 285(2). A fine imposed on a partnership on its conviction in such proceedings must be paid out of the partnership assets: s 285(3). Where a partnership is guilty of such an offence, every partner, other than the partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly: s 285(4).

Where an offence under Pt V (ss 274-286) committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly: s 285(5).

9 Copyright, Designs and Patents Act 1988 s 278(1). For the purposes of s 278(1), the reference to a solicitor does not include a reference to a body corporate recognised by the Council of the Law Society under the Administration of Justice Act 1985 s 9 (see **LEGAL PROFESSIONS** vol 65 (2008) PARA 688 et seq); but the reference to 'a firm of solicitors' being described as 'a firm of patent attorneys' is to be construed as including a body corporate recognised by the Council of the Law Society under s 9 being described as 'patent attorneys': Solicitors' Incorporated Practices Order 1991, SI 1991/2684, arts 2(2), 3, 4(b), Sch 2.

10 The enactments so referred to are the Solicitors Act 1974 s 21 (see **LEGAL PROFESSIONS** vol 65 (2008) PARA 591) and the Solicitors (Northern Ireland) Order 1976, SI 1976/582 (NI 12): Copyright, Designs and Patents Act 1988 s 278(3).

11 Copyright, Designs and Patents Act 1988 s 278(2). For these purposes, 'European list' means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention: Copyright, Designs and Patents Act 1988 s 286. As to the European Patent Convention see PARA 668 et seq.

UPDATE

615 Restrictions on practice

NOTES 1, 3, 5--Day appointed is 1 January 2010: SI 2009/3250.

NOTES 2, 9--SI 1991/2684 renamed Solicitors' Recognised Bodies Order 1991: SI 2009/500. SI 1991/2684 art 3 amended: SI 2009/500. See also SI 1991/2684 art 5.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(i) In general/616. Power to prescribe conditions etc for mixed partnerships and bodies corporate.

616. Power to prescribe conditions etc for mixed partnerships and bodies corporate.

Until a day to be appointed¹, the Secretary of State² may make rules:

- 442 (1) prescribing the conditions to be satisfied for the purposes of the statutory provisions relating to persons entitled to describe themselves as patent agents³ in relation to a partnership where not all the partners are qualified persons⁴ or a body corporate where not all the directors are qualified persons; and
- 443 (2) imposing requirements to be complied with by such partnerships and bodies corporate⁵.

The rules may, in particular:

- 444 (a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons;
- 445 (b) impose requirements as to the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to it or to its business, and as to the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons⁶.

Contravention of a requirement imposed by the rules is an offence for which a person is liable on summary conviction to a fine⁷.

The Secretary of State may make rules prescribing for the purposes of the statutory provisions relating to persons entitled to describe themselves as European patent attorneys etc⁸ the number or proportion of partners of a partnership or directors of a body corporate who must be qualified persons in order for the partnership or body to take advantage of those provisions⁹.

Rules under the above provisions must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament¹⁰.

1 As from a day to be appointed, the Copyright, Designs and Patents Act 1988 s 279 is repealed by the Legal Services Act 2007 ss 185(1), (5), 210, Sch 23. As from that day, rules may be made under the Legal Services Act 2007 s 275A (not yet in force) (see PARA 615 note 1). At the date at which this volume states the law no such day had been appointed.

2 As to the Secretary of State see PARA 575.

3 I.e. the Copyright, Designs and Patents Act 1988 s 276: see PARA 615.

4 For these purposes, 'qualified person': (1) in the Copyright, Designs and Patents Act 1988 s 279(1), (2) means a person who is a registered patent agent; and (2) in s 279(4) means a person who is on the European list: s 279(5). As to the meaning of 'registered patent agent' see PARA 615 note 1; and as to the meaning of 'European list' see PARA 615 note 11.

5 Copyright, Designs and Patents Act 1988 s 279(1). In exercise of the power so conferred the Secretary of State has made the Patent Agents (Mixed Partnerships and Bodies Corporate) Rules 1994, SI 1994/362 (see PARA 615 note 3) which came into force on 24 March 1994: r 1.

6 Copyright, Designs and Patents Act 1988 s 279(2).

7 Copyright, Designs and Patents Act 1988 s 279(3). The fine must not exceed level 5 on the standard scale:
s 279(3). As to the standard scale see PARA 609 note 2.

8 In the Copyright, Designs and Patents Act 1988 s 277: see PARA 636.

9 Copyright, Designs and Patents Act 1988 s 279(4).

10 Copyright, Designs and Patents Act 1988 s 279(6).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(i) In general/617. Preparation of documents by patent agents.

617. Preparation of documents by patent agents.

No offence is committed under the enactments relating to the preparation of documents by persons not legally qualified¹ by reason only of the preparation by any person of a document, other than a deed, for use in proceedings before the comptroller². A registered patent agent³ has the right to draw or prepare any instrument, including a deed, relating to any invention, design, technical information or trade mark⁴.

1 As from a day to be appointed, for the purposes of the Patents Act 1977 s 102(2), as it has effect in relation to England and Wales, 'the enactment relating to the preparation of documents by persons not qualified' means the Legal Services Act 2007 s 14 (not yet in force) (offence to carry on a reserved legal activity if not entitled) as it applies in relation to an activity which amounts to the carrying on of reserved instrument activities within the meaning of that Act: Patents Act 1977 s 102(2A) (prospectively added by the Legal Services Act 2007 s 208(1), Sch 21 para 40(a)). At the date at which this volume states the law no such day had been appointed.

2 Patents Act 1977 s 102(2) (s 102 substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 27). Nothing in the Patents Act 1977 s 102(2) is to be taken to limit the right to draw or prepare deeds given to a registered patent agent by the Courts and Legal Services Act 1990 s 68: Patents Act 1977 s 102(5) (added by the Courts and Legal Services Act 1990 s 125(3), Sch 18 para 20(1)). As from a day to be appointed, nothing in the Patents Act 1977 s 102(2) is to be taken to limit any entitlement to prepare deeds conferred on a registered patent attorney by virtue of the Legal Services Act 2007: Patents Act 1977 s 102(5) (prospectively substituted by the Legal Services Act 2007 Sch 21 para 40(b)).

3 For these purposes, 'registered patent agent' has the same meaning as in the Copyright, Designs and Patents Act 1988 s 275(1) (see PARA 615 note 1): Solicitors Act 1974 s 22(3A) (added by the Courts and Legal Services Act 1990 s 68(1), (3); amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 5(1),(3)(b)). As from a day to be appointed, the Solicitors Act 1974 s 22 is repealed by the Legal Services Act 2007 ss 177, 210, Sch 16 paras 1, 26(a), Sch 23). At the date at which this volume states the law no such day had been appointed.

4 Solicitors Act 1974 s 22(2)(ab) (added by the Courts and Legal Services Act 1990 s 68(1), (2); amended by the Trade Marks Act 1994 Sch 4 para 5(1), (2); and prospectively repealed (see note 3)). As to trade marks see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 2 et seq.

UPDATE

617 Preparation of documents by patent agents

NOTES 1-3--Day appointed is 1 January 2010: SI 2009/3250.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(i) In general/618. Privilege for communications with patent agents.

618. Privilege for communications with patent agents.

Any communication as to any matter relating to the protection of any invention, design, technical information or trade mark, or as to any matter involving passing off¹ between a person and his patent agent² or for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent, is privileged from disclosure in legal proceedings in England, Wales or Northern Ireland in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor³.

1 As from a day to be appointed, documents, material or information relating to any such matter are also privileged: see the Copyright, Designs and Patents Act 1988 s 280(1)(b) (prospectively added by the Legal Services Act 2007 s 208(1), Sch 21 paras 75, 77(b)). At the date at which this volume states the law no such day had been appointed.

2 For these purposes, 'patent agent' means: (1) a registered patent agent or a person who is on the European list; (2) a partnership entitled to describe itself as a firm of patent agents or as a firm carrying on the business of a European patent attorney; or (3) a body corporate entitled to describe itself as a patent agent or as a company carrying on the business of a European patent attorney: Copyright, Designs and Patents Act 1988 s 280(3). As to the meaning of 'registered patent agent' see PARA 615 note 1; and as to the meaning of 'European list' see PARA 615 note 11. As from a day to be appointed, the term 'patent agent' is replaced by the term 'patent attorney', and also includes an unincorporated body, other than a partnership, entitled to describe itself as a patent attorney: see s 280(3) (prospectively amended by the Legal Services Act 2007 s 185(1), (6), Sch 21 paras 75, 77(d)). At the date at which this volume states the law no such day had been appointed.

3 Copyright, Designs and Patents Act 1988 s 280(1), (2) (s 280(1) amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 8(1), (3)). As to the extension of privilege for communications with solicitors relating to patent proceedings see the Patents Act 1977 s 103; and PARA 594. As from a day to be appointed, where a patent attorney (see note 2) acts for a client in relation to a privileged matter (see the text and note 1), any communication, document, material or information is privileged from disclosure in like manner as if the patent attorney had at all material times been acting as the client's solicitor: see the Copyright, Designs and Patents Act 1988 s 280(2) (prospectively substituted by the Legal Services Act 2007 Sch 21 paras 75, 77(c)). At the date at which this volume states the law no such day had been appointed.

UPDATE

618 Privilege for communications with patent agents

NOTES 1-3--Day appointed is 1 January 2010: SI 2009/3250.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(i) In general/619. Power of comptroller to refuse to deal with certain agents.

619. Power of comptroller to refuse to deal with certain agents.

Any act required or authorised by the Patents Act 1977 or the Patents Rules 2007 to be done by or to any person in connection with an application for a patent, or any procedure relating to a patent, may be done by or to an agent authorised by that person orally or in writing¹. Where an agent has been authorised, the comptroller may, in any particular case, require the signature or presence of his principal².

The Secretary of State³ may make rules authorising the comptroller to refuse to recognise as agent in respect of any business under the Patents Act 1977:

- 446 (1) a person who has been convicted of specified offences⁴;
- 447 (2) an individual whose name has been erased from and not restored to, or who is suspended from, the register of patent agents⁵ on the ground of misconduct;
- 448 (3) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent agents⁶, render him liable to have his name erased from the register on the ground of misconduct;
- 449 (4) a partnership or body corporate of which one of the partners or directors⁷ is a person whom the comptroller could refuse to recognise under head (1), (2) or (3) above⁸.

The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may in particular prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct⁹.

Such rules must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament¹⁰.

The comptroller is accordingly authorised to refuse to recognise as agent in respect of any business under the Patents Act 1977:

- 450 (a) a person who has been convicted of specified offences¹¹;
- 451 (b) an individual whose name has been erased from and not restored to the register of patent agents on the ground of misconduct;
- 452 (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent agents, render him liable to have his name erased from the register on the ground of misconduct;
- 453 (d) a partnership or body corporate of which one of the partners or directors is a person whom the comptroller could refuse to recognise under head (a), (b) or (c) above¹².

The comptroller must refuse to recognise as agent in respect of any business under the Patents Act 1977 a person who neither resides nor has a place of business in the United Kingdom¹³, the Isle of Man or another member state of the European Union¹⁴.

1 Patents Rules 2007, SI 2007/3291, r 101(1). Where an agent is appointed when a person starts or joins any proceeding under the Patents Act 1977, the comptroller must first be notified of his appointment in writing: Patents Rules 2007, SI 2007/3291, r 101(1)(a). Where an agent is appointed after a person has started or joined any proceeding under the Patents Act 1977, Patents Form 51 must first be filed in duplicate: Patents Rules 2007, SI 2007/3291, r 101(1)(b). As to the comptroller see PARA 577.

2 Patents Rules 2007, SI 2007/3291, r 101(2).

3 As to the Secretary of State see PARA 575.

4 Is an offence under the Patents Act 1949 s 88 (repealed), the Patents Act 1977 s 114 (repealed) or the Copyright, Designs and Patents Act 1988 s 276 (see PARA 615).

5 As to the register of patent agents see PARA 620 et seq. As from a day to be appointed, this provision refers to the register of patent attorneys (see PARA 615 note 1): see the Copyright, Designs and Patents Act 1988 s 281(2)(b) (prospectively amended by the Legal Services Act 2007 s 208(1), Sch 21 paras 75, 78). At the date at which this volume states the law no such day had been appointed.

6 See note 5.

7 As to the meaning of 'director' see PARA 615 note 4.

8 Copyright, Designs and Patents Act 1988 s 281(1), (2). In exercise of the power so conferred the Secretary of State has made the Patent Agents (Non-recognition of Certain Agents by Comptroller) Rules 1990, SI 1990/1454, which came into force on 13 August 1990: see r 1. As to the Secretary of State's power to make rules authorising the comptroller to refuse to recognise specified persons as agents in respect of business under the Registered Designs Act 1949 see PARA 690.

9 Copyright, Designs and Patents Act 1988 s 281(3).

10 Copyright, Designs and Patents Act 1988 s 281(4).

11 See note 4.

12 Patent Agents (Non-recognition of Certain Agents by Comptroller) Rules 1990, SI 1990/1454, r 3.

13 As to the meaning of 'United Kingdom' see PARA 303 note 5.

14 Copyright, Designs and Patents Act 1988 s 281(5).

UPDATE

619 Power of comptroller to refuse to deal with certain agents

TEXT AND NOTES 3-8--Copyright, Designs and Patents Act 1988 s 281(2) amended: SI 2009/3348.

NOTE 5--Day appointed is 1 January 2010: SI 2009/3250.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(ii) The Register of Patent Agents/620. In general.

(ii) The Register of Patent Agents

620. In general.

The Secretary of State¹ may make rules requiring the keeping of a register of persons who act as agent for others for the purposes of applying for or obtaining patents². The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons, and may in particular:

- 454 (1) require the payment of such fees as may be prescribed; and
- 455 (2) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person's registration³.

The rules may delegate the keeping of the register to another person, and may confer on that person:

- 456 (a) power to make regulations with respect to the payment of fees, in the cases and subject to the limits prescribed by the rules and with respect to any other matter which could be regulated by rules; and
- 457 (b) such other functions, including disciplinary functions, as may be prescribed by rules⁴.

Rules under the above provisions must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament⁵.

1 As to the Secretary of State see PARA 575.

2 Copyright, Designs and Patents Act 1988 s 275(1). In exercise of the power so conferred the Secretary of State has made the Register of Patent Agents Rules 1990, SI 1990/1457 (see PARA 621 et seq) which came into force on 13 August 1990: see r 1. As from a day to be appointed, the Copyright, Designs and Patents Act 1988 s 275 is repealed by the Legal Services Act 2007 ss 185(1), (5), 210, Sch 23. As from that day, rules may be made under the Legal Services Act 2007 s 275A (not yet in force) (see PARA 615 note 1). At the date at which this volume states the law no such day had been appointed.

3 Copyright, Designs and Patents Act 1988 s 275(2). See note 2.

4 Copyright, Designs and Patents Act 1988 s 275(3). See note 2.

5 Copyright, Designs and Patents Act 1988 s 275(4). See note 2.

UPDATE

620 In general

NOTE 2--SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(ii) The Register of Patent Agents/621. The register.

621. The register.

The register formerly kept¹ by the Chartered Institute of Patent Attorneys is the register² to be kept and the Institute must continue to keep the same; and any person whose name was on 13 August 1990 entered in the register is³ a registered patent agent⁴.

There must be entered in the register the name of each person who is entitled to be registered⁵, together with his business address, the date of his registration, his qualifications for registration, and such other particulars as the registrar⁶ may, at the request of that person, think fit to include⁷. A registered patent agent must give notice to the registrar of any change in the particulars relating to him entered in the register; and the registrar must, on payment of the prescribed fee⁸, if any, amend the register accordingly⁹.

Not later than 1 April in each year the Institute must cause to be printed, published and placed on sale a copy of the entries in the register, with the names arranged alphabetically, as at the end of the preceding calendar year¹⁰.

The registrar may, on being duly satisfied that any entry in the register has been made in error or that any entry is incorrect, erase or correct the same¹¹. No erasure or correction of any entry in the register may be so made unless the registrar has first served notice of the proposed erasure or correction on the person appearing to him to be affected, has afforded that person the opportunity to make written representations regarding the same and has taken into account any such representations¹².

Names may also be erased for failure to pay the annual practising fee¹³ or after due inquiry into misconduct¹⁴.

The comptroller may from time to time give general directions to the Institute as to any matters relating to the register¹⁵.

1 Ie the register formerly kept under the Register of Patent Agents Rules 1978, SI 1978/1093 (amended by SI 1982/1428) (revoked).

2 For these purposes, 'register' means the register required to be kept under the Register of Patent Agents Rules 1990, SI 1990/1457 (see PARA 622 et seq): r 2.

3 Ie for the purposes of the Register of Patent Agents Rules 1990, SI 1990/1457.

4 Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 3(1). For these purposes, 'registered patent agent' means a person whose name is entered in the register: r 2.

5 Ie pursuant to the Register of Patent Agents Rules 1990, SI 1990/1457, r 10: see PARA 627.

6 For these purposes, 'registrar' means the person appointed in accordance with the Register of Patent Agents Rules 1990, SI 1990/1457, r 7 (see PARA 623) to maintain the register: r 2.

7 Register of Patent Agents Rules 1990, SI 1990/1457, r 3(2).

8 Ie the fee, if any, prescribed by regulations under the Register of Patent Agents Rules 1990, SI 1990/1457, r 20: see PARA 634.

9 Register of Patent Agents Rules 1990, SI 1990/1457, r 11.

10 Register of Patent Agents Rules 1990, SI 1990/1457, r 6.

- 11 Register of Patent Agents Rules 1990, SI 1990/1457, r 13(1).
- 12 Register of Patent Agents Rules 1990, SI 1990/1457, r 13(2).
- 13 See the Register of Patent Agents Rules 1990, SI 1990/1457, r 12; and PARA 628.
- 14 See the Register of Patent Agents Rules 1990, SI 1990/1457, r 14; and PARA 629.
- 15 Register of Patent Agents Rules 1990, SI 1990/1457, r 21.

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(ii) The Register of Patent Agents/622. Special record.

622. Special record.

The special record formerly kept¹ for the transfer thereto of the names and other particulars of persons whose names have been erased from the register formerly kept² is the special record to be kept³; and any name transferred thereto and not restored to the register⁴ remains⁵ a named erased from the register⁶.

The registrar⁷ must continue to keep the special record and must transfer thereto the names and particulars of any person whose name has been erased⁸ and he must enter therein, against such name, the reason for the erasure⁹.

1 le the special record formerly kept under the Register of Patent Agents Rules 1978, SI 1978/1093, r 4 (revoked).

2 le under the Register of Patent Agents Rules 1978, SI 1978/1093 (amended by SI 1982/1428) (revoked).

3 le for the purposes of the Register of Patent Agents Rules 1990, SI 1990/1457: see PARAS 621, 623 et seq.

4 See note 2 *supra*.

5 le unless restored to the register under the Register of Patent Agents Rules 1990, SI 1990/1457. As to the meaning of 'register' see PARA 621 note 2.

6 Register of Patent Agents Rules 1990, SI 1990/1457, r 4(1).

7 As to the meaning of 'registrar' see PARA 621 note 6.

8 le under the Register of Patent Agents Rules 1990, SI 1990/1457, r 12 (see PARA 628) or r 13 (see PARA 621) or pursuant to a direction under r 14 (see PARA 629).

9 Register of Patent Agents Rules 1990, SI 1990/1457, r 4(2).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(ii) The Register of Patent Agents/623. The registrar.

623. The registrar.

There must be a registrar who is charged with the duty of maintaining the register¹ and the special record² and who is³ under the direction of the Chartered Institute of Patent Attorneys⁴. The registrar must be appointed by the Institute for a period of one year and is eligible, on ceasing to hold office, for re-appointment⁵. He holds office and must vacate his office in accordance with such terms and conditions as the Institute may, after consultation with the comptroller, determine⁶.

1 As to the meaning of 'register' see PARA 621 note 2.

2 As to the special record see PARA 622.

3 He is subject to the Register of Patent Agents Rules 1990, SI 1990/1457, and to any general directions of the comptroller. As to the comptroller see PARA 577.

4 Register of Patent Agents Rules 1990, SI 1990/1457, r 7(1).

5 Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 7(2).

6 Register of Patent Agents Rules 1990, SI 1990/1457, r 7(2).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/(ii) The Register of Patent Agents/624. Inspection of register and special record.

624. Inspection of register and special record.

The register¹ and the special record² or, if they are kept otherwise than in documentary form, entries therein made available in documentary form, must be open to public inspection at such times and in such manner as the registrar³ may, subject to any general directions of the comptroller, direct⁴.

1 As to the meaning of 'register' see PARA 621 note 2.

2 As to the special record see PARA 622.

3 As to the registrar see PARA 623.

4 Register of Patent Agents Rules 1990, SI 1990/1457, r 5.

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/625. Qualifying examinations.

(iii) Qualifications for Registration

625. Qualifying examinations.

The Chartered Institute of Patent Attorneys may, by regulations made by it after consultation with the Institute of Trade Mark Attorneys¹ and with the approval of the comptroller², make provision for such educational qualifications, training and qualifying examinations, which examinations must be offered at least once in every year, as it considers appropriate for the registration of persons³, and has⁴ the entire management and control of such examinations⁵.

The comptroller may from time to time give general directions to the Institute in relation to such matters as in his opinion will be conducive to the better regulation of any examinations held by the Institute⁶.

1 As to the Institute of Trade Mark Attorneys see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 40.

2 As to the comptroller see PARA 577.

3 Ie under the Register of Patent Agents Rules 1990, SI 1990/1457.

4 Ie subject to any such regulations and any general directions of the comptroller under the Register of Patent Agents Rules 1990, SI 1990/1457, r 21: see the text to note 7.

5 Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 8(1) (amended by SI 1999/983). Transitional provision could be made for candidates who entered for examinations pursuant to the Register of Patent Agents Rules 1978, SI 1978/1093, r 8 (revoked): see the Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 8(2).

6 Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 21.

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/626. Qualifications for registration.

626. Qualifications for registration.

A person who has passed the qualifying examinations¹ of the Chartered Institute of Patent Attorneys and who has completed:

- 458 (1) not less than two years' full-time practice in the field of intellectual property, including substantial experience in patent agency work², under the supervision of either a registered patent agent³ or of a barrister, solicitor, or, in Scotland or the Isle of Man, an advocate, being a barrister or solicitor or advocate who is engaged in or has substantial experience of patent agency work in the United Kingdom; or
- 459 (2) not less than four years' full-time practice in the field of intellectual property, including substantial experience in patent agency work in the United Kingdom,

qualifies for registration⁴.

1 As to the qualifying examinations see PARA 625.

2 For these purposes, 'patent agency work' means work done in the course of carrying on the business of acting as agent for others for the purpose of applying for or obtaining patents in the United Kingdom or elsewhere or of conducting proceedings before the comptroller relating to applications for, or otherwise in connection with, patents: Register of Patent Agents Rules 1990, SI 1990/1457, r 2. As to the meaning of 'United Kingdom' see PARA 303 note 5. As to the comptroller see PARA 577.

3 As to the meaning of 'registered patent agent' see PARA 621 note 4.

4 Register of Patent Agents Rules 1990, SI 1990/1457, r 9.

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/627. Entitlement to registration.

627. Entitlement to registration.

Unless a direction¹ by the Secretary of State² in relation to him is in force, a person who qualifies³ for registration is entitled to have his name entered in the register⁴ on production to the registrar⁵ of evidence that he qualifies for registration and on the payment of the prescribed⁶ fee⁷.

For the purpose of satisfying himself that a person has completed the requisite number of years of practice, the registrar may require that person to submit to him a statutory declaration attesting to that fact and may require such further particulars of that practice as he may consider necessary⁸.

Upon being satisfied after due inquiry⁹ that a person, who would otherwise be entitled to be registered, has been guilty of misconduct, the Secretary of State may direct that the name of that person is not to be registered; and upon such direction the registrar must not, except with the prior consent of the Secretary of State, register the name of that person¹⁰.

1 Ie under the Register of Patent Agents Rules 1990, SI 1990/1457, r 10(3): see the text to notes 9-10.

2 As to the Secretary of State see PARA 575.

3 Ie under Register of Patent Agents Rules 1990, SI 1990/1457, r 9: see PARA 626.

4 As to the meaning of 'register' see PARA 621 note 2.

5 As to the registrar see PARA 623.

6 Ie the fee prescribed by regulations under the Register of Patent Agents Rules 1990, SI 1990/1457, r 20: see PARA 634.

7 Register of Patent Agents Rules 1990, SI 1990/1457, r 10(1).

8 Register of Patent Agents Rules 1990, SI 1990/1457, r 10(2).

9 Ie in accordance with the Register of Patent Agents Rules 1990, SI 1990/1457, r 15: see PARA 629.

10 Register of Patent Agents Rules 1990, SI 1990/1457, r 10(3).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/628. Erasure of name for failure to pay fee.

628. Erasure of name for failure to pay fee.

If any registered patent agent¹ fails to pay any annual practice fee that may be prescribed² within one month from the day on which it becomes payable, the registrar³ must send to him at his business address, as shown in the register⁴, a notice requiring him to pay the fee on or before a day specified in the notice; and, if that person fails to pay the fee on or before that date, the registrar may erase his name from the register⁵.

The name of a person so erased from the register may be restored to it by direction of the Chartered Institute of Patent Attorneys on payment by him of the fee or fees due from him, together with such further sum not exceeding the amount prescribed for the annual practice fee as the Institute may in each particular case direct⁶.

1 As to the meaning of 'registered patent agent' see PARA 621 note 4.

2 Ie by regulations made under the Register of Patent Agents Rules 1990, SI 1990/1457, r 20: see PARA 634.

3 As to the registrar see PARA 623.

4 As to the meaning of 'register' see PARA 621 note 2.

5 Register of Patent Agents Rules 1990, SI 1990/1457, r 12(1).

6 Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 12(2).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/629. Erasure of registration after due inquiry into misconduct.

629. Erasure of registration after due inquiry into misconduct.

Where the Secretary of State¹ is satisfied, after due inquiry², that a person has been guilty of misconduct, that is to say, conduct discreditable to a registered patent agent³, he may at his discretion, having regard to the circumstances of the misconduct, direct that the name of that person be erased from the register⁴; and he may further direct that the name is to remain erased during such period as he may specify⁵. Upon such a direction the registrar⁶ must erase the name and particulars of that person from the register accordingly⁷.

Where it appears to the Secretary of State⁸ that a person may have been guilty of misconduct, he must serve on that person (the 'person affected') a notice:

- 460 (1) informing him of the grounds on which it so appears to the Secretary of State and the substance of any allegations of misconduct made against him; and
- 461 (2) inviting him to submit to the Secretary of State, within such period, being not less than 21 days, as may be specified in the notice, his representations in writing and requiring him to serve notice, if he wishes, of his intention to make oral representations⁹.

A copy of the notice so served on the person affected and a copy of any written representations submitted by him to the Secretary of State must be served by the Secretary of State on the Chartered Institute of Patent Attorneys¹⁰.

Where the person affected has so served notice of his intentions to make oral representations, the Secretary of State must give him not less than 21 days' notice, or such shorter notice as the person affected may request or consent to accept, of the date, time and place at which his representations will be heard¹¹.

If the Secretary of State considers that he should proceed with his inquiry but for a reason which differs or on grounds which differ from those set out in the notice served by him, he must give¹² a further notice¹³.

1 As to the Secretary of State see PARA 575.

2 Ie in accordance with the Register of Patent Agents Rules 1990, SI 1990/1457, r 15.

3 As to the meaning of 'registered patent agent' see PARA 621 note 4.

4 As to the meaning of 'register' see PARA 621 note 2.

5 Register of Patent Agents Rules 1990, SI 1990/1457, r 14.

6 As to the registrar see PARA 623.

7 Register of Patent Agents Rules 1990, SI 1990/1457, r 14.

8 Ie under the Register of Patent Agents Rules 1990, SI 1990/1457, r 10(3) (see PARA 627) or r 14 (see the text and notes 1-7).

9 Register of Patent Agents Rules 1990, SI 1990/1457, r 15(1).

10 Register of Patent Agents Rules 1990, SI 1990/1457, r 15(2).

- 11 Register of Patent Agents Rules 1990, SI 1990/1457, r 15(3).
- 12 le under the Register of Patent Agents Rules 1990, SI 1990/1457, r 15(1).
- 13 Register of Patent Agents Rules 1990, SI 1990/1457, r 15(4).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/630. Hearing of representations.

630. Hearing of representations.

At the hearing of oral representations¹ the Secretary of State² must, at the request of the person affected³, permit any other person, in addition to the person affected, to make representations on his behalf or to give evidence or to introduce documents for him⁴. The Secretary of State may not refuse to admit evidence solely on the grounds that it would not be admissible in a court of law⁵.

The hearing may be adjourned at the discretion of the Secretary of State; and, if the hearing is so adjourned, he must give the person affected reasonable notice of the date, time and place at which the hearing is to be resumed⁶.

The Secretary of State must inform the Chartered Institute of Patent Attorneys of the date, time and place appointed for any hearing; and the Institute is entitled to be represented at the hearing and to make submissions touching on the matters in issue⁷.

1 He held pursuant to the Register of Patent Agents Rules 1990, SI 1990/1457, r 15(3): see PARA 629.

2 As to the Secretary of State see PARA 575.

3 As to the meaning of 'person affected' see PARA 629.

4 Register of Patent Agents Rules 1990, SI 1990/1457, r 16(1).

5 Register of Patent Agents Rules 1990, SI 1990/1457, r 16(2).

6 Register of Patent Agents Rules 1990, SI 1990/1457, r 16(3).

7 Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 16(4).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/631. Decision.

631. Decision.

In deciding whether to issue a direction, the Secretary of State¹ must take into account any written or oral representations duly made² and:

- 462 (1) if he decides not to issue a direction, give notice of that decision to the person affected, the Chartered Institute of Patent Attorneys and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person, if known, but nothing in these provisions requires the Secretary of State to state the reason for that decision;
- 463 (2) if he decides to issue a direction, give notice of his decision, the terms thereof and his reason for the decision to the person affected, the Institute and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person, if known³.

¹ As to the Secretary of State see PARA 575.

² le made in accordance with the Register of Patent Agents Rules 1990, SI 1990/1457, r 15 (see PARA 629) and r 16 (see PARA 630).

³ Register of Patent Agents Rules 1990, SI 1990/1457, rr 2, 17. As to the meaning of 'person affected' see PARA 629.

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iii) Qualifications for Registration/632. Restoration of name to the register.

632. Restoration of name to the register.

On an application made to him by a person whose name has been erased from the register after due inquiry into misconduct¹, the Secretary of State² may, if he thinks fit, direct that the name of that person is to be restored to the register; and he may further direct that such restoration is to be made either without fee or on payment of such fee as he may fix not exceeding the prescribed fee³ for the registration of a name⁴.

Upon a direction for the restoration of the name of a person, the registrar⁵ must restore the name and particulars of that person to the register and must, in the case of a person whose name has been erased for a specified period and in respect of whom no direction has been issued under this provision, restore his name and particulars upon the expiration of that period and upon payment of the prescribed fee for the registration of a name⁶.

¹ I.e. under the Register of Patent Agents Rules 1990, SI 1990/1457, r 14: see PARA 629. As to the meaning of 'register' see PARA 621 note 2.

² As to the Secretary of State see PARA 575.

³ I.e. the fee prescribed by regulations made under the Register of Patent Agents Rules 1990, SI 1990/1457, r 20: see PARA 634.

⁴ Register of Patent Agents Rules 1990, SI 1990/1457, r 18(1).

⁵ As to the registrar see PARA 623.

⁶ Register of Patent Agents Rules 1990, SI 1990/1457, r 18(2).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (iv) Appeals/633. Appeal to the comptroller from decision of the Institute or the registrar.

(iv) Appeals

633. Appeal to the comptroller from decision of the Institute or the registrar.

A person aggrieved by any decision of the Chartered Institute of Patent Attorneys or the registrar¹ may appeal to the comptroller² by serving on the comptroller, within one month from the date of the decision, a notice of appeal, stating the grounds of appeal with a statement of his case in support thereof³. A copy of the notice with a copy of the statement of case must, at the same time, be served by that person (the 'appellant') on the Institute or the registrar, as appropriate⁴.

On receipt of the notice of appeal, the comptroller must give such directions as he thinks fit for the purpose of hearing the appeal and must give the appellant and the Institute or the registrar, as the case may be, not less than 14 days' notice, or such shorter notice as the appellant and the Institute or registrar may consent to accept, of the date, time and place appointed for the hearing of the appeal⁵.

At the hearing the comptroller must, at the request of any party, permit any other person, in addition to that party, to appear on his behalf⁶.

The comptroller must give his decision on the appeal in writing with a statement of his reasons and must serve a copy thereof on the appellant and the Institute or registrar⁷.

The comptroller's decision on the appeal is final; and for the purposes of giving effect to it he may give such directions to the Institute or registrar as he thinks fit⁸.

1 As to the registrar see PARA 623.

2 As to the comptroller see PARA 577.

3 Register of Patent Agents Rules 1990, SI 1990/1457, r 19(1).

4 Register of Patent Agents Rules 1990, SI 1990/1457, r 19(1).

5 Register of Patent Agents Rules 1990, SI 1990/1457, r 19(2).

6 Register of Patent Agents Rules 1990, SI 1990/1457, r 19(3).

7 Register of Patent Agents Rules 1990, SI 1990/1457, r 19(4).

8 Register of Patent Agents Rules 1990, SI 1990/1457, r 19(5).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (v) Fees/634. In general.

(v) Fees

634. In general.

The Chartered Institute of Patent Attorneys may, by regulations made by it with the approval of the comptroller¹, prescribe the fees to be paid by:

- 464 (1) every candidate for any examinations, or part or parts thereof, duly held²;
- 465 (2) every person for the registration of his name;
- 466 (3) every registered patent agent³ as an annual practice fee;
- 467 (4) a registered patent agent requesting an amendment of the register⁴;

and any such regulations may provide for the remission or refund of any fees in such circumstances as may be prescribed thereunder⁵.

When prescribing any fees for the purposes of head (1) above, the Institute must, as far as practicable, secure that the income therefrom does not exceed the expenditure properly incurred in administering any examinations, taking one year with another⁶.

1 As to the comptroller see PARA 577.

2 Ie in accordance with regulations made under the Register of Patent Agents Rules 1990, SI 1990/1457, r 8: see PARA 625.

3 As to the meaning of 'registered patent agent' see PARA 621 note 4.

4 Ie under the Register of Patent Agents Rules 1990, SI 1990/1457, r 11: see PARA 621. As to the meaning of 'register' see PARA 621 note 2.

5 Register of Patent Agents Rules 1990, SI 1990/1457, r 20(1).

6 Register of Patent Agents Rules 1990, SI 1990/1457, r 20(2).

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(2) PATENT AGENTS/ (vi) Report of the Institute/635. In general.

(vi) Report of the Institute

635. In general.

The Chartered Institute of Patent Attorneys must before 30 April in every year send to the comptroller¹ a report stating:

- 468 (1) the number of applications for registration which were made in the preceding year and the number of registrations effected in that year;
- 469 (2) the examinations which were held in that year and the results thereof;
- 470 (3) the amount of the fees received by the Institute in that year; and
- 471 (4) that the limitation on income from fees for examinations² has been complied with and showing, by reference to income and expenditure, its compliance with that limitation;

and must include in the report a statement on such other matters³ as the comptroller may from time to time require⁴.

1 As to the comptroller see PARA 577.

2 Ie under the Register of Patent Agents Rules 1990, SI 1990/1457, r 20(2): see PARA 634.

3 Ie in relation to the provisions of the Register of Patent Agents Rules 1990, SI 1990/1457, including any regulations made by the Chartered Institute of Patent Attorneys pursuant thereto.

4 Register of Patent Agents Rules 1990, SI 1990/1457, r 22.

UPDATE

621-635 The register ... In general

SI 1990/1457 revoked: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/ (3) EUROPEAN PATENT ATTORNEYS/636. European patent attorneys.

(3) EUROPEAN PATENT ATTORNEYS

636. European patent attorneys.

The term 'European patent attorney' or 'European patent agent' may be used in the following cases without any contravention of the statutory provisions¹ relating to persons entitled to describe themselves as patent agents²:

- 472 (1) an individual who is on the European list³ may carry on business under a name or other description which contains the words 'European patent attorney' or 'European patent agent' or otherwise describe himself, or permit himself to be described, as a 'European patent attorney' or 'European patent agent'⁴;
- 473 (2) a partnership of which not less than the prescribed number or proportion of partners is on the European list may carry on a business under a name or other description which contains the words 'European patent attorneys' or 'European patent agents' or otherwise describe itself, or permit itself to be described, as a firm which carries on the business of 'European patent attorney' or 'European patent agent'⁵;
- 474 (3) a body corporate of which not less than the prescribed number or proportion of directors⁶ is on the European list may carry on business under a name or other description which contains the words 'European patent attorney' or 'European patent agent' or otherwise describe itself, or permit itself to be described, as a 'European patent attorney' or 'European patent agent'⁷.

Where the term 'European patent attorney' or 'European patent agent' may, in accordance with the above provisions, be used in reference to an individual, partnership or body corporate, it is equally permissible to use other expressions in reference to that person, or to his business or place of business, which are likely to be understood as indicating that he is entitled to be described as a 'European patent attorney' or 'European patent agent'⁸.

1 In the Copyright, Designs and Patents Act 1988 s 276: see PARA 615.

2 Copyright, Designs and Patents Act 1988 s 277(1).

3 As to the meaning of 'European list' see PARA 615 note 11.

4 Copyright, Designs and Patents Act 1988 s 277(2).

5 Copyright, Designs and Patents Act 1988 s 277(3).

6 As to the meaning of 'director' see PARA 615 note 4.

7 Copyright, Designs and Patents Act 1988 s 277(4).

8 Copyright, Designs and Patents Act 1988 s 277(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/637. Constitution and jurisdiction of the Patents Court.

(4) THE PATENTS COURT

637. Constitution and jurisdiction of the Patents Court.

All proceedings in the High Court¹ under the Registered Designs Act 1949², the Defence Contracts Act 1958³ and the Patents Act 1977⁴ must be assigned to the Chancery Division and taken by the Patents Court⁵, which is constituted as part of that Division⁶ with such of the puisne judges of the High Court as the Lord Chief Justice, after consulting the Lord Chancellor, may from time to time nominate⁷.

The Patents Court also has an appellate jurisdiction⁸ which was formerly exercised by the Patents Appeal Tribunal⁹. That tribunal was abolished and its jurisdiction transferred to the Patents Court¹⁰. For the purpose of hearing appeals the Patents Court may consist of one or more judges of the court in accordance with directions given by the Lord Chief Justice of England and Wales after consulting the Lord Chancellor¹¹. For the purpose of determining any question in the exercise of its original or appellate jurisdiction under the Patents Act 1977, or under any treaty or international convention to which the United Kingdom¹² is a party, the Patents Court may make any order or exercise any other power which the comptroller¹³ could have made or exercised for the purpose of determining that question¹⁴.

1 In the Patents Act 1977, 'court' means the High Court or any patents county court having jurisdiction by virtue of an order under the Copyright, Designs and Patents Act 1988 s 287 (see PARA 644): Patents Act 1977 s 130(1) (definition amended by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 23). As to the patents county court see PARA 644 et seq.

2 As to the Registered Designs Act 1949 see PARA 681 et seq.

3 As to the Defence Contracts Act 1958 see PARA 408; and **WAR AND ARMED CONFLICT** vol 49(1) (2005 Reissue) PARAS 588-589.

4 As to current legislation see PARA 304. Any matter arising out of the Patents Act 1977 including infringement actions (see PARA 521 et seq), revocation actions (see PARA 564 et seq), threats under s 70 (see PARA 557) and disputes as to ownership (see PARA 360 et seq) must be dealt with in the Patents Court: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 2.2(1).

5 CPR 63.1(2)(f), 63.3. Claims in the Patents Court and a Patents County Court form specialist lists for the purpose of CPR 30.5: CPR 63.4. Under CPR 30.5, the High Court may order proceedings in any division of the High Court to be transferred to another division: CPR 30.5(1). A judge dealing with claims in a specialist list may order proceedings to be transferred to or from that list: CPR 30.5(2). An application for the transfer of proceedings to or from a specialist list must be made to a judge dealing with claims in that list: CPR 30.5(3). A claim form relating to patents must be marked in the top right hand corner 'Patents Court' below the title of the court in which it is issued: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 3.1.

6 Supreme Court Act 1981 s 6(1)(a). As from a day to be appointed, the Supreme Court Act 1981 is renamed the Senior Courts Act 1981: see the Constitutional Reform Act 2005 s 59(5), Sch 11 para 1. At the date at which this volume states the law, no such day had been appointed.

7 Supreme Court Act 1981 s 6(2) (amended by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 114, 119(1), (2)). See note 6.

8 See PARA 639.

9 See the Patents Act 1949 s 85 (repealed).

10 See the Patents Act 1977 s 132(7), Sch 6.

11 Patents Act 1977 s 97(2) (amended by the Supreme Court Act 1981 s 152(4), Sch 7; and the Constitutional Reform Act 2005 Sch 4 paras 90, 91(1), (2)). See further PARA 640.

12 As to the meaning of 'United Kingdom' see PARA 303 note 5.

13 As to the comptroller see PARA 577.

14 Patents Act 1977 s 99.

UPDATE

637 Constitution and jurisdiction of the Patents Court

NOTE 6--Appointed day is 1 October 2009: SI 2009/1604.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/638. Scientific adviser.

638. Scientific adviser.

At the case management conference¹ the Patents Court may direct that a scientific adviser be appointed² and that a document setting out basic undisputed technology should be prepared³. Where the court appoints one or more persons (an 'assessor'), the assessor must assist the court in dealing with a matter in which the assessor has skill and experience⁴. An assessor must take such part in the proceedings as the court may direct and in particular the court may: (1) direct the assessor to prepare a report for the court on any matter at issue in the proceedings; and (2) direct the assessor to attend the whole or any part of the trial to advise the court on any such matter⁵. If the assessor prepares a report for the court before the trial has begun, the court will send a copy to each of the parties and the parties may use it at trial⁶. Except where the remuneration of the assessor is to be paid out of money provided by Parliament⁷, the remuneration to be paid to the assessor for his services is to be determined by the court and forms part of the costs of the proceedings⁸ and the court may order any party to deposit in the court office a specified sum in respect of the assessor's fees and, where it does so, the assessor will not be asked to act until the sum has been deposited⁹.

1 As to the case management conference see PARA 534.

2 See the Supreme Court Act 1981 s 70(3). As from a day to be appointed, the Supreme Court Act 1981 is renamed the Senior Courts Act 1981: see the Constitutional Reform Act 2005 s 59(5), Sch 11 para 1. At the date at which this volume states the law, no such day had been appointed.

Scientific advisors were appointed in eg *Valensi v British Radio Corp* [1973] RPC 337, CA; *Re Genentec Inc's Patent, Genentech Inc v The Wellcome Foundation Ltd* [1989] RPC 147; *Kirin-Amgen Inc v Hoechst Marion Rousel Ltd* [2004] UKHL 46, [2005] 1 All ER 667, [2005] RPC 169. Guidance as to the role of a scientific advisor was given in *Halliburton Energy Service Inc v Smith International (North Sea) Ltd* [2006] EWCA Civ 1599, [2007] RPC 428.

3 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.10.

4 CPR 35.15(1), (2).

5 CPR 35.15(3).

6 CPR 35.15(4).

7 See CPR 35.15(7). The remuneration of any such assessor may be determined by the Lord Chancellor with the consent of the Treasury and must be defrayed out of money provided by Parliament: see the Supreme Court Act 1981 s 70(4). See note 2.

8 CPR 35.15(5).

9 CPR 35.15(6).

UPDATE

638 Scientific adviser

TEXT AND NOTES--CPR 35.15 substituted: SI 2009/2092.

NOTE 2--Appointed day is 1 October 2009: SI 2009/1604.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/639. Right of appeal to the Patents Court.

639. Right of appeal to the Patents Court.

Appeals, other than Scottish appeals¹, from the comptroller lie to the Patents Court² from any decision of the comptroller under the Patents Act 1977 or under the Patents Rules 2007³ except:

.1

- 31. (1) a decision whether an abstract adequately fulfils its purpose⁴;
- 32. (2) a decision to omit matter from a specification⁵;
- 33. (3) a decision to give directions prohibiting or restricting the publication or communication of information in the interests of defence or national security⁶; and
- 34. (4) where a decision under the rules⁷ provides for no right of appeal⁸.

21

1 Appeals from a decision of the comptroller after a hearing in Scotland lie to the Court of Session: see the Patents Act 1977 s 97(4). As to the comptroller see PARA 577.

2 As to the constitution and jurisdiction of the Patents Court see PARA 637.

3 Patents Act 1977 s 97(1).

4 Ie a decision under the Patents Act 1977 s 14(7): see PARA 326.

5 Ie a decision under the Patents Act 1977 s 16(2): see PARA 327.

6 Ie a decision under the Patents Act 1977 s 22(1) or (2): see PARA 335.

7 Eg a decision made under the Patents Rules 2007, SI 2007/3291, r 106(1) or (2), whether to remit the whole or part of a search fee in certain cases: see r 106(7); and PARA 583.

8 Patents Act 1977 s 97(1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/640. Procedure on appeal to the Patents Court.

640. Procedure on appeal to the Patents Court.

For the purpose of hearing appeals from the comptroller¹, the Patents Court² consists of one or more judges of that court in accordance with directions given by the Lord Chief Justice of England and Wales after consulting the Lord Chancellor³.

The provisions of the Civil Procedure Rules relating to appeals⁴ apply to appeals from the comptroller⁵. Where those provisions require a document to be served, it must also be served on the comptroller⁶.

Without prejudice to the right of counsel to appear before the High Court⁷, a solicitor of the Supreme Court⁸ may appear and be heard on behalf of any party to an appeal from the comptroller to the Patents Court⁹; and a registered patent agent or a member of the Bar not in actual practice may do, in or in connection with proceedings on an appeal from the comptroller to the Patents Court, anything which a solicitor of the Supreme Court¹⁰ might do, other than prepare a deed¹¹.

An appeal from the comptroller to the Patents Court is by way of rehearing but with appropriate weight being given to the decision below¹². Costs are in the discretion of the court¹³.

1 le under the Patents Act 1977 s 97: see PARA 639. As to the comptroller see PARA 577.

2 As to the constitution and jurisdiction of the Patents Court see PARA 637.

3 Patents Act 1977 s 97(2) (amended by the Supreme Court Act 1981 s 152(4), Sch 7; and the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 90, 91(1), (2)). As from a day to be appointed, the Supreme Court Act 1981 is renamed the Senior Courts Act 1981: see the Constitutional Reform Act 2005 s 59(5), Sch 11 para 1. At the date at which this volume states the law, no such day had been appointed. The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4)) to exercise his functions under the Patents Act 1977 s 97(2): s 97(4) (added by the Constitutional Reform Act 2005 Sch 4 paras 90, 91(1), (3)).

4 le CPR Pt 52: see **CIVIL PROCEDURE** vol 12 (2009) PARA 1657 et seq.

5 CPR 63.17(1). Patent appeals are to be made to the Patents Court: CPR 63.17(2).

6 CPR 63.17(3).

7 As to a barrister's right of audience in the High Court see **LEGAL PROFESSIONS** vol 66 (2009) PARA 1109. Where counsel appear, they may be instructed by registered patent agents as at the UK Intellectual Property Office. If the comptroller wishes to appear, he usually instructs Treasury Counsel.

8 As from a day to be appointed, this provision is amended to refer to a solicitor of the Senior Courts: see the Patents Act 1977 s 102A(1) (s 102A added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 27; the Patents Act 1977 s 102A(1), (2) prospectively amended by the Constitutional Reform Act 2005 s 59(5), Sch 11 para 23(1), (2)). At the date at which this volume states the law no such day had been appointed. As from a day to be appointed, the Patents Act 1977 s 102A is repealed by the Legal Services Act 2007 s 210, Sch 23. At the date at which this volume states the law no such day had been appointed. As to transitional provisions see the Legal Services Act 2007 Sch 5 para 9.

9 Patents Act 1977 s 102A(1), (5) (as added; amended and prospectively repealed (see note 8)). Nothing in the Patents Act 1977 s 102A is to be taken to limit the right to draw or prepare deeds given to a registered patent agent by the Courts and Legal Services Act 1990 s 68 (see PARA 617); Patents Act 1977 s 102A(6) (added by the Courts and Legal Services Act 1990 s 125(3), Sch 18 para 20(2); and prospectively repealed (see note 8)). As to registered patent agents see PARA 614.

10 See note 8.

11 Patents Act 1977 s 102A(2) (as added; amended and prospectively repealed (see note 8)). The Lord Chancellor may, with the concurrence of the Lord Chief Justice of England and Wales, by regulations: (1) provide that the right conferred by s 102A(2) is to be subject to such conditions and restrictions as appear to the Lord Chancellor to be necessary or expedient; and (2) apply to persons exercising that right such statutory provisions, rules of court and other rules of law and practice applying to solicitors as may be specified in the regulations; and different provision may be made for different descriptions of proceedings: s 102A(3) (as added (see note 8); and amended by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 90, 92(1), (2)). Any such regulations must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: Patents Act 1977 s 102A(4) (as added: see note 8). At the date at which this volume states the law no such regulations had been made. The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4) (see **COURTS**)) to exercise his functions under the Patents Act 1977 s 102A: s 102A(7) (added by the Constitutional Reform Act 2005 Sch 4 paras 90, 92(1), (3)).

12 See CPR 52.11; and **CIVIL PROCEDURE** vol 12 (2009) PARA 1672 et seq. See also *Thibierge & Comar SA v Rexam CFP Ltd* [2002] RPC 379.

13 Supreme Court Act 1981 s 51(1) (substituted by the Courts and Legal Services Act 1990 s 4(1)). See note 3. The normal rule is that the party successful on the appeal is awarded taxed costs: *Ormon Tateisi Electronics Co's Patent* [1981] RPC 125; *Extrude Hone Corp'n's Patent* [1982] RPC 361. This applies to appeals to which the comptroller is a party. See also *Reiss Engineering Co Ltd v Harris* [1987] RPC 171.

In proceedings under the Patents Act 1977 s 40 (see PARA 370), s 70 (see PARA 557), s 71 (see PARA 556) or proceedings for infringement (see PARA 521 et seq), the court, in determining whether to award costs or expenses to any party and what costs or expenses to award, must have regard to all the relevant circumstances, including the financial position of the parties: s 106(1), (1A) (s 106(1) amended, and s 106(1A) added, by the Patents Act 2004 s 14(1)-(4)). If in any such proceedings the court directs that any costs of one party are to be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs are to be taxed on a scale specified by the court, being a scale of costs prescribed by rules of court: see the Patents Act 1977 s 106(2) (amended, as from a day to be appointed, by the Constitutional Reform Act 2005 s 59(5), Sch 11 para 23(1), (4)). At the date at which this volume states the law no such day had been appointed.

UPDATE

640 Procedure on appeal to the Patents Court

NOTES 3, 13--Day appointed for commencement of Constitutional Reform Act 2005 Sch 11 is 1 October 2009: SI 2009/1604.

NOTE 8--Day appointed for repeal of Patents Act 1977 s 102A is 1 January 2010: SI 2009/3250.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/641. Appeals relating to unpublished applications.

641. Appeals relating to unpublished applications.

On an appeal from the UK Intellectual Property Office¹ relating to an unpublished application² the hearing will normally be in private³. If it is of general importance, the decision may be published⁴ after a suitable lapse of time⁵.

1 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 As to publication see PARA 327.

3 This follows the established practice of the former Patents Appeal Tribunal.

4 I.e. in the Reports of Patent Cases: see PARA 580.

5 As to early publication see PARA 580.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/642. Appeals from the Patents Court.

642. Appeals from the Patents Court.

Appeal lies from a decision of the Patents Court in the exercise of its original jurisdiction, in the ordinary way, on a question of law or fact, to the Court of Appeal¹ and thence, with leave, to the House of Lords².

Appeal lies to the Court of Appeal (and thence, with leave, to the House of Lords) from a decision of the Patents Court on an appeal from a decision of the comptroller only with leave of the Patents Court or of the Court of Appeal³, and only where either:

- 475 (1) the ground of appeal is that the decision of the Patents Court is wrong in law⁴;
or
- 476 (2) the comptroller's decision was given under one of certain provisions of the Patents Act 1977⁵.

Where an appeal lies to the Court of Appeal, the judge may, in a proper case, certify that the appeal may be made direct to the House of Lords⁶.

1 See the Supreme Court Act 1981 s 16(1); and **COURTS** vol 10 (Reissue) PARA 639. As to the procedure see **CIVIL PROCEDURE** vol 12 (2009) PARA 1657 et seq. As from a day to be appointed, the Supreme Court Act 1981 is renamed the Senior Courts Act 1981: see the Constitutional Reform Act 2005 s 59(5), Sch 11 para 1. At the date at which this volume states the law, no such day had been appointed.

2 See the Appellate Jurisdiction Act 1876 s 3; and **COURTS** vol 10 (Reissue) PARA 360. As to the procedure see **COURTS** vol 10 (Reissue) PARA 374 et seq. As from a day to be appointed, the appellate jurisdiction of the House of Lords is abolished and the Supreme Court of the United Kingdom is established: see the Constitutional Reform Act 2005 Pt 3 (ss 23-60); and **COURTS** vol 10 (Reissue) PARA 601 et seq.

3 Patents Act 1977 s 97(3). Where the appeal is from a decision of the Patents Court which was itself made on an appeal from a decision of the comptroller, the appellant must serve the appellant's notice on the comptroller in addition to the respondent: see *Practice Direction--Appeals* PD 52 para 21.3. The Patents Act 1977 s 97(3) is not impliedly repealed or amended by the Access to Justice Act 1999 s 55 (second appeals) (see **CIVIL PROCEDURE** vol 12 (2009) PARA 1682): *Smith International Inc v Specialised Petroleum Services Group Ltd* [2005] EWCA Civ 1357, [2006] 1 WLR 252, [2006] FSR 487.

4 Patents Act 1977 s 97(3)(b).

5 Patents Act 1977 s 97(3)(a). These provisions are ss 8, 12 and s 37 (entitlement questions: see PARAS 361, 364, 366), s 18 (refusal of patent: see PARA 329), s 20 (failure of application: see PARA 332), s 27 (amendment of specification after grant: see PARA 347), s 40 (compensation to employee-inventor: see PARA 370), s 61 (infringement: see PARA 555), s 72 or s 73 (revocation: see PARAS 564-565) or s 75 (amendment in infringement or revocation proceedings: see PARA 564). Decisions under s 71 (declaration of non-infringement: see PARA 556) are not, however, included.

6 See the Administration of Justice Act 1969 ss 12, 13; and **COURTS** vol 10 (Reissue) PARA 379. Such appeals are known colloquially as 'leapfrog appeals'. As from a day to be appointed, the reference to the House of Lords is replaced by a reference to the Supreme Court: see ss 12, 13 prospectively amended by the Constitutional Reform Act 2005 s 40(4), Sch 9 para 20(1), (3), (4). At the date at which this volume states the law no such day had been appointed. See note 2.

UPDATE

642 Appeals from the Patents Court

NOTES 1, 2, 6--Appointed day is 1 October 2009: SI 2009/1604.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(4) THE PATENTS COURT/643. Prerogative orders.

643. Prerogative orders.

The High Court can intervene by prerogative order¹ if the comptroller² acts illegally and where the comptroller's decision is not subject to appeal³.

1 As to prerogative orders see **JUDICIAL REVIEW** vol 61 (2010) PARA 687 et seq. Application for a prerogative order is by way of application for a judicial review under CPR Pt 54. See, however, the Patents Act 1977 s 116; and PARA 575. See eg *R (on the application of Penife International Ltd) v HM Comptroller-General of Patents, Trademarks and Designs* [2003] EWHC 3409 (Admin), [2004] RPC 737, [2004] All ER (D) 116 (Mar); *R (on the application of Ash & Lacy Building Products Ltd) v Comptroller General of Patents* [2002] EWHC 541 (Admin), [2002] RPC 939, [2002] All ER (D) 23 (Feb).

2 As to the comptroller see PARA 577.

3 As to the right of appeal from the comptroller see PARA 639.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(i) In general/644. Special jurisdiction of patents county courts.

(5) THE PATENTS COUNTY COURT

(i) In general

644. Special jurisdiction of patents county courts.

The Lord Chancellor may, with the concurrence of the Lord Chief Justice¹, by order made by statutory instrument designate any county court as a patents county court and confer on it jurisdiction (its 'special jurisdiction') to hear and determine such descriptions of proceedings:

- 477 (1) relating to patents or designs; or
- 478 (2) ancillary to, or arising out of the same subject matter as, proceedings relating to patents or designs,

as may be specified in the order².

The special jurisdiction of a patents county court is exercisable throughout England and Wales, but rules of court may provide for a matter pending in one such court to be heard and determined in another or partly in that and partly in another³.

A patents county court may entertain proceedings within its special jurisdiction notwithstanding that no pecuniary remedy is sought⁴.

An order providing for the discontinuance of any of the special jurisdiction of a patents county court may make provision as to proceedings pending in the court when the order comes into operation⁵.

Nothing in the above provisions is to be construed as affecting the ordinary jurisdiction of a county court⁶.

The purpose of a patents county court is to provide cheaper, speedier and more informal procedures to enable small and medium sized enterprises and individuals to resolve their patent disputes⁷. Cases raising difficult and important technical issues should not be brought in the patents county court⁸.

¹ The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4) (see **COURTS**)) to exercise his functions under this provision: Copyright, Designs and Patents Act 1988 s 287(6) (added by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 198, 200(1), (2)).

² Copyright, Designs and Patents Act 1988 s 287(1) (amended by the Constitutional Reform Act 2005 Sch 4 paras 198, 200(1), (2)). In exercise of the power so conferred the Lord Chancellor has made the Patents County Court (Designation and Jurisdiction) Order 1994, SI 1994/1609, designating the Central London County Court as a patents county court (see art 2). As a patents county court, the Central London County Court has jurisdiction to hear and determine any action or matter relating to patents or designs over which the High Court would have jurisdiction, together with any claims or matters ancillary to or arising from such proceedings: art 3(a) (amended by SI 2005/587). The jurisdiction conferred by the Patents County Court (Designation and Jurisdiction) Order 1994, SI 1994/1609, art 3 does not, however, include jurisdiction to hear appeals from the comptroller: art 4. The designation of the Central London County Court as a patents county court took effect on 11 July 1994 (see art 1); and the Edmonton County Court thereupon ceased to be a patents county court (see art 5(1)). As to the comptroller see **PARA 577**.

³ Copyright, Designs and Patents Act 1988 s 287(2).

4 Copyright, Designs and Patents Act 1988 s 287(3).

5 Copyright, Designs and Patents Act 1988 s 287(4).

6 Copyright, Designs and Patents Act 1988 s 287(5).

7 See the *Patents County Court Users' Guide* foreword by the Lord Chancellor.

8 *Optical Coating Laboratory Inc v Pilkington PE Ltd* [1995] RPC 145, CA; *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat), [2006] RPC 25 (affd [2006] EWCA Civ 1715, [2006] All ER (D) 246 (Dec)).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(i) In general/645. Financial limits in relation to proceedings within special jurisdiction of patents county court.

645. Financial limits in relation to proceedings within special jurisdiction of patents county court.

Her Majesty may by Order in Council provide for limits of amount or value in relation to any description of proceedings within the special jurisdiction of a patents county court¹. No recommendation may, however, be made to Her Majesty to make such an Order unless a draft of the Order has been laid before and approved by a resolution of each House of Parliament².

If a limit is imposed on the amount of a claim of any description and the claimant has a cause of action for more than that amount, he may abandon the excess; in which case a patents county court has jurisdiction to hear and determine the action, but the claimant may not recover more than that amount³. Where the court has jurisdiction so to hear and determine an action, the judgment of the court in the action is in full discharge of all demands in respect of the cause of action, and entry of the judgment must be made accordingly⁴.

If the parties agree, by a memorandum signed by them or by their respective solicitors⁵ or other agents, that a patents county court is to have jurisdiction in any proceedings, that court has jurisdiction to hear and determine the proceedings notwithstanding any limit imposed under these provisions⁶.

1 Copyright, Designs and Patents Act 1988 s 288(1). At the date at which this volume states the law no such Order in Council had been made. As to the meaning of 'special jurisdiction' see PARA 644; and as to patents county courts see PARA 644.

2 Copyright, Designs and Patents Act 1988 s 288(5).

3 Copyright, Designs and Patents Act 1988 s 288(2).

4 Copyright, Designs and Patents Act 1988 s 288(3).

5 For these purposes, the reference to a solicitor includes a reference to a body corporate recognised by the Council of the Law Society under the Administration of Justice Act 1985 s 9 (see **LEGAL PROFESSIONS** vol 65 (2008) PARA 688 et seq): Solicitors' Incorporated Practices Order 1991, SI 1991/2684, arts 2(1), 3, 4(a), Sch 1.

6 Copyright, Designs and Patents Act 1988 s 288(4).

UPDATE

645 Financial limits in relation to proceedings within special jurisdiction of patents county court

NOTE 5--SI 1991/2684 renamed the Solicitors' Recognised Bodies Order 1991: SI 2009/500. SI 1991/2684 art 3 amended: SI 2009/500. See also SI 1991/2684 art 5.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(i) In general/646. Transfer of proceedings between High Court and patents county court.

646. Transfer of proceedings between High Court and patents county court.

No order may be made¹ to transfer proceedings from the county court in respect of proceedings within the special jurisdiction of a patents county court².

In considering in relation to proceedings within the special jurisdiction of a patents county court whether an order should be made to transfer proceedings from or to the High Court³, the court must have regard to the financial position of the parties and may order the transfer of the proceedings to a patents county court or, as the case may be, refrain from ordering their transfer to the High Court notwithstanding that the proceedings are likely to raise an important question of fact or law⁴.

Matters which the patents county court takes into consideration when considering whether to order a transfer include:

- 479 (1) the financial position of the parties;
- 480 (2) the financial substance of the action;
- 481 (3) the importance of the action generally and in particular whether it would affect persons not party to the action;
- 482 (4) the complexity of the matters raised;
- 483 (5) the speed with which a trial would be heard; and
- 484 (6) the proper administration of justice which includes the length of time the trial would take and the purpose for which the patents county court was designed⁵.

Transfer should be ordered only if, after considering all the relevant factors, the scales were tipped in favour of transfer⁶.

1 le an order under the County Courts Act 1984 s 41: see **CIVIL PROCEDURE** vol 11 (2009) PARA 69.

2 Copyright, Designs and Patents Act 1988 s 289(1). As to the meaning of 'special jurisdiction' see PARA 644; and as to patents county courts see PARA 644.

3 le an order under the County Courts Act 1984 s 40 or s 42: see **CIVIL PROCEDURE** vol 11 (2009) PARA 69.

4 Copyright, Designs and Patents Act 1988 s 289(2). In exercising his discretion whether to transfer a case to the High Court, the judge of the patents county court should bear in mind that that court had been established as a means of making patent litigation cheaper, simpler and more accessible so that smaller enterprises and private individuals should not be deterred from innovation by the potential cost of litigation to safeguard their rights: *Chaplin Patents Holdings Co plc v Group Lotus plc* (1994) Times, 12 January, CA. Cases involving complex technical matters should not be brought in the patents county court: *Optical Coating Laboratory Inc v Pilkington PE Ltd* [1995] RPC 145, CA; *Halliburton Energy Services Inc v Smith International (North Sea) Ltd* [2005] EWHC 1623 (Pat), [2006] RPC 25 (affd [2006] EWCA Civ 1715, [2006] All ER (D) 246 (Dec)).

5 *Symbol Technologies Inc v Opticon Sensors Europe BV (No 2)* [1993] RPC 232 (transfer refused), following *Mannesmann Kienzle GmbH v Microsystems Design Ltd* [1992] RPC 569 (transfer refused); *Pharma Plast A/S v Bard Ltd* [1993] FSR 686 (transfer refused); *CIBA Vision (UK) Ltd v Coopervision Ltd* [2001] All ER (D) 20 (Jul) (transfer refused). As to the rationale behind the setting up of the patents county court see PARA 644.

6 *Memminger-Iro GmbH v Trip-lite Ltd* [1992] RPC 210, CA (transfer ordered), followed in *Mannesmann Kienzle GmbH v Microsystems Design Ltd* [1992] RPC 569 and *Symbol Technologies Inc v Opticon Sensors Europe BV (No 2)* [1993] RPC 232.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(i) In general/647. Limitation of costs where pecuniary claim could have been brought in patents county court.

647. Limitation of costs where pecuniary claim could have been brought in patents county court.

Where an action is commenced in the High Court which could have been commenced in a patents county court¹ and in which a claim for a pecuniary remedy is made, then, subject to the following provisions, if the claimant recovers less than the prescribed amount², he is not entitled to recover any more costs than those to which he would have been entitled if the action had been brought in the county court³. For this purpose, a claimant is to be treated as recovering the full amount recoverable in respect of his claim without regard to any deduction made in respect of matters not falling to be taken into account in determining whether the action could have been commenced in a patents county court⁴.

These provisions do not affect any question as to costs if it appears to the High Court that there was reasonable ground for supposing the amount recoverable in respect of the claimant's claim to be in excess of the prescribed amount⁵.

If satisfied that there was sufficient reason for bringing the action in the High Court, the High Court may make an order allowing the costs or any part of the costs on the High Court scale or on such one of the county court scales as it may direct⁶.

The above provisions do not apply to proceedings brought by the Crown⁷.

1 As to the patents county court see PARA 644.

2 'Prescribed amount' means such amount as may be prescribed by Her Majesty for these purposes by Order in Council: Copyright, Designs and Patents Act 1988 s 290(6). Section 290 is repealed by the Courts and Legal Services Act 1990 s 125(7), Sch 20 as from a day to be appointed under s 124(3). No recommendation may, however, be made to Her Majesty to make such an order unless a draft of the Order has been laid before and approved by a resolution of each House of Parliament: s 290(7). At the date at which this volume states the law no such order had been made.

3 Copyright, Designs and Patents Act 1988 s 290(1) (prospectively repealed: see note 2).

4 Copyright, Designs and Patents Act 1988 s 290(2) (prospectively repealed: see note 2).

5 Copyright, Designs and Patents Act 1988 s 290(3) (prospectively repealed: see note 2).

6 Copyright, Designs and Patents Act 1988 s 290(4) (prospectively repealed: see note 2).

7 Copyright, Designs and Patents Act 1988 s 290(5) (prospectively repealed: see note 2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(ii) Procedure/648. Proceedings in the patents county court.

(ii) Procedure

648. Proceedings in the patents county court.

Where a county court is designated a patents county court¹, the Lord Chief Justice², after consulting the Lord Chancellor, must nominate a person entitled to sit as a judge of that court as the patents judge³.

County court rules must make provision for securing that, so far as is practicable and appropriate:

- 485 (1) proceedings within the special jurisdiction of a patents county court are dealt with by the patents judge; and
- 486 (2) the judge, rather than a district judge or other officer of the court, deals with interlocutory matters in the proceedings⁴.

County court rules must also make provision empowering a patents county court in proceedings within its special jurisdiction, on or without the application of any party:

- 487 (a) to appoint scientific advisers or assessors to assist the court; or
- 488 (b) to order the UK Intellectual Property Office⁵ to inquire into and report on any question of fact or opinion⁶.

Where the court exercises either of those powers on the application of a party, the remuneration or fees payable to the UK Intellectual Property Office are at such rate as may be determined in accordance with county court rules and are costs of the proceedings unless otherwise ordered by the judge⁷.

Where the court exercises either of those powers of its own motion, the remuneration or fees payable to the UK Intellectual Property Office are at such rate as may be determined by the Lord Chancellor with the approval of the Treasury and must be paid out of money provided by Parliament⁸.

1 As to the designation of patents county courts see PARA 644.

2 The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4) (see **COURTS**)) to exercise his functions under this provision: Copyright, Designs and Patents Act 1988 s 291(6) (added by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 198, 201(1), (3)).

3 Copyright, Designs and Patents Act 1988 s 291(1) (amended by the Constitutional Reform Act 2005 Sch 4 paras 198, 201(1), (2)). Claims in a patents county court form specialist lists for the purpose of CPR 30.5: see PARA 637 note 5. Proceedings in the patents county court must be dealt with by the patents judge: CPR 63.4A(1). However, when a matter needs to be dealt with urgently and it is not practicable or appropriate for the patents judge to deal with such matter, the matter may be dealt with by another judge with appropriate specialist experience who must be nominated by the Vice-Chancellor: CPR 63.4A(2). 'Patents judge' means a person nominated under the Copyright, Designs and Patents Act 1988 s 291(1): CPR 63.1(2)(gg). 'Patents county court' means a county court designated as a patents county court under the Copyright, Designs and Patents Act 1988 s 287(1) (see PARA 644): CPR 63.1(2)(g).

4 Copyright, Designs and Patents Act 1988 s 291(2). As to the meaning of 'special jurisdiction' see PARA 644.

5 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 Copyright, Designs and Patents Act 1988 s 291(3).

7 Copyright, Designs and Patents Act 1988 s 291(4).

8 Copyright, Designs and Patents Act 1988 s 291(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(ii) Procedure/649. Rights and duties of registered patent agents in relation to proceedings in patents county court.

649. Rights and duties of registered patent agents in relation to proceedings in patents county court.

A registered patent agent¹ may do, in or in connection with proceedings in a patents county court² which are within the special jurisdiction of that court, anything which a solicitor of the Supreme Court³ might do, other than prepare a deed⁴. The Lord Chancellor may by regulations provide that the right so conferred is to be subject to such conditions and restrictions as appear to the Lord Chancellor to be necessary or expedient; and different provision may be made for different descriptions of proceedings⁵; and any such regulations must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament⁶.

A patents county court has the same power to enforce an undertaking given by a registered patent agent acting in pursuance of these provisions as it has⁷ in relation to a solicitor⁸.

Nothing in the statutory prohibition on persons other than solicitors receiving remuneration⁹ applies to a registered patent agent acting in pursuance of these provisions¹⁰.

The provisions of county court rules prescribing scales of costs to be paid to solicitors apply in relation to registered patent agents acting in pursuance of these provisions¹¹.

1 'Registered patent agent' is not defined for these purposes but cf the Copyright, Designs and Patents Act 1988 s 275(1); and PARA 615 note 1.

2 As to the designation of patents county courts see PARA 644.

3 As from a day to be appointed, this provision is amended to refer to a solicitor of the Senior Courts: see the Copyright, Designs and Patents Act 1988 s 292(1) (prospectively amended by the Constitutional Reform Act 2005 s 59(5), Sch 11 para 4(1), (3)). At the date at which this volume states the law no such day had been appointed. As from a day to be appointed, the Copyright, Designs and Patents Act 1988 s 292 is repealed by the Legal Services Act 2007 ss 208(1), 210, Sch 21 paras 75, 80, Sch 23. At the date at which this volume states the law no such day had been appointed.

4 Copyright, Designs and Patents Act 1988 s 292(1). See note 3. As to the meaning of 'special jurisdiction' see PARA 644.

5 Copyright, Designs and Patents Act 1988 s 292(2). See note 3. The Lord Chancellor may make regulations under s 292(2) only with the concurrence of the Lord Chief Justice: s 292(2A) (added by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 198, 202(1), (2)). The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4) (see **COURTS**)) to exercise his functions under the Copyright, Designs and Patents Act 1988 s 292: s 292(7) (added by the Constitutional Reform Act 2005 Sch 4 paras 198, 202(1), (2)).

6 Copyright, Designs and Patents Act 1988 s 292(6). See note 3.

7 Ie by virtue of the County Courts Act 1984 s 142: see **COURTS** vol 10 (Reissue) PARA 706.

8 Copyright, Designs and Patents Act 1988 s 292(3). See note 3.

9 Ie the County Courts Act 1984 s 143: see **COURTS** vol 10 (Reissue) PARA 706.

10 Copyright, Designs and Patents Act 1988 s 292(4). See note 3.

11 Copyright, Designs and Patents Act 1988 s 292(5). See note 3.

UPDATE

649 Rights and duties of registered patent agents in relation to proceedings in patents county court

TEXT AND NOTES--Repeal of these provisions in force 1 January 2010: SI 2009/3250.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(ii) Procedure/650. Scientific advisers etc.

650. Scientific advisers etc.

At the case management conference the court may direct that:

- 489 (1) a scientific advisor be appointed¹; and
- 490 (2) a document setting out basic undisputed technology should be prepared².

1 Rule under the Supreme Court Act 1981 s 70(3): see **CIVIL PROCEDURE** vol 12 (2009) PARA 1133. CPR 35.15 (see **CIVIL PROCEDURE** vol 11 (2009) PARA 863) applies to scientific advisers: see *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.10. See further PARA 534.

2 *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 4.10. See further PARA 534.

UPDATE

650 Scientific advisers etc

NOTE 1--Supreme Court Act 1981 now cited as Senior Courts Act 1981: Constitutional Reform Act 2005 Sch 11 para 1.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/10. ADMINISTRATION; PATENT AGENTS; THE COURTS/(5) THE PATENTS COUNTY COURT/(iii) Appeals/651. In general.

(iii) Appeals

651. In general.

Appeal lies from a decision of a patents county court in the exercise of its special jurisdiction¹ in the ordinary way² on a question of law or fact to the Court of Appeal³ and thence with leave to the House of Lords⁴.

1 As to the meaning of 'special jurisdiction' see PARA 644.

2 See CPR Pt 52; and **CIVIL PROCEDURE** vol 12 (2009) PARA 1679 et seq.

3 See the County Courts Act 1984 s 77; and **CIVIL PROCEDURE** vol 12 (2009) PARA 1679. Where CPR Pt 52 requires a document to be served, it must also be served on the comptroller: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 63.17.

4 See the Appellate Jurisdiction Act 1876 s 3; and **COURTS** vol 10 (Reissue) PARA 360. As from a day to be appointed the appellate jurisdiction of the House of Lords is abolished and the Supreme Court of the United Kingdom is established: see Constitutional Reform Act 2005 Pt 3 (ss 23-60); and **COURTS** vol 10 (Reissue) PARA 601 et seq.

UPDATE

651 In general

NOTE 4--Appointed day is 1 October 2009: SI 2009/1604.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(1) THE INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY/652. Convention countries.

11. INTERNATIONAL CONVENTIONS

(1) THE INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

652. Convention countries.

Nearly all countries with appreciable industry are parties to the International Convention for the Protection of Industrial Property (the 'Paris Convention')¹. Such countries enjoy special protection for their vessels, aircraft and vehicles against claims for patent infringement². In addition Her Majesty may by Order in Council³ declare any country⁴ to be a convention country for the purposes of establishing priority⁵. Thus, an application made in a declared convention country for protection of an invention⁶ or an application which is treated, by law or treaty, by that country as equivalent to an application there, may be made the subject of a claim to priority in a United Kingdom application⁷ in the same way as an earlier United Kingdom application⁸.

1 The International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431). For a list of members see note 5.

2 See the Patents Act 1977 s 60(5)(d), (e), (7); and PARA 515.

3 As to the making of such orders see PARA 576.

4 For these purposes, every colony, protectorate and territory subject to the authority or under the suzerainty of another country, and every territory administered by another country under the trusteeship system of the United Nations is taken to be a country in the case of which a declaration may be so made: Patents Act 1977 s 90(3).

5 Patents Act 1977 s 90(1). Her Majesty may by Order in Council direct that any of the Channel Islands or any colony is to be taken to be a convention country for those purposes: s 90(2) (amended by the Statute Law (Repeals) Act 1986).

The following countries are declared to be convention countries by the Patents (Convention Countries) Order 2007, SI 2007/276, art 2, Schedule: Albania, Algeria, Andorra, Angola, Antigua and Barbuda, Argentina, Armenia, Australia, Austria, Azerbaijan, Bahamas, Bahrain, Bangladesh, Barbados, Belarus, Belgium, Belize, Benin, Bhutan, Bolivia, Bosnia and Herzegovina, Botswana, Brazil, Brunei Darussalam, Bulgaria, Burkina Faso, Burundi, Cambodia, Cameroon, Canada, Central African Republic, Chad, Chile, China, Columbia, Comoros, Congo, Democratic Republic of the Congo, Costa Rica, Cote d'Ivoire, Croatia, Cuba, Cyprus, Czech Republic, Denmark, Djibouti, Dominica, Dominican Republic, Ecuador, Egypt, El Salvador, Equatorial Guinea, Estonia, Faeroe Islands, Fiji, Finland, France (including Overseas Departments and Territories), Gabon, Gambia, Georgia, Germany, Ghana, Greece, Grenada, Guatemala, Guinea, Guinea-Bissau, Guyana, Haiti, Holy See, Honduras, Hong Kong, Hungary, Iceland, India, Indonesia, Islamic Republic of Iran, Iraq, Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kazakhstan, Kenya, Democratic People's Republic of Korea, Republic of Korea, Kuwait, Kyrgyzstan, Lao People's Democratic Republic, Latvia, Lebanon, Lesotho, Liberia, Libyan Arab Jamahiriya, Liechtenstein, Lithuania, Luxembourg, Macao, Former Yugoslav Republic of Macedonia, Madagascar, Malawi, Malaysia, Maldives, Mali, Malta, Mauritania, Mauritius, Mexico, Republic of Moldova, Monaco, Mongolia, Montenegro, Morocco, Mozambique, Myanmar, Namibia, Nepal, Netherlands, Netherlands Antilles and Aruba, New Zealand (including the Cook Islands, Niue and Tokelau), Nicaragua, Niger, Nigeria, Norway, Oman, Pakistan, Panama, Papua New Guinea, Paraguay, Peru, Philippines, Poland, Portugal, Qatar, Romania, Russian Federation, Rwanda, Saint Kitts and Nevis, Saint Lucia, Saint Vincent and the Grenadines, San Marino, Sao Tome and Principe, Saudi Arabia, Senegal, Serbia, Seychelles, Sierra Leone, Singapore, Slovakia, Slovenia, Solomon Islands, South Africa, Spain, Sri Lanka, Sudan, Suriname, Swaziland, Sweden, Switzerland, Syrian Arab Republic, Taiwan, Tajikistan, United Republic of Tanzania, Thailand, Togo, Tonga, Trinidad and Tobago, Tunisia, Turkey,

Turkmenistan, Uganda, Ukraine, United Arab Emirates, United States of America (including Puerto Rico and all territories and possessions), Uruguay, Uzbekistan, Venezuela, Viet Nam, Yemen, Zambia, Zimbabwe.

If the political situation in a country becomes too unstable, the UK Intellectual Property Office ceases to operate the convention in that country, although the Order remains in force. Information as to the position of particular countries in this respect may be obtained from the UK Intellectual Property Office. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

Under earlier legislation (most recently the Patents Act 1949 s 68 (repealed)) there was power to declare countries convention countries for the purpose of protection against claims for infringement. However, that power no longer seems to exist.

6 The application need not be for a patent; the convention expressly refers to an application for a patent or for the registration of a utility model (see the International Convention for the Protection of Industrial Property art 4A(1)), and it is clear that an application for an 'inventor's certificate' would be sufficient: cf the Convention on the Grant of European Patents (the 'European Patent Convention') (Munich, 5 October 1973; TS 20 (1978); Cmnd 7090) art 87(1).

7 As to convention priority in respect of applications for European patents (UK) and international applications (UK) see PARAS 664-665.

8 See the Patents Act 1977 s 5; and PARA 311.

UPDATE

652 Convention countries

NOTE 5--Now, Cape Verde is declared to be a convention country: SI 2007/276 (amended: SI 2009/2746).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(2) THE PATENT CO-OPERATION TREATY/(i) The Treaty/653. International applications.

(2) THE PATENT CO-OPERATION TREATY

(i) The Treaty

653. International applications.

The Patent Co-operation Treaty¹ enables an applicant to file a single application for a patent, known as an 'international application'², which is then subject to a single international search³ and, if desired, a single international preliminary examination⁴, before being filed with whichever national patent offices the applicant specifies⁵.

International applications may only be filed by residents or nationals of a contracting state⁶.

1 The Patent Co-operation Treaty (Washington, 19 June 1970; TS 78 (1978); Cmnd 7340). The United Kingdom ratified the treaty on 24 October 1977 and the treaty entered into force on 24 January 1978, except c II (arts 31-42) which entered into force on 29 March 1978. The treaty is divided into five chapters of which only c I (arts 3-30) (international applications and searches) and c II (international preliminary examinations) are relevant. For the contracting states see note 6.

References in the Patents Act 1977 to the Patent Co-operation Treaty are references to that Treaty or any international convention or agreement replacing it, as amended or supplemented by any convention or international agreement, including in either case any protocol or annex, or in accordance with the terms of any such convention or agreement, and include references to any instrument made under any such convention or agreement: Patents Act 1977 s 130(6)(c).

2 As to filing an international application see PARA 654.

3 As to the international search see PARA 656.

4 As to the international preliminary examination see PARA 660.

5 As to the communication of international applications to national patent offices see PARA 658; as to the filing of an international application with the UK Intellectual Property Office see PARA 654. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 See the Patent Co-operation Treaty art 9(1). As to the concepts of residence and nationality see art 9(3); Patent Co-operation Treaty Regulations r 18. No provision of the Patent Co-operation Treaty is to be interpreted as diminishing the rights under the Paris Convention for the Protection of Industrial Property (see PARA 652) of any resident or national of any country party to that convention: Patent Co-operation Treaty art 1(2).

The contracting states constitute the International Patent Co-operation Union (art 1(1)), of which the present members are Albania, Algeria, Angola, Antigua and Barbuda, Argentina, Armenia, Australia, Austria, Azerbaijan, Bahrain, Barbados, Belarus, Belgium, Belize, Benin, Bosnia and Herzegovina, Botswana, Brazil, Bulgaria, Burkina Faso, Cameroon, Canada, Central African Republic, Chad, China, Colombia, Comoros, Congo, Costa Rica, Côte d'Ivoire, Croatia, Cuba, Cyprus, Czech Republic, Democratic People's Republic of Korea, Denmark, Dominica, Dominican Republic, Ecuador, Egypt, El Salvador, Equatorial Guinea, Estonia, Finland, France, Gabon, Gambia, Georgia, Germany, Ghana, Greece, Grenada, Guatemala, Guinea, Guinea-Bissau, Holy See, Honduras, Hungary, Iceland, India, Indonesia, Islamic Republic of Iran, Ireland, Israel, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Lao People's Democratic Republic, Latvia, Lesotho, Liberia, Libyan Arab Jamahiriya, Liechtenstein, Lithuania, Luxembourg, Madagascar, Malawi, Malaysia, Mali, Malta, Mauritania, Mexico, Moldova, Monaco, Mongolia, Montenegro, Morocco, Mozambique, Namibia, Netherlands, New Zealand, Nicaragua, Niger, Nigeria, Norway, Oman, Papua New Guinea, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Saint Kitts and Nevis, Saint Lucia, Saint Vincent and the Grenadines, San Marino, Sao Tome and Principe, Senegal, Serbia, Seychelles, Sierra Leone, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sudan, Swaziland, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, The former Yugoslav Republic of Macedonia, Togo, Trinidad and Tobago, Tunisia, Turkey, Turkmenistan, Uganda, Ukraine, United Arab Emirates, United

Kingdom, United Republic of Tanzania, United States of America, Uzbekistan, Viet Nam, Zambia, Zimbabwe. The United Kingdom has extended the application of the Treaty to Hong Kong and to the Isle of Man.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(2) THE PATENT CO-OPERATION TREATY/(i) The Treaty/654. Filing of international applications.

654. Filing of international applications.

An international application for a patent¹ must be filed with the prescribed receiving office², namely the national patent office of or acting for the state of which the applicant is a resident or national, or with the International Bureau of the World Intellectual Property Organisation in Geneva³. The receiving office must then transmit one copy of the application (the 'record copy'⁴) to the International Bureau, one copy (the 'search copy') to the appropriate international searching authority⁵ and retains one copy (the 'home copy')⁶.

United Kingdom⁷ residents may not file international applications outside the United Kingdom without the written authority of the comptroller⁸ if the application contains information relating to military technology or might be prejudicial to national security or to the safety of the public⁹.

1 'International application for a patent' means an application made under the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340): Patents Act 1977 s 130(1). In the Patent Co-operation Treaty and the Patent Co-operation Treaty Regulations 'application' means an application for the protection of an invention; and references to an 'application' are to be construed as references to applications for patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition: Patent Co-operation Treaty art 2(i). As to the form and contents of an international application see PARA 655. The Patent Co-operation Treaty Regulations are often revised, the latest revision having come into force on 1 April 2007: see the PCT Gazette (18 January 2007) p 3 et seq.

2 Patent Co-operation Treaty art 10. 'Receiving office' means the national office or the intergovernmental organisation with which the application is filed: art 2(xv). As to the filing of applications see the Patents Rules 2007, SI 2007/3291, r 65. See also note 3.

3 Patent Co-operation Treaty Regulations r 19.1(a). Where the state is a member of a regional treaty, the organisation designated by that treaty may act for member states: see r 19.1(b). The European Patent Convention (see PARA 668 et seq) is a regional treaty and international applications, other than those made by United Kingdom residents, may therefore be filed with the European Patent Office as an alternative. The International Bureau of the World Intellectual Property Organisation is the administrative organisation of the Patent Co-operation Treaty: see art 55.

4 The record copy is considered the true copy of the application: Patent Co-operation Treaty art 12(2).

5 The international searching authority may be either a national office or an intergovernmental organisation, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications: Patent Co-operation Treaty art 16(1). The following national and regional offices have been appointed by the Assembly of the International Patent Co-operation Union (see PARA 653) under art 16(3) to act as international searching authorities: Australia, Austria, Canada, China, Finland, Japan, Republic of Korea, Nordic Patent Institute, the Russian Federation, Spain, Sweden, the United States of America, and the European Patent Organisation.

6 Patent Co-operation Treaty art 12(1). The fee to transmit an international application for a patent filed at the UK Intellectual Property Office to the International Bureau and the international searching authority is £55: Patents (Fees) Rules 2007, SI 2007/3292, r 7(3), (4). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

7 As to the meaning of 'United Kingdom' see PARA 303 note 5.

8 As to the comptroller see PARA 577.

9 See the Patents Act 1977 s 23(1), (1A); and PARA 337.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(2) THE PATENT CO-OPERATION TREATY/(i) The Treaty/655. Form and contents of international applications.

655. Form and contents of international applications.

An international application¹ must contain a request, a description of the invention, one or more claims, one or more drawings where required, and an abstract². The request must contain:

- 491 (1) a petition to the effect that the international application be processed according to the Patent Co-operation Treaty³;
- 492 (2) the designation of the contracting state or states ('designated states') in which the applicant desires protection⁴ and, if a regional patent⁵ is available for any designated state, whether the applicant desires a regional patent⁶;
- 493 (3) the name and address of the applicant and his agent, if any⁷; and
- 494 (4) the title of the invention⁸ and the name and address of the inventor or inventors where the national law of at least one of the designated states requires this information to be filed at the time of filing a national application⁹.

The description must disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art¹⁰. The claim or claims must define the matter for which protection is sought, must be clear and concise and must be fully supported by the description¹¹. The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought¹².

An international application may contain a declaration claiming priority from one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property¹³. An international application must relate to only one invention or to a group of inventions linked by a single inventive concept¹⁴.

There are specific regulations governing inventions involving the use of micro-organisms¹⁵ and nucleotide and amino acid sequence listings¹⁶.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7430) art 3(2). As to the language and form of an application see art 3(4); Patent Co-operation Treaty Regulations rr 3-12.

3 Patent Co-operation Treaty art 4(1)(i). The petition is preferably worded as follows: 'The undersigned requests that the present international application be processed according to the Patent Co-operation Treaty'.

4 Unless the applicant asks for any other kind of protection as referred to in the Patent Co-operation Treaty art 43 (eg an inventor's certificate, a utility certificate or a utility model), the request is deemed to be a request for protection by the grant of a patent by or for the designated state: art 4(3).

5 Ie a patent granted by a national or intergovernmental authority having the power to grant patents effective in more than one state: Patent Co-operation Treaty art 2(iv). The European Patent (see PARA 668) is a regional patent which may be requested under art 4(1).

6 Patent Co-operation Treaty art 4(1)(ii).

7 Patent Co-operation Treaty art 4(1)(iii).

8 Patent Co-operation Treaty art 4(1)(iv).

9 See the Patent Co-operation Treaty art 4(1)(v). As to the filing of United Kingdom applications see PARA 315 et seq.

10 Patent Co-operation Treaty art 5.

11 Patent Co-operation Treaty art 6. In particular, wherever appropriate, claims must contain: (1) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art; and (2) a characterising portion, preceded by the words 'characterised by' or 'characterised in that' or any other words to the same effect, stating concisely the technical features which, in combination with the prior art features, it is desired to protect: Patent Co-operation Treaty Regulations r 6.3(b).

12 Patent Co-operation Treaty art 3(3).

13 See the Patent Co-operation Treaty art 8. As to the Paris Convention for the Protection of Industrial Property see PARA 652.

14 See the Patent Co-operation Treaty Regulations r 13.

15 See the Patent Co-operation Treaty Regulations r 13 bis.

16 See the Patent Co-operation Treaty Regulations r 13 ter.

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656. The international search.

On receipt of an international application¹ the international searching authority² carries out an international search³, the purpose of which is to discover relevant prior art⁴ to enable subsequent examination to assess novelty and inventive step. The international searching authority is not required to search subject matter which is not patentable under national laws⁵. After the search, the international searching authority draws up an international search report⁶ which is sent to the International Bureau⁷ and to the applicant⁸.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 As to the international searching authority see PARA 654 note 5.

3 Every international application is subject to an international search: Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 15(1). As to the procedure before the international searching authority see art 17.

4 Patent Co-operation Treaty art 15(2). The search must be made on the basis of the claims, with due regard to the description and drawings, if any: art 15(3).

5 See the Patent Co-operation Treaty Regulations r 39. The exclusions there listed correspond to the exclusions from patentability under the United Kingdom law: see the Patents Act 1977 s 1(2); and PARA 431.

6 See the Patent Co-operation Treaty art 18.

7 As to the bureau see PARA 654 note 3.

8 Patent Co-operation Treaty art 18(2).

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657. Amendment of claims before the International Bureau.

On receipt of the international search report¹ the applicant under an international application² is allowed to amend the claims once³. In addition, he may file a brief statement explaining the amendments⁴. The amendments must not go beyond the disclosure in the international application as filed⁵.

1 As to the report see PARA 656.

2 As to the meaning of 'international application' see PARA 654 note 1.

3 See the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 19(1).

4 Patent Co-operation Treaty art 19(1).

5 See the Patent Co-operation Treaty art 19(2), (3). As to the filing of an international application see PARA 654. Amendment which goes beyond the original disclosure is not permitted under United Kingdom law: see the Patents Act 1977 s 76; and PARA 352.

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658. Communication of international applications to designated offices.

An international application¹, together with the international search report², must be communicated to each designated office³ by the International Bureau⁴. If the claims have been amended⁵, the claims both as filed and as amended must be communicated⁶.

Communication completes the international stage of an international application, the remaining procedures being governed solely by the national law of the designated state concerned. No designated office may process or examine an international application prior to the expiry of 30 months from its priority date⁷.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 As to the report see PARA 656.

3 'Designated office' means the national office of or acting for a designated state (see PARA 655): Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 2(xiii).

4 Patent Co-operation Treaty art 20(1); Patent Co-operation Treaty Regulations r 47.1. A designated office may waive the requirement that the International Bureau transmit the application and report, in which case the applicant is responsible for transmission: Patent Co-operation Treaty arts 20(1), 22. At the date at which this volume states the law only the United States of America (in part) had waived the requirement.

5 As to the amendment of claims see PARA 657.

6 Patent Co-operation Treaty art 20(2).

7 Patent Co-operation Treaty art 23(1). As to the priority date of an international application see art 8. At the express request of the applicant any designated office may, however, process or examine an international application at any time: art 23(2).

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659. International publication.

An international application¹ must be published by the International Bureau² as promptly as possible after the expiry of 18 months from the priority date of the application³, together with the international search report⁴.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 As to the bureau see PARA 654 note 3.

3 See the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 21(1), (2). As to the priority date of international applications see art 8; and as to the effects of publication see art 29.

4 See the Patent Co-operation Treaty art 21(3).

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660. International preliminary examination.

An applicant under an international application¹ who is either a resident or national² of a contracting state which has adhered to Chapter II³ of the Patent Co-operation Treaty may request an international preliminary examination of his application provided that he has filed his application at the receiving office⁴ of such a contracting state⁵. The international preliminary examination must be carried out by an international preliminary examining authority⁶.

The demand for an international preliminary examination must be made separately from the international application itself⁷, and must indicate the contracting state or states ('elected states') in which the applicant intends to use the results of the international preliminary examination⁸. Only designated states may be elected⁹.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 As to residence and nationality see PARA 653 note 6.

3 I.e. the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970, TS 78 (1978); Cmnd 7340) c II (arts 31-42), dealing with international preliminary examinations. The contracting states which have not adhered to c II (arts 31-42) are Greece, Liechtenstein, Spain, and Switzerland.

4 As to the meaning of 'receiving office' see PARA 654 note 2.

5 See the Patent Co-operation Treaty art 31(2).

6 Patent Co-operation Treaty art 32(1). The following national and regional offices have been appointed international preliminary examining authorities under arts 16(3), 32(3): Australia, Austria, Canada, China, Finland, Japan, Republic of Korea, Nordic Patent Institute, Russian Federation, Spain, Sweden, the United States of America and the European Patent Office. As to the European Patent Office see PARA 668 note 2.

7 Patent Co-operation Treaty art 31(3).

8 Patent Co-operation Treaty art 31(4)(a).

9 Patent Co-operation Treaty art 31(4)(a). As to designated states see PARA 655. The comptroller has power under the Patents Rules 2007, SI 2007/3291, r 107 (see PARA 592) to correct irregularities or errors in a demand filed at the UK Intellectual Property Office as the relevant receiving office (see PARA 654 note 2): *Prangley's Application* [1988] RPC 187, CA. See also *Vapocure Technologies Ltd's Application* [1990] RPC 1, CA. There is also power under the Patent Co-operation Treaty Regulations r 91.1 to correct obvious errors: see *Vapocure Technologies Ltd's Application*; *R v Comptroller-General of Patents, ex p Celltech Ltd* [1991] RPC 475; *Drazil's Application* [1992] RPC 479. As to the comptroller see PARA 577. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

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661. Function and scope of international preliminary examinations.

The purpose of an international preliminary examination¹ is to formulate a preliminary and non-binding opinion as to whether the invention claimed appears to be novel, to involve an inventive step, and to be industrially applicable². For the purposes of the examination, a claimed invention is considered novel if it is not anticipated by the prior art³, and it is considered to involve an inventive step if, having regard to the prior art, it is not at its priority date obvious to a person skilled in the art⁴. A claimed invention is considered to be industrially applicable if it can be made or used in any kind of industry⁵. Any contracting state⁶ may, however, apply additional or different criteria for the purpose of deciding whether, in that state, the claimed invention is patentable⁷. The examination must take into consideration all the documents cited in the international search report⁸ and may also consider any additional relevant documents⁹, but the examining authority is not required to examine subject matter which is not patentable under national laws¹⁰.

The international preliminary examination report must state in relation to each claim whether it appears to satisfy the criteria of novelty, inventive step and industrial applicability, but it must not contain any statement as to whether the claimed invention is or seems to be patentable under any national law¹¹. The report is accompanied by the citation of documents believed to support the stated conclusion together with such further explanation as may be thought necessary¹². The report is then sent to the applicant and to the International Bureau¹³, and the report, together with any translations that may be required, are transmitted by the International Bureau to the national patent office of each elected state¹⁴.

1 As to the examination generally see PARA 660.

2 Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 33(1).

3 Patent Co-operation Treaty art 33(2). 'Prior art' is defined in the Patent Co-operation Treaty Regulations r 33, and essentially consists of every written disclosure made available to the public before the priority date of the application (see PARA 658).

4 Patent Co-operation Treaty art 33(3).

5 See the Patent Co-operation Treaty art 33(4).

6 As to contracting states see PARA 653 note 6.

7 Patent Co-operation Treaty art 33(5).

8 As to the report see PARA 656.

9 Patent Co-operation Treaty art 33(6).

10 See the Patent Co-operation Treaty Regulations r 67. The exclusions listed in r 67 correspond to the exclusions from patentability contained in the Patents Act 1977 s 1(2); see PARA 431.

11 See the Patent Co-operation Treaty art 35(2).

12 Patent Co-operation Treaty art 35(2).

13 Patent Co-operation Treaty art 36(1). As to the International Bureau see PARA 654 note 3.

14 See the Patent Co-operation Treaty art 36(3). As to elected states see PARA 660.

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662. Amendment of claims before elected offices.

An applicant under an international application¹ may amend the claims, description and drawings once before each elected office² before the expiry of 19 months from the priority date³. The amendments must not go beyond the disclosure in the international application as filed unless permitted under the national law of the elected state⁴, and must be in accordance with the national law of the elected state in all respects not provided for in the Patent Co-operation Treaty and the Implementing Regulations⁵.

The international phase is then complete. Thereafter the application enters the national phase. No elected office may process the international application according to its own law before the expiry of 25 months from the priority date of the international application⁶, unless the applicant requests an earlier processing⁷.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 'Elected office' means the national office of or acting for the elected state (see PARA 660); Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 2(xiv).

3 Patent Co-operation Treaty art 41(1); Patent Co-operation Treaty Regulations r 78.1.

4 Patent Co-operation Treaty art 41(2).

5 Patent Co-operation Treaty art 41(3).

6 Patent Co-operation Treaty art 40(1). As to the priority date of an international application see PARA 658.

7 Patent Co-operation Treaty art 40(2).

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663. Patent agents and other representatives.

Any attorney, patent agent or other person having the right to practise before the national office with which the international application¹ was filed² is entitled to practise before the International Bureau³ and the competent international searching and preliminary examination authorities⁴ in respect of that application⁵.

1 As to the meaning of 'international application' see PARA 654 note 1.

2 As to the filing of international applications see PARA 654.

3 As to the International Bureau see PARA 654 note 3.

4 As to these authorities see PARAS 656, 660.

5 Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 49.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(2) THE PATENT CO-OPERATION TREATY/(ii) Incorporation of International Applications into the British Patent System/664. Effect of international application for patent.

(ii) Incorporation of International Applications into the British Patent System

664. Effect of international application for patent.

An international application for a patent (UK)¹ for which a date of filing has been accorded under the Patent Co-operation Treaty² is treated³ as an application for a patent under the Patents Act 1977⁴.

If the application, or the designation of the United Kingdom in it, is withdrawn or deemed⁵ to be withdrawn under the Treaty, it is treated as withdrawn under the Patents Act 1977⁶.

An application is not, however, treated as withdrawn under the Patents Act 1977 if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Treaty:

- 495 (1) because of an error or omission in an institution having functions under the Treaty; or
- 496 (2) because, owing to circumstances outside the applicant's control, the application was not received by the International Bureau⁷ before the end of the time limited for that purpose under the Treaty,

or in such other circumstances as may be prescribed⁸.

If an international application for a patent which designates the United Kingdom is refused a filing date under the Treaty and the comptroller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, he may direct that the application is to be treated as an application under the Patents Act 1977, having such date of filing as he may direct⁹.

1 For these purposes, 'international application for a patent (UK)' means an international application for a patent which, on its date of filing, designates the United Kingdom: Patents Act 1977 s 130(1). 'Designate' in relation to an application or a patent, means designate the country or countries (in pursuance of the European Patent Convention (see PARA 668 et seq) or the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340)) in which protection is sought for the invention which is the subject of the application or patent and includes a reference to a country being treated as designated in pursuance of the convention or treaty: Patents Act 1977 s 130(1) (definition amended by the Patents Act 2004 s 5, Sch 1 paras 1, 9). An international application for a patent is not, by reason of being treated by virtue of the European Patent Convention as an application for a European patent (UK), to be treated also as an international application for a patent (UK): Patents Act 1977 s 130(4A) (added by the Patents Act 2004 Sch 1 paras 1, 9). As to the meaning of 'international application for a patent' see PARA 654 note 1. As to the meaning of 'date of filing' see PARA 316; and as to the meaning of 'United Kingdom' see PARA 303 note 5.

2 As to the Patent Co-operation Treaty see PARA 653 et seq.

3 Ie for the purposes of the Patents Act 1977 Pt I (ss 1-76A) and Pt III (ss 97-132) but subject to s 89A (international and national phases of applications: see PARA 665) and s 89B (adaptation of provisions in relation to international applications: see PARAS 665-667).

4 Patents Act 1977 s 89(1) (s 89 substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 25). As to international applications for patents under the Patents Act 1977 s 89 see the Patents Rules 2007, SI 2007/3291, Pt 6 (rr 64-72).

5 le except as mentioned in the Patents Act 1977 s 89(3): see the text and notes 7-8.

6 Patents Act 1977 s 89(2) (as substituted: see note 4).

7 As to the International Bureau see PARA 654 note 3.

8 Patents Act 1977 s 89(3) (as substituted: see note 4). See also note 9. See *Mitsubishi Jidosha Kogyo KK's Application* [1988] RPC 449 (where the application was saved under head (1) in the text). The other circumstance prescribed for the purposes of the Patents Act 1977 s 89(3) is where the comptroller determines that, in comparable circumstances in relation to an application under the Patents Act 1977 (other than an international application for a patent (UK)), he would have exercised his powers under the Patents Rules 2007, SI 2007/3291, r 107 (see PARA 592) or r 108 (see PARA 599) to prevent the application being treated as withdrawn: r 72. As to the comptroller see PARA 577.

9 Patents Act 1977 s 89(5) (as substituted: see note 4). The applicant may, before the end of the relevant period, make a written request to the comptroller to give a direction under s 89(5): Patents Rules 2007, SI 2007/3291, r 71(1). The relevant period is two months beginning with the date on which the International Bureau, or the receiving office, notifies the applicant that his international application for a patent (UK) is refused a filing date under the Patent Co-operation Treaty: Patents Rules 2007, SI 2007/3291, r 71(4). The applicant may notify the comptroller that the circumstances mentioned in the Patents Act 1977 s 89(3) (see the text and notes 7-8) or the Patents Rules 2007, SI 2007/3291, r 72 (see note 8) apply to his application: r 71(2). The request under r 71(1) must be accompanied by a statement of the reasons for the request and the fee prescribed for the purposes of the Patents Act 1977 s 89A(3) (see PARA 665): Patents Rules 2007, SI 2007/3291, r 71(3). Where the applicant has made a request to the comptroller under r 71(1), the comptroller may direct the applicant to furnish him with any document, information or evidence within such period as the comptroller may specify: r 71(5). Where the applicant fails, before the end of the period specified, to comply with such a direction, the comptroller may treat him as having withdrawn his request: r 71(6). Where the Patents Act 1977 s 89(3) applies or a direction has been given under s 89(5) the comptroller may: (1) alter any period of time (whether it has already expired or not) specified in the Act or listed in the Patents Rules 2007, SI 2007/3291, Sch 4 Pts 1-3 (see PARA 599); and (2) amend any document kept at the UK Intellectual Property Office in relation to the application, subject to such conditions as the comptroller may direct: r 71(7). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

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665. International and national phases of application.

The provisions of the Patent Co-operation Treaty¹ relating to publication², search³, examination⁴ and amendment⁵, and not those of the Patents Act 1977, apply to an international application for a patent (UK)⁶ during the international phase of the application⁷.

The international phase of the application means the period from the filing of the application in accordance with the Treaty until the national phase of the application begins⁸. The national phase of the application begins:

- 497 (1) when the prescribed period⁹ expires, provided any necessary translation of the application into English has been filed at the UK Intellectual Property Office¹⁰ and the prescribed fee¹¹ has been paid by the applicant¹²; or
- 498 (2) on the applicant expressly requesting the comptroller to proceed earlier with the national phase of the application, filing at the UK Intellectual Property Office:
- 22 35. (a) a copy of the application¹³, if none has yet been sent to the UK Intellectual Property Office in accordance with the Treaty; and
- 36. (b) any necessary translation of the application into English¹⁴,
- 23

and paying the prescribed fee¹⁵.

Where, during the international phase the application is amended in accordance with the Treaty, the amendment is treated as made under the Patents Act 1977 if:

- 499 (i) when the prescribed period expires, any necessary translation of the amendment into English has been filed at the UK Intellectual Property Office; or
- 500 (ii) where the applicant expressly requests the comptroller to proceed earlier with the national phase of the application, there is then filed at the UK Intellectual Property Office a copy of the amendment, if none has yet been sent to the UK Intellectual Property Office in accordance with the Treaty and any necessary translation of the amendment into English;

otherwise the amendment must be disregarded¹⁶.

During the international phase of the application the statutory provisions relating to the determination of questions of entitlement in relation to applications¹⁷ do not apply and the statutory provisions relating to the determination of entitlement in relation to foreign and convention patents¹⁸ apply notwithstanding the application; but after the end of the international phase the statutory provisions relating to the determination of questions of entitlement in relation to applications apply and the statutory provisions relating to the determination of entitlement in relation to foreign and convention patents do not¹⁹.

When the national phase begins, the comptroller must refer the application for so much of the examination²⁰ and search²¹ as he considers appropriate in view of any examination or search²² carried out under the Treaty²³.

1 le the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340): see PARA 653 et seq.

2 As to publication see PARA 659.

3 As to search see PARA 656.

4 As to examination see PARA 660.

5 As to amendment see PARA 657.

6 As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1.

7 Patents Act 1977 s 89A(1) (s 89A added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 25).

8 Patents Act 1977 s 89A(2) (as added: see note 7).

9 The prescribed period for the purposes of the Patents Act 1977 s 89A(3)(a), (5)(a) is 31 months beginning with: (1) where there is no declared priority date, the date of filing of the application; (2) where there is a declared priority date, that date: Patents Rules 2007, SI 2007/3291, r 66(1). However, where the applicant has been notified under r 69(5) that a translation is missing (see note 10), the prescribed period is three months beginning with the date of the notification: Patents Rules 2007, SI 2007/3291, r 66(1). As to the extension of time limits see para 599. If the prescribed period expires without the conditions mentioned in the Patents Act 1977 s 89A(3)(a) being satisfied, the application is taken to be withdrawn: s 89A(4) (as added: see note 7).

10 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

A translation is necessary for the purposes of the Patents Act 1977 s 89A(3) where any of the following are not in English: (1) the international application for a patent (UK) as published in accordance with the Patent Co-operation Treaty; (2) where the information mentioned in the Patents Rules 2007, SI 2007/3291, r 13(1), Sch 1 para 3(2)(a), (b) (biological material) has been provided (see PARA 322), that information: r 69(1). Where the applicant expressly requests the comptroller to proceed with the national phase before the end of the period prescribed by r 66(1) (see note 9), the translation must include the request and abstract: r 69(2). But r 69(2) does not apply where a copy of the application, as published in accordance with the Patent Co-operation Treaty, is available to the comptroller: r 69(3). A translation of an amendment is necessary for the purposes of the Patents Act 1977 s 89A(5) (see the text to note 16) where any amendment made to the application is not in English and has either been: (a) published under the Patent Co-operation Treaty; or (b) annexed to the International Preliminary Examination Report (see PARA 660): Patents Rules 2007, SI 2007/3291, r 69(4). At the end of the period prescribed by r 66(1) (see note 9), the comptroller must notify the applicant that a necessary translation is missing if: (i) a translation of the application has been filed, but a translation of the amendment has not been filed; or (ii) the information mentioned in Sch 1 para 3(2)(a), (b) (biological material) has been provided, but a translation of that information has not been filed, and the prescribed fee has been paid: r 69(5).

Translations which are necessary for the purposes of the Patents Act 1977 s 89A(3) and (5) are necessary for only that part of the application which is in a language other than English: Patents Rules 2007, SI 2007/3291, r 70(1), (2). Where the application includes a drawing which is annotated, the translation must include either a copy of the original drawing where the original annotations have been replaced by annotations in English, or a new drawing with the annotations in English: r 70(3). Where a title has been established for the application by the International Searching Authority (see PARA 654 note 5), the translation must include that title (and not any title which was included in the application as it was originally filed): r 70(4). Where the description of the invention includes a sequence listing and the listing complies with the relevant requirements of the Patent Co-operation Treaty, the translation of the application may exclude a translation of the sequence listing: Patents Rules 2007, SI 2007/3291, r 70(5). These provisions apply to translations of amendments as they apply to translations of applications and accordingly references to 'application' are to be construed as references to 'amendment': r 70(6).

11 The prescribed fee to publish a translation filed at the UK Intellectual Property Office under the Patents Act 1977 s 89A(3) or (5) (international and national phases of application) is £12: Patents (Fees) Rules 2007, SI 2007/3292, r 7(1).

12 Patents Act 1977 s 89A(3)(a) (as added: see note 7). The comptroller must on payment of the prescribed fee publish any translation filed at the UK Intellectual Property Office under the Patents Act 1977 s 89A(3) or s 89A(5) (see the text to note 16): s 89A(6) (as added: see note 7).

13 For these purposes, a 'copy of the application' includes a copy published in accordance with the Treaty in a language other than that in which it was originally filed: Patents Act 1977 s 89A(3) (as added: see note 7).

- 14 Patents Act 1977 s 89A(3)(b) (as added: see note 7). See also note 12.
- 15 See the Patents Act 1977 s 89A(3) (as added: see note 7).
- 16 Patents Act 1977 s 89A(5) (as added: see note 7). See also notes 10, 12.
- 17 Ie the Patents Act 1977 s 8: see PARAS 361-362.
- 18 Ie the Patents Act 1977 s 12: see PARA 364.
- 19 Patents Act 1977 s 89B(4) (s 89B added by the Copyright, Designs and Patents Act 1988 Sch 5 para 25).
See eg *Cannings' United States Application* [1992] RPC 459 (cited in PARA 364 note 4).
- 20 Ie under the Patents Act 1977 s 15A (see PARA 318), s 17 (see PARA 328).
- 21 Ie under the Patents Act 1977 ss 17, 18: see PARAS 328-329.
- 22 As to examination under the Treaty see PARA 660; and as to the search so carried out see PARA 656.
- 23 Patents Act 1977 s 89B(5) (as added: see note 19).

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666. International applications for patents (UK).

Where an international application for a patent (UK)¹ is accorded a filing date² under the Patent Co-operation Treaty³:

- 501 (1) that date or, if the application is redated under the Treaty⁴ to a later date, that later date is treated as the date of filing⁵ the application under the Patents Act 1977⁶;
- 502 (2) any declaration of priority made under the Treaty⁷ is treated as made under the Patents Act 1977⁸ and, where in accordance with the Treaty any extra days are allowed, the specified period of 12 months⁹ is treated as altered accordingly¹⁰; and
- 503 (3) any statement of the name of the inventor under the Treaty¹¹ is treated as a statement filed¹² under the Patents Act 1977¹³.

If the application, not having been published under the Patents Act 1977, is published in accordance with the Treaty¹⁴, it is treated¹⁵ as published under the Patents Act 1977¹⁶ when the national phase of the application begins or, if later, when published in accordance with the Treaty¹⁷.

1 As to the meaning of 'international application for a patent (UK)' see PARA 664 note 1.

2 The receiving office must accord as the international filing date the date of receipt of the international application, provided that that office has found that, at the time of receipt: (1) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving office; (2) the international application is in the prescribed language; (3) the international application contains at least the following elements: (a) an indication that it is intended as an international application; (b) the designation of at least one contracting state; (c) the name of the applicant, as prescribed; (d) a part which on the face of it appears to be a description; (e) a part which on the face of it appears to be a claim or claims: Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340) art 11(1). As to the receiving office see PARA 654.

3 As to the Patent Co-operation Treaty see PARA 653 et seq.

4 If the receiving office finds that the international application did not, at the time of receipt, fulfil the requirements listed in the Patent Co-operation Treaty art 11(1) (see note 2), it must invite the applicant to file the required correction: art 11(2).

5 As to the meaning of 'date of filing' see PARA 316.

6 Patents Act 1977 s 89B(1)(a) (s 89B added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 25).

7 Ie under the Patent Co-operation Treaty art 8.

8 Ie under the Patents Act 1977 s 5(2): see PARA 311.

9 Ie the period allowed under the Patents Act 1977 s 5(2)(a): see PARA 311.

10 Patents Act 1977 s 89B(1)(b) (as added (see note 6); and amended by SI 2004/2357).

11 Ie under the Patent Co-operation Treaty art 4(1)(v), (4).

12 Ie under the Patents Act 1977 s 13(2): see PARA 308.

- 13 Patents Act 1977 s 89B(1)(c) (as added: see note 6).
- 14 ie under the Patent Co-operation Treaty art 21: see PARA 659.
- 15 ie for purposes other than those mentioned in the Patents Act 1977 s 89B(3): see PARA 667.
- 16 ie under the Patents Act 1977 s 16: see PARA 327.
- 17 Patents Act 1977 s 89B(2) (as added (see note 6); and amended by the Patents Act 2004 s 5, Sch 1 paras 1, 8).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(2) THE PATENT CO-OPERATION TREATY/(ii) Incorporation of International Applications into the British Patent System/667. Effect of international applications for patents (UK).

667. Effect of international applications for patents (UK).

For the purposes of the statutory provisions relating to the use of an invention for the service of the Crown¹ and the infringement of rights conferred by publication², the application, not having been published under the Patents Act 1977, is treated as duly published³:

- 504 (1) if it is published in accordance with the Patent Co-operation Treaty⁴ in English, on its being so published⁵; and
- 505 (2) if it is so published in a language other than English on the due publication of a translation of the application⁶ or on the service by the applicant of a translation into English of the specification of the application on the government department concerned or, as the case may be, on the person committing the infringing act⁷.

1 Ie the Patents Act 1977 s 55: see PARAS 405-406.

2 Ie the Patents Act 1977 s 69: see PARAS 548-549.

3 Ie under the Patents Act 1977 s 16: see PARA 327.

4 Ie the Patent Co-operation Treaty (Washington, 19 June to 31 December 1970; TS 78 (1978); Cmnd 7340): see PARA 653 et seq.

5 Patents Act 1977 s 89B(3)(a) (s 89B added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 25). For these purposes, the reference to the service of a translation on a government department or other person is to its being sent by or delivered to that department or person: Patents Act 1977 s 89B(3) (as so added).

6 Ie in accordance with the Patents Act 1977 s 89A(6): see PARA 665.

7 Patents Act 1977 s 89B(3)(b) (as added: see note 5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(i) The Convention/668. The European Patent Convention.

(3) THE EUROPEAN PATENT CONVENTION

(i) The Convention

668. The European Patent Convention.

Under the European Patent Convention¹ a person seeking protection for an invention may file a single application for a patent at the European Patent Office² specifying in which of the contracting states he desires to obtain protection³. After an examination for patentability⁴ by the European Patent Office, a European patent⁵ is granted. A European patent takes effect as a number of national patents operative in the states designated by the applicant⁶. A European patent may be opposed before the European Patent Office within the period of nine months after its grant⁷. If no opposition is entered or any such opposition is rejected, the validity of the European patent can thereafter be put in issue only in the national courts of the states designated by the applicant and is subject to the relevant national law⁸. Infringement of a European patent is governed solely by the national law of the state concerned⁹. After grant a European patent has the same territorial effect in the states for which it has been granted as does a national patent¹⁰.

When the Community Patent Convention comes into force¹¹, an application for a European patent designating one or all member states of the European Community will result in the grant of a Community patent¹².

1 For these purposes, 'European Patent Convention' means the Convention on the Grant of European Patents (Munich, 5 October 1973; TS 20 (1978); Cmnd 7090): Patents Act 1977 s 130(1). The following states have acceded to the convention: Austria, Belgium, Bulgaria, Croatia, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, the Netherlands, Norway, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey and the United Kingdom.

The European Patent Organisation has concluded 'extension agreements' with a number of states which are not parties to the European Patent Convention. Under these agreements, applicants for European patents may, on payment of an extension fee, obtain protection for their patents in the countries with which such agreements have been concluded. At the date at which this volume states the law, extension agreements are in force with the following states: Albania, Bosnia and Herzegovina, Macedonia, and Serbia: see EPO Official Journal 2006 p 325.

References in the Patents Act 1977 to the European Patent Convention are references to that Convention or any international convention or agreement replacing it, as amended or supplemented by any convention or international agreement, including in either case any protocol or annex, or in accordance with the terms of any such convention or agreement, and include references to any instrument made under any such convention or agreement: Patents Act 1977 s 130(6)(a).

2 For these purposes, 'European Patent Office' means the patent office established by the European Patent Convention: Patents Act 1977 s 130(1). The seat of the office is in Munich, with branches in The Hague, Berlin, Vienna and Brussels. As to the office generally see the European Patent Convention arts 4, 10-25; and as to the communication of information from the United Kingdom to the European Patent Office see the Patents Act 1977 s 94; the Patents Rules 2007, SI 2007/3291, r 63. Any costs awarded by the European Patent Office are recoverable by execution issued from the county court or otherwise as if they were payable under an order of the court: Patents Act 1977 s 93(a). As from a day to be appointed, costs are recoverable under the County Courts Act 1984 s 85: see the Patents Act 1977 s 93(a) (prospectively amended by the Tribunals, Courts and Enforcement Act 2007 s 62(3), Sch 13 paras 39, 42). At the date at which this volume states the law no such day had been appointed.

3 See the European Patent Convention art 3.

4 As to the criteria of patentability see PARA 671.

5 'European patent' means a patent granted under the European Patent Convention: art 2(1); Patents Act 1977 s 130(1).

6 See the European Patent Convention art 2(2).

7 See the European Patent Convention arts 99-105.

8 See the European Patent Convention art 2(2).

9 European Patent Convention art 64(3).

10 European Patent Convention art 64(1). Where an undertaking has been given to prosecute an appeal with due diligence, resulting in a stay of revocation, that appeal may not be stayed pending the outcome of an EPO decision on a related matter unless some other good grounds are shown to support such a stay: *Beloit Technologies Inc v Valmet Paper Machinery Inc* [1996] FSR 718, CA.

11 As to the Community Patent Convention see PARA 679.

12 See PARA 679.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(i) The Convention/669. Filing an application for a European patent.

669. Filing an application for a European patent.

An applicant may file an application for a European patent¹ at the European Patent Office² or at the national patent office of a contracting state³. Persons resident in the United Kingdom⁴ may, however, only file an application for a European patent at the UK Intellectual Property Office where the application could be prejudicial to national security or the safety of the public⁵. An application filed at a national patent office has the same effect as if it had been filed on the same day at the European Patent Office⁶. An application filed at a national patent office must be forwarded by that office within six weeks of filing to the European Patent Office unless the subject matter is obviously liable to secrecy⁷.

1 As to the meaning of 'European patent' see PARA 668 note 5. As to the application see PARA 670.

2 As to the European Patent Office see PARA 668 note 2.

3 European Patent Convention art 75(1). As to the meaning of 'European Patent Convention' see PARA 746 note 1.

4 As to the meaning of 'United Kingdom' see PARA 303 note 5.

5 See the Patents Act 1977 s 23; and PARA 337. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 European Patent Convention art 75(1)(b).

7 See the European Patent Convention art 77. Failure by a national office to transmit the application within the prescribed period will result in loss of rights for which there is no restitution: see Case J-03/80 *Chubb/Failure to forward a European patent application* [1979-1985] EPOR 23, Legal Board of Appeal.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(i) The Convention/670. Form and contents of application for a European patent and date of filing.

670. Form and contents of application for a European patent and date of filing.

An application for a European patent¹ must contain a request for the grant of a European patent², a description of the invention³, one or more claims⁴, any drawings referred to in the description or the claims⁵ and an abstract⁶. The application is subject to the payment of a filing fee and a search fee within one month of its filing⁷, and must satisfy the conditions laid down in the Implementing Regulations⁸.

All the contracting states⁹ at the time of filing of the European patent application are deemed to be designated in the request for grant of a European patent¹⁰. Designation may be withdrawn at any time up to the grant of the European patent¹¹. The application must designate the inventor¹². If the applicant is not the inventor or the sole inventor, the designation must contain a statement indicating the origin of the right to the European patent¹³. The application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept¹⁴, and must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art¹⁵. The claims must define the matter for which protection is sought, be clear and precise and be supported by the description¹⁶. Wherever appropriate, the claims must contain a statement of those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art and a characterising portion, preceded by the expression 'characterised in that' or 'characterised by', stating the technical features which, in combination with the prior art features, it is desired to protect¹⁷.

The date of filing of an application for a European patent is the date on which the documents filed by the applicant contain:

- 506 (1) an indication that a European patent is sought;
- 507 (2) information identifying the applicant or allowing the applicant to be contacted; and
- 508 (3) a description or reference to a previously filed application¹⁸.

Priority may be claimed from any convention application¹⁹ filed during the period of 12 months preceding the date of filing of an application for a European patent²⁰.

1 As to the meaning of 'European patent' see PARA 668 note 5.

2 European Patent Convention art 78(1)(a). As to the meaning of 'European Patent Convention' see PARA 668 note 1.

3 European Patent Convention art 78(1)(b).

4 European Patent Convention art 78(1)(c).

5 European Patent Convention art 78(1)(d).

6 European Patent Convention art 78(1)(e).

7 European Patent Convention art 78(2).

8 European Patent Convention art 78(1). The Implementing Regulations are appended to the convention: see generally the Implementing Regulations rr 26-36. The Implementing Regulations have been amended from time to time.

9 For the contracting states see PARA 668 note 1.

10 European Patent Convention art 79(1). Designation may be subject to the payment of a designation fee: see art 79(2).

11 European Patent Convention art 79(3).

12 European Patent Convention art 81.

13 European Patent Convention art 81. The right to a European patent belongs to the inventor or his successors in title, except where the inventor is an employee, in which case the right to the patent is subject to the national law of the state in which he is mainly employed: see art 60.

14 European Patent Convention art 82. Plurality of invention is not, however, a ground of opposition: see PARA 673.

15 European Patent Convention art 83. As to biotechnological inventions see the Implementing Regulations rr 26-34.

16 European Patent Convention art 84.

17 See the Implementing Regulations r 43(1).

18 European Patent Convention art 80; Implementing Regulations r 40(1).

19 As to convention applications see PARA 669.

20 See the European Patent Convention arts 87-89.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(i) The Convention/671. Criteria of patentability.

671. Criteria of patentability.

A European patent¹ may be granted only in respect of an invention which is susceptible of industrial application², which is new and which involves an inventive step³. In particular the following are not regarded as patentable inventions:

- 509 (1) discoveries, scientific theories and mathematical methods⁴;
- 510 (2) aesthetic creations⁵;
- 511 (3) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers⁶; and
- 512 (4) presentations of information⁷.

European patents may not be granted in respect of methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body, but products, such as substances and compositions, for use in any such methods are patentable provided that the criteria of novelty and inventive step are satisfied⁸.

A European patent may not be granted in respect of an invention the commercial exploitation of which would be contrary to 'ordre public' or morality⁹, nor may it be granted in respect of plant or animal varieties or essentially biological processes for the production of plants or animals¹⁰. An invention is considered to be new if it does not form part of the state of the art¹¹. The state of the art comprises everything that has been made available to the public by means of a written or oral description, by use, or in any other way before the date of filing of the European patent application¹². In addition, the state of the art comprises for the purposes of assessing novelty, but not inventive step, the content of European patent applications as filed, the dates of filing of which are earlier than that of the application in suit but which were published on or after that date¹³. An invention involves an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art¹⁴.

1 As to the meaning of 'European patent' see PARA 668 note 5.

2 An invention is considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture: European Patent Convention art 57. As to the meaning of 'European Patent Convention' see PARA 668 note 1.

3 European Patent Convention art 52(1). Cf the Patents Act 1977 s 1(1); and PARA 430 et seq. Cases on patentability under the Patents Act 1977 are of persuasive authority. Likewise cases on patentability under the European Patent Convention are of persuasive authority in the English courts. See further PARAS 430-488 where both United Kingdom and European Patent Office cases are cited. The correct approach in determining whether an 'invention' was unpatentable within the terms of art 52(2), (3) was in four steps: (1) to properly construe the claim; (2) to identify the actual contribution; (3) to ask whether it fell solely within the excluded subject matter; and (4) to check whether the actual or alleged contribution was actually technical in nature: *Aerotel Ltd v Telco Holdings Ltd; Re Macrossan's Application* [2006] EWCA Civ 1371 at [40]-[49], [2007] 1 All ER 225 at [40]-[49], [2007] RPC 117 at [40]-[49] per Jacob LJ, giving the judgment of the court.

4 European Patent Convention art 52(2)(a).

5 European Patent Convention art 52(2)(b).

6 European Patent Convention art 52(2)(c). A computer program product which comprises all the features enabling the implementation of a method and which, when loaded onto a computer, is capable of carrying out

that method is patentable as a European patent: Case T-0935/97 *Re IBM's European Patent Application No 96 305 851.6* (1999) Times, 15 April.

7 European Patent Convention art 52(2)(d).

8 See the European Patent Convention art 53(c). See *Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals Inc* [2001] RPC 1, [2000] All ER (D) 713, [2000] IP & T 908, CA.

9 European Patent Convention art 53(a). The exploitation is not deemed to be contrary to 'ordre public' or morality merely because it is prohibited by law or regulation in some or all of the contracting states: art 53(a). For the contracting states see PARA 668 note 1.

10 European Patent Convention art 53(b). Article 53(b) does not apply to microbiological processes or products of such processes: art 53(b).

11 European Patent Convention art 54(1). As to non-prejudicial disclosures see art 55.

12 European Patent Convention art 54(2). As to the date of filing of a European patent application see PARA 670.

13 European Patent Convention arts 54(3), 56.

14 European Patent Convention art 56.

UPDATE

671 Criteria of patentability

NOTE 2--See *Eli Lilly & Co v Human Genome Sciences Inc* [2008] EWHC 1903 (Pat), [2009] IP & T 306 (patent invalid for lack of industrial applicability) (affd: [2010] EWCA Civ 33, [2010] IP & T 442).

NOTE 14--See *Armour Group plc v Leisuretech Electronics Pty Ltd* [2008] EWHC 2797 (Pat), [2008] All ER (D) 155 (Nov).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(i) The Convention/672. Examination of an application for a European patent.

672. Examination of an application for a European patent.

An application for a European patent¹ is subject to a search to ascertain whether the criteria of novelty and inventive step are satisfied² and is examined to ascertain whether it meets the requirements of the European Patent Convention as to patentability³. The application must be published by the European Patent Office⁴ as soon as possible after the expiry of a period of 18 months from its priority date⁵. If the application and the invention to which it relates meet the requirements of the convention, the European Patent Office must grant the European patent⁶. As soon as possible after it publishes the mention of the grant of a European patent, the European Patent Office must publish the specification of the European patent⁷.

1 As to the meaning of 'European patent' see PARA 668 note 5.

2 See the European Patent Convention art 92. As to the meaning of 'European Patent Convention' see PARA 668 note 1.

3 See the European Patent Convention art 94. As to the criteria of patentability see PARA 671.

4 As to the European Patent Office see PARA 668 note 2.

5 See the European Patent Convention art 93. As to the priority date see PARA 670.

6 See the European Patent Convention art 97(1).

7 European Patent Convention art 98.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(i) The Convention/673. Opposition.

673. Opposition.

Within nine months of the publication of the mention of the grant of a European patent¹, any person may give notice to the European Patent Office² of opposition to the European patent granted³. The opposition applies to the European patent in all the contracting states⁴ in which the patent has effect⁵. Opposition may be filed on the following grounds only:

- 513 (1) that the subject matter of the European patent is not patentable within the meaning of the European Patent Convention⁶;
- 514 (2) that the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art⁷;
- 515 (3) that the subject matter of the European patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed by a person found to be entitled to the invention⁸, that the subject matter extends beyond the content of the earlier applications as filed⁹.

If the opposition is admissible, the Opposition Division of the European Patent Office must examine whether the grounds of opposition relied on prejudice the maintenance of the European patent¹⁰. If the Opposition Division is of the opinion that the grounds are so prejudicial, it must revoke the patent; otherwise, the opposition must be rejected¹¹. Provision is made for amendment of the patent in opposition proceedings and the Opposition Division may decide to maintain the patent in its amended form¹².

1 As to the meaning of 'European patent' see PARA 668 note 5.

2 As to the European Patent Office see PARA 668 note 2.

3 European Patent Convention art 99(1). The notice of opposition will not be deemed to have been filed until the opposition fee has been paid: art 99(1). As to the meaning of 'European Patent Convention' see PARA 668 note 1. As to the procedure on opposition see art 99 and the Implementing Regulations rr 75-89.

4 For the contracting states see PARA 668 note 1.

5 European Patent Convention art 99(2). As to the effect of a European patent see PARA 674.

6 European Patent Convention art 100(a). As to the criteria of patentability see PARA 671.

7 European Patent Convention art 100(b).

8 *Ie* in accordance with the European Patent Convention art 61.

9 European Patent Convention art 100(c).

10 See the European Patent Convention art 101(1). Jurisdiction under the Patents Act 1977 s 72 (revocation proceedings: see PARA 564) exceeds that exercised by an Opposition Division under the European Patent Convention art 100; and a decision of an Opposition Division is not a final judicial determination of the validity of a patent: *Buehler AG v Chronos Richardson Ltd* [1998] 2 All ER 960, [1998] RPC 609, CA.

11 European Patent Convention art 101(2).

12 European Patent Convention art 101(3).

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674. Effect of a European patent.

A European patent¹ confers on the proprietor from the date of publication of the mention of its grant, in each contracting state² in respect of which it is granted, the same rights as would be conferred by a national patent granted in that state³. Any infringement of a European patent is dealt with by national law⁴. An application for a European patent which has been accorded a date of filing⁵ is in each designated state⁶ equivalent to a regular national filing where appropriate with the priority claimed for the European patent application⁷. A European patent application confers on the applicant, from the date of its publication⁸, the same rights as would be conferred on him by a national patent application from the date of its publication⁹. The extent of protection conferred by a European patent or application for a European patent is determined by the terms of the claims, although the description and drawings must be used to interpret the claims¹⁰. In relation to infringement of a European patent and infringement of the rights conferred by publication, a European patent or application is regarded as void ab initio to the extent that the patent is revoked in opposition proceedings¹¹. Any contracting state may provide that, if the text of the European patent is not in one of its official languages¹², a translation into one of its official languages must be filed and that on failure to file such a translation the European patent may be deemed void ab initio in that state¹³.

1 As to the meaning of 'European patent' see PARA 668 note 5.

2 For the contracting states see PARA 668 note 1.

3 European Patent Convention art 64(1). Cf the Patents Act 1977 s 77; and PARA 675. As to the meaning of 'European Patent Convention' see PARA 668 note 1.

4 European Patent Convention art 64(3).

5 As to the date of filing of a European patent application see PARA 670.

6 As to the designation of states see PARA 670.

7 See the European Patent Convention art 66. Cf the Patents Act 1977 s 78(2), (3); and PARA 676.

8 As to publication of a European patent application see PARA 672.

9 See the European Patent Convention art 67(1), (2). Such rights are deemed never to have existed if the application is withdrawn, deemed to be withdrawn or refused or, in respect of a particular state, if the designation of that state is withdrawn or deemed to have been withdrawn: art 67(4). Cf the Patents Act 1977 ss 69, 78(7); and PARA 676.

10 European Patent Convention art 69(1). See also the Protocol on the interpretation of art 69.

11 See the European Patent Convention art 68. As to opposition see PARA 673.

12 The official languages of the European Patent Office are English, French and German: European Patent Convention art 14(1). All applications for European patents must be filed in one of these languages: art 14(1). As to the European Patent Office see PARA 668 note 2. See Case C-44/98 *BASF AG v Präsident des Deutschen Patentamts* [1999] ECR I-6269, [2001] 2 CMLR 435, (1999) Times, 12 October, ECJ.

13 See the European Patent Convention art 65.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/11. INTERNATIONAL CONVENTIONS/(3) THE EUROPEAN PATENT CONVENTION/(ii) Incorporation of the European Patent Convention into the British Patent System/675. Internal effect of a European patent (UK).

(ii) Incorporation of the European Patent Convention into the British Patent System

675. Internal effect of a European patent (UK).

A European patent (UK)¹ is treated², as from the date of publication of the mention of its grant in the European Patent Bulletin³, as if it were a patent under the Patents Act 1977 granted in pursuance of an application made under that Act, and as if notice of the grant of the patent had, on the date of that publication, been published⁴ in the Official Journal (Patents)⁵.

Accordingly, the proprietor of a European patent (UK) then has, as respects the United Kingdom, the same rights and remedies, subject to the same conditions, as the proprietor of a patent under the Patents Act 1977⁶; and any statement made and any certificate filed under the European Patent Convention in respect of non-prejudicial disclosures⁷ are respectively treated as a statement made and written evidence filed for the purposes of the corresponding provision⁸ of the Patents Act 1977⁹.

The above provisions¹⁰ do not, however affect the operation in relation to a European patent (UK) of any provision of the European Patent Convention relating to the amendment or revocation of such a patent in proceedings before the European Patent Office¹¹.

Where in the case of a European patent (UK) proceedings for infringement¹² or under the Crown use provisions¹³ have been commenced before the court¹⁴ or the comptroller¹⁵ and have not been finally disposed of and it is established in proceedings before the European Patent Office¹⁶ that the patent is only partially valid, the provisions relating to the relief to be afforded in respect of partially valid patents¹⁷ apply as they apply to proceedings in which the validity of a patent is put in issue and in which it is found that the patent is only partially valid¹⁸.

Where a European patent (UK) has been amended in accordance with the European Patent Convention, the amendment has effect¹⁹ as if the specification of the patent had been amended under the Patents Act 1977²⁰.

Where a European patent (UK) is revoked in accordance with the provisions of the European Patent Convention, it is treated²¹ as having been revoked under the Patents Act 1977²².

Where under the European Patent Convention a European patent (UK) is revoked for failure to observe a time limit and is subsequently restored or is revoked by the Board of Appeal and is subsequently restored by the Enlarged Board of Appeal, and between the revocation and publication of the fact that it has been restored a person begins in good faith to do an act which would constitute²³ an infringement of the patent or makes in good faith effective and serious preparations to do such an act, he has the right²⁴ to continue to do the act or, as the case may be, to do the act²⁵.

1 For these purposes, 'European patent (UK)' means a European patent designating the United Kingdom: Patents Act 1977 s 130(1). As to the meaning of 'European patent' see PARA 668 note 5. As to the meaning of 'United Kingdom' see PARA 303 note 5.

2 Ie for the purposes of the Patents Act 1977 Pt I (ss 1-76: new domestic law), and Pt III (ss 97-132: miscellaneous and general provisions).

3 le under the European Patent Convention art 97. As to the meaning of 'European Patent Convention' see PARA 668 note 1. 'European Patent Bulletin' means the bulletin of that name published under the European Patent Convention: Patents Act 1977 s 130(1).

4 le under the Patents Act 1977 s 24: see PARA 338.

5 Patents Act 1977 s 77(1). References in Pts I, III to a patent are to be construed accordingly: s 77(1)(b). As to the Journal see PARA 580.

6 Patents Act 1977 s 77(1)(a).

7 le under the European Patent Convention art 55(1)(b), (2).

8 le the Patents Act 1977 s 2(4)(c): see PARA 436.

9 Patents Act 1977 s 77(1)(c).

10 le the Patents Act 1977 s 77(1): see the text to notes 1-9.

11 Patents Act 1977 s 77(2). As to the meaning of 'European Patent Office' see PARA 668 note 2. As to the application of the Patents Act 1997 s 77(2) to the situation where there are concurrent proceedings pending before the national court and the European Patent Office see *Beloit Technologies Inc v Valmet Paper Machinery Inc* [1997] RPC 489, CA.

The requirement that a translation into English of the specification of a European patent (UK) published in French or German be filed at the UK Intellectual Property Office no longer applies as from 1 May 2008, the date on which the Agreement on the application of Article 65 of the Convention on the Grant of European Patents made in London on 17 October 2000 (the 'London Agreement') (Misc 9 (2001); Cm 5247) came into force: see the Patents Act 1977 s 77(9); Patents Rules 2007, SI 2007/3291, r 56(9), (10). As to translations in proceedings relating to a European patent (UK) see rr 114, 115. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

12 le under the Patents Act 1977 ss 61-69: see PARA 500 et seq.

13 le under the Patents Act 1977 s 58: see PARA 410.

14 As to the meaning of 'court' see PARA 637 note 1. It is within the court's discretion to stay proceedings pending determination of validity by the European Patent Office: *Amersham International plc v Corning Ltd* [1987] RPC 53; *Pall Corp v Commercial Hydraulics (Bedford) Ltd* [1989] RPC 703 at 709, CA; *Biogen Inc v Medeva plc* [1993] RPC 475; *Unilin Beheer BV v Berry Floor NV* [2007] EWCA Civ 364, [2008] 1 All ER 156, [2008] FSR 635; *Glaxo Group Ltd v Genentech Inc* [2008] EWCA Civ 23, [2008] All ER (D) 282 (Jan), [2008] FSR 549.

15 As to the comptroller see PARA 577.

16 le opposition proceedings under the European Patent Convention art 100: see PARA 673.

17 le the provisions of the Patents Act 1977 s 63 (see PARA 552) or, as the case may be, s 58(7)-(9) (see PARA 410).

18 Patents Act 1977 s 77(3) (substituted by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 21(1), (2)).

19 See note 2.

20 Patents Act 1977 s 77(4) (substituted by the Copyright, Designs and Patents Act 1988 Sch 5 para 21(1), (3)). The requirement that a translation into English of the specification as amended be filed was repealed as from 1 May 2008, the date the London Agreement came into force: see note 11.

21 See note 2.

22 Patents Act 1977 s 77(4A) (added by the Copyright, Designs and Patents Act 1988 Sch 5 para 21(1), (3)). The wording of the Patents Act 1977 s 77(4A) does not enable the court to question the propriety of the action of the European Patent Office Board of Appeal: *Lenzing AG's European Patent (UK)* [1997] RPC 245. See also *ITP SA v Coflexip Stena Offshore Ltd* 2004 SLT 1285, IH (domestic appeal proceedings would not be stayed pending outcome of appeal to European Court of Human Rights against decision of the European Patent Office Board of Appeal to revoke patent); *Unilin Beheer BV v Berry Floor NV* [2007] EWCA Civ 364, [2008] 1 All ER 156, [2008] FSR 635; *Glaxo Group Ltd v Genentech Inc* [2008] EWCA Civ 23, [2008] All ER (D) 282 (Jan), [2008] FSR 549. See *Actavis UK Ltd v Merck & Co Inc* [2008] EWCA Civ 444, [2008] All ER (D) 290 (May) (Court of Appeal free to

depart from the ratio decidendi of its own earlier decision if it was satisfied that the European Patent Office Boards of Appeal had formed a settled view of European patent law which was inconsistent with that earlier decision).

23 le apart from the Patents Act 1977 s 55: see PARAS 405-406.

24 le the rights conferred by the Patents Act 1977 s 28A(4), (5): see PARA 358.

25 Patents Act 1977 s 77(5) (amended by the Copyright, Designs and Patents Act 1988 Sch 5 para 8(b); and the Patents Act 2004 s 5, Sch 1 paras 1, 2). The Patents Act 1977 s 28A(6), (7) applies accordingly: s 77(5) (as so amended).

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676. Internal effect of an application for a European patent (UK).

An application for a European patent (UK)¹ having a date of filing under the European Patent Convention² is treated as an application for a patent under the Patents Act 1977, having that date as its date of filing, for the following purposes³:

- 516 (1) co-pending applications which may comprise part of the state of the art for the purposes of novelty⁴;
- 517 (2) establishing priority⁵;
- 518 (3) inventors' certificates⁶;
- 519 (4) transactions in applications for patents⁷;
- 520 (5) registration⁸;
- 521 (6) co-ownership of applications⁹;
- 522 (7) Crown use¹⁰;
- 523 (8) infringement of rights conferred by publication¹¹;
- 524 (9) putting validity in issue¹²;
- 525 (10) unauthorised claim of application for a patent¹³; and
- 526 (11) extent of protection conferred by an application¹⁴.

An application for a European patent (UK) which is so treated as an application for a patent under the Patents Act 1977 has the following further incidents:

- 527 (a) any declaration of priority made in connection with an application under the European Patent Convention¹⁵ is treated as a declaration made¹⁶ under the Patents Act 1977¹⁷;
- 528 (b) where a period of time relevant to priority is extended under the convention, the 12-month priority period specified in the Patents Act 1977¹⁸ is treated as altered correspondingly¹⁹;
- 529 (c) where the date of filing an application is redated under the convention to a later date, that date is treated as the date of filing the application²⁰;
- 530 (d) if the application is published in accordance with the convention²¹, it is treated²² as having been published²³ under the Patents Act 1977²⁴;
- 531 (e) any designation of the inventor under the convention²⁵ or any statement under the convention²⁶ indicating the origin of the right to a European patent is treated as having been filed under the corresponding provision²⁷ of the Patents Act 1977²⁸;
- 532 (f) registration of the application in the register of European patents²⁹ is treated as registration under the Patents Act 1977³⁰.

The above provisions³¹ cease to apply³² to an application for a European patent (UK) if: (i) the application is refused, withdrawn or deemed to be withdrawn; or (ii) the designation of the United Kingdom in the application is withdrawn³³ or deemed to be withdrawn, but apply again if the rights of the applicant are re-established under the European Patent Convention as from their re-establishment³⁴. Where between the above provisions ceasing to apply to any such application and the re-establishment³⁵ of the rights of the applicant a person begins in good faith to do an act which would constitute³⁶ an infringement of rights conferred by publication of

the application if the above provisions then applied, or makes in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the above provisions applying again and notwithstanding the grant of the patent³⁷.

An application for a European patent (UK) published by the European Patent Office under the European Patent Convention in French or German is treated as published³⁸ for the purposes of the provisions of the Patents Act 1977 relating to Crown use³⁹ and infringement of rights conferred by an application⁴⁰ when a translation into English of the claims of the specification of the application has been filed and published by the UK Intellectual Property Office and the prescribed fee has been paid⁴¹.

1 As to the meaning of 'European patent (UK)' see PARA 675 note 1.

2 Ie under the European Patent Convention art 80: see PARA 670. As to the meaning of 'European Patent Convention' see PARA 668 note 1.

3 Patents Act 1977 s 78(1), (2). Rules under s 32 (see PARA 585) may not impose any requirements as to the registration of applications for European patents (UK) but may provide for the registration of copies of entries relating to such applications in the European register of patents: s 78(4). As to the operation of the Patents Act 1977 s 78 in relation to international applications for a patent (UK) see s 79.

4 Ie the Patents Act 1977 s 2(3) (see PARA 435) and so much of s 14(7) (see PARA 326) as relates to s 2(3).

5 Ie the Patents Act 1977 ss 5, 6: see PARAS 311-313.

6 Ie so much of the Patents Act 1977 s 13(3) as relates to an application for an issue of a certificate under s 13(3): see PARA 308.

7 Ie the Patents Act 1977 s 30: see PARAS 373-374, 378.

8 Ie the Patents Act 1977 ss 32, 33: see PARA 585 et seq.

9 Ie the Patents Act 1977 s 36: see PARA 372.

10 Ie the Patents Act 1977 ss 55-59: see PARA 405 et seq.

11 Ie the Patents Act 1977 ss 60-69: see PARA 512 et seq.

12 Ie the Patents Act 1977 s 74: see PARA 520.

13 Ie the Patents Act 1977 s 111: see PARA 610.

14 Ie the Patents Act 1977 s 125: see PARA 301.

15 Ie under the European Patent Convention arts 87-89: see PARA 670.

16 Ie under the Patents Act 1977 s 5(2): see PARA 311.

17 Patents Act 1977 s 78(3)(a).

18 Ie the period allowed under the Patents Act 1977 s 5(2A)(a): see PARA 311.

19 Patents Act 1977 s 78(3)(b) (amended by SI 2004/2357).

20 Patents Act 1977 s 78(3)(c).

21 Ie in accordance with the European Patent Convention art 98: see PARA 672.

22 Ie subject to the Patents Act 1977 s 78(6) (see the text to notes 35-37) and s 79 (see note 3).

23 Ie under the Patents Act 1977 s 16: see PARA 327.

24 Patents Act 1977 s 78(3)(d).

- 25 Ie under the European Patent Convention art 62.
- 26 Ie under the European Patent Convention art 60.
- 27 Ie the Patents Act 1977 s 13(2): see PARA 308.
- 28 Patents Act 1977 s 78(3)(e).
- 29 See the European Patent Convention art 127.
- 30 Patents Act 1977 s 78(3)(f). As to registration see PARA 585 et seq.
- 31 Ie the Patents Act 1977 ss 78(1)-(3).
- 32 Ie subject to the Patents Act 1977 s 78(5A). The occurrence of any of the events mentioned in s 78(5)(a) or (b) does not affect the continued operation of s 2(3) (see PARA 435) in relation to matter contained in an application for a European patent (UK) which by virtue of s 2(3) has become part of the state of the art as regards other inventions; and the occurrence of any event mentioned in s 78(5)(b) (see head (ii) in the text) does not prevent matter contained in an application for a European patent (UK) becoming part of the state of the art by virtue of s 2(3) as regards other inventions where the event occurs before the publication of that application: s 78(5A) (added by the Copyright, Designs and Patents Act 1988 s 295, Sch 5 para 22; and amended by the Patents Act 2004 s 5, Sch 1 paras 1, 3(1), (2)).
- 33 As to designation see PARA 670.
- 34 Patents Act 1977 s 78(5) (substituted by the Copyright, Designs and Patents Act 1988 Sch 5 para 22).
- 35 Ie under the European Patent Convention art 122.
- 36 The provisions of the Patents Act 1977 s 78(6)-(6B) apply in relation to the use of a patented invention for the services of the Crown (see PARAS 405-406) as they apply in relation to an infringement of the rights conferred by publication of the application (or, as the case may be, infringement of the patent): s 78(6C) (s 78(6) substituted, and s 78(6A)-(6C) added, by the Patents Act 2004 Sch 1 paras 1, 3(1), (3)). 'Patented invention' has the same meaning as in the Patents Act 1977 s 55 (see PARA 405).
- 37 Patents Act 1977 s 78(6) (as substituted: see note 36). The provisions of s 20B(5), (6) (see PARA 334) have effect for the purposes of s 78(6) as they have effect for the purposes of s 20B and as if the references to s 20B(4) were references to s 78(6): s 78(6A) (as added: see note 36). Subject to s 78(6A), the right conferred by s 78(6) does not extend to granting a licence to another person to do the act in question: s 78(6B) (as added: see note 36).
- 38 Ie under the Patents Act 1977 s 16: see PARA 327.
- 39 Ie the Patents Act 1977 s 55: see PARA 405.
- 40 Ie the Patents Act 1977 s 69: see PARAS 548-549.
- 41 Patents Act 1977 s 78(7), (8). An applicant may: (1) recover a payment by virtue of s 55(5) (see PARA 406) in respect of the use of the invention in question before publication of that translation; or (2) bring proceedings by virtue of s 69 in respect of an act mentioned in s 69 which is done before publication of that translation, if before that use or the doing of that act he has sent by or delivered to the government department which made use or authorised the use of the invention or, as the case may be, to the person alleged to have done the act, a translation into English of those claims: s 78(7). A translation into English of the claims of the specification of the application for a European patent (UK), which is filed under s 78(7) must be accompanied by Patents Form 54: Patents Rules 2007, SI 2007/3291, r 56(1)(b). The translation must comply with the formal requirements set out in Sch 2 Pts 1-3 (see PARAS 315, 320) except where a translation is delivered in electronic form or using electronic communications: r 56(2), (4). The translation and Patents Form 54 must be filed in duplicate: r 56(3). At the date at which this volume states the law, no fee is payable on filing a translation in accordance with r 56: see the Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

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677. Authentic text of European patents and applications.

The text of a European patent¹ or application for such a patent in the language of the proceedings, that is to say, the language in which proceedings relating to the patent or the application are to be conducted before the European Patent Office², is authentic text for the purposes of any domestic proceedings, that is to say, any proceedings relating to the patent or application before the comptroller³ or the court⁴.

Where the language of the proceedings is French or German, a translation into English of the claims of the application⁵ or, in the case of European patent (UK) granted before 1 February 2008, a translation into English of the specification of the patent⁶, is treated as the authentic text for the purpose of any domestic proceedings, other than proceedings for the revocation of the patent, if the patent or application as translated into English confers protection which is narrower than that conferred by it in French or German⁷.

If any such translation results in a European patent or application conferring the narrower protection, the proprietor of or applicant for the patent may file a corrected translation with the UK Intellectual Property Office⁸ and, if he pays the prescribed fee⁹ within the period of 14 days beginning with the day the corrected translation is filed, the UK Intellectual Property Office must publish it¹⁰.

However:

- 533 (1) any payment for any use of the invention which apart from the provisions relating to Crown use¹¹ would have infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have so infringed it if the patent had been granted, is not recoverable under those provisions; and
- 534 (2) the proprietor or applicant is not entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not as originally translated, or in the case of an application would have so infringed it if the patent had been granted,

unless before that use or the doing of the act the corrected translation has been published by the UK Intellectual Property Office or the proprietor or applicant has sent the corrected translation by or delivered it to the government department which made use or authorised the use of the invention or, as the case may be, to the person alleged to have done that act¹².

Where a correction of a translation is published¹³ and, before it is so published, a person begins in good faith to do an act which would not constitute an infringement of the patent as originally translated, or of the rights conferred by publication of the application as originally translated, but would do so under the amended translation, or makes in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the publication of the corrected translation and notwithstanding the grant of the patent¹⁴.

1 As to the meaning of 'European patent' see PARA 668 note 5.

2 As to the European Patent Office see PARA 668 note 2.

3 As to the comptroller see PARA 577.

4 Patents Act 1977 s 80(1). As to the meaning of 'court' see PARA 637 note 1. See *Siemens Schweiz AG v Thorne Security Ltd* [2007] EWHC 2242 (Ch), [2008] RPC 58, [2007] All ER (D) 61 (Oct).

5 Ie under the Patents Act 1977 s 78: see PARA 676.

6 Ie under the Patents Act 1977 s 77(6): see PARA 675. This provision has been repealed with effect from 1 May 2008, the date on which the London Agreement came into force: see the Patents Rules 2007, SI 2007/3291, r 56(10). There are no transitional provisions so that translations need not be filed in respect of European patents (UK) granted on or after 1 February 2008.

7 Patents Act 1977 s 80(2).

8 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

9 At the date at which this volume states the law, no fee is payable on filing a corrected translation under the Patents Act 1977 s 80(3): see the Patents (Fees) Rules 2007, SI 2007/3292, r 2, Sch 1.

10 Patents Act 1977 s 80(3); Patents Rules 2007, SI 2007/3291, r 57(6). A corrected translation filed under the Patents Act 1977 s 80(3) must be accompanied by Patents Form 54: Patents Rules 2007, SI 2007/3291, r 57(1). The corrected translation must comply with the formal requirements set out in Sch 2 Pts 1-3 (see PARAS 315, 320): r 57(2). Where the corrected translation includes any drawings, all annotations in French or German must be replaced with annotations in English: r 57(3). The corrected translation and Patents Form 54 must be filed in duplicate except where a translation is delivered in electronic form or using electronic communications: r 57(4), (5).

11 Ie the Patents Act 1977 s 55: see PARAS 405-406.

12 Patents Act 1977 s 80(3).

13 Ie under the Patents Act 1977 s 80(3): see the text and notes 8-12.

14 Patents Act 1977 s 80(4) (s 80(4) substituted, and s 80(5)-(7) added, by the Patents Act 2004 s 5, Sch 1 paras 1, 4). The provisions of the Patents Act 1977 s 28A(5), (6) (see PARA 358) have effect for the purposes of s 80(4) as they have effect for the purposes of s 28A and as if the references to s 28A(4) were references to s 80(4), and the reference to the registered proprietor of the patent included a reference to the applicant: s 80(5) (as so added). Subject to s 80(5), the right conferred by s 80(4) does not extend to granting a licence to another person to do the act in question: s 80(6) (as so added). The provisions of s 80(4)-(6) apply in relation to the use of a patented invention for the services of the Crown as they apply in relation to an infringement of the patent or of the rights conferred by the publication of the application; and 'patented invention' has the same meaning as in s 55 (see PARA 405): s 80(7) (as so added).

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678. Conversion of European patent applications.

The comptroller¹ may direct that, on compliance with the relevant conditions, an application for a European patent (UK)² is to be treated as an application under the Patents Act 1977 where the application is deemed to be withdrawn under the provisions of the European Patent Convention³ relating to the time for forwarding applications to the European Patent Office⁴.

The relevant conditions are:

- 535 (1) that the applicant requests⁵ the comptroller within the relevant prescribed period⁶ (where the application was filed with the UK Intellectual Property Office⁷) to give a direction under these provisions⁸, or the central industrial property office of a country which is party to the convention, other than the United Kingdom⁹, with which the application was filed transmits within the relevant prescribed period¹⁰ a request that the application should be converted into an application under the Patents Act 1977, together with a copy of the application¹¹; and
- 536 (2) that the applicant within the relevant prescribed period pays the application fee and, if the application is in a language other than English, files a translation into English of the application and of any amendments previously made in accordance with the convention¹².

Where an application for a European patent falls to be treated as an application for a patent under the Patents Act 1977 by virtue of a direction given by the comptroller under these provisions, then:

- 537 (a) the date which is the date of filing the application under the European Patent Convention is treated as its date of filing for the purposes of the Patents Act 1977, but, if that date is redated under the convention to a later date, that later date is to be treated for those purposes as the date of filing the application¹³;
- 538 (b) if the application satisfies a requirement of the convention corresponding to any of the requirements of the Patents Act 1977 or rules designated as formal requirements¹⁴, it is to be treated as satisfying that formal requirement¹⁵;
- 539 (c) any document filed with the European Patent Office under any provision of the convention corresponding to certain provisions of the Patents Act 1977¹⁶, or any rule made for the purposes of any of those provisions, is to be treated as filed with the UK Intellectual Property Office under that provision or rule¹⁷; and
- 540 (d) the comptroller will refer the application for only so much of the examination¹⁸ and search¹⁹ required as he considers appropriate in view of any examination and search carried out under the convention²⁰.

1 As to the comptroller see PARA 577.

2 As to the meaning of 'European patent (UK)' see PARA 675 note 1.

3 As to the meaning of 'European Patent Convention' see PARA 668 note 1.

4 Patents Act 1977 s 81(1) (amended by the Patents Act 2004 s 5, Sch 1 paras 1, 5(1), (2)). See the European Patent Convention art 77.

5 A request under the Patents Act 1977 s 81(2)(b)(i) must be made in writing and accompanied by a copy of the notification by the European Patent Office that the application has been deemed to be withdrawn: Patents Rules 2007, SI 2007/3291, r 58(1). When making such a request, a person may also request the comptroller to send a copy of his application for a European patent (UK) and a copy of the request to the central industrial property office of any contracting state designated in the application: r 58(2). 'Contracting state' means a country which is a party to the European Patent Convention: Patents Rules 2007, SI 2007/3291, r 58(5). As to the parties to the convention see PARA 668 note 1. Where a request has been made under the Patents Act 1977 s 81(2)(b)(i), the period prescribed for the purposes of s 13(2) (see PARA 308), s 15(10)(d) (see PARA 316) and s 81(2)(c) is two months beginning with the date on which the comptroller received that request: Patents Rules 2007, SI 2007/3291, r 58(4).

6 The period prescribed for the purposes of the Patents Act 1977 s 81(2)(b)(i) is three months beginning with the date of notification by the European Patent Office that the application has been deemed to be withdrawn: Patents Rules 2007, SI 2007/3291, r 58(3). The prescribed time limit may not be extended: see PARA 599.

7 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

8 Patents Act 1977 s 81(2)(b)(i) (amended by the Patents Act 2004 Sch 1 paras 1, 5(1), (3)).

9 As to the meaning of 'United Kingdom' see PARA 303 note 5.

10 The period prescribed for the purposes of the Patents Act 1977 s 81(2)(b)(ii) is 20 months beginning with: (1) where there is no declared priority date, the date of filing of the application; or (2) where there is a declared priority date, that date: Patents Rules 2007, SI 2007/3291, r 59(1). The prescribed time limit may not be extended: see PARA 599. Where a request, transmitted under the Patents Act 1977 s 81(2)(b)(ii), has been received by the comptroller, he must notify the applicant accordingly: Patents Rules 2007, SI 2007/3291, r 59(2). Where a request has been transmitted under the Patents Act 1977 s 81(2)(b)(ii), the period prescribed for the purposes of s 13(2) (see PARA 308), s 15(10)(d) (see PARA 316) and s 81(2)(c) is four months beginning with the date of that notification: Patents Rules 2007, SI 2007/3291, r 59(3). As to the extension of time limits see para 599. As to priority dates and the date of filing under the European Patent Convention see PARA 670.

11 Patents Act 1977 s 81(2)(b)(ii).

12 Patents Act 1977 s 81(2)(c) (amended by the Patents Act 2004 Sch 1 paras 1, 5(1), (3)).

13 Patents Act 1977 s 81(3)(a). Where an application for a European patent (UK) falls to be treated as an application for a patent under the Patents Act 1977 by virtue of a direction under s 81, the period prescribed for the purposes of s 18(1) (see PARA 329) is two years beginning with: (1) where there is no declared priority date, the date of filing of the application; or (2) where there is a declared priority date, that date: Patents Rules 2007, SI 2007/3291, r 60. As to the extension of time limits see para 599.

14 As to the meaning of 'formal requirements' see PARA 328.

15 Patents Act 1977 s 81(3)(b).

16 Ie the Patents Act 1977 s 2(4)(c) (see PARA 436), s 5 (see PARA 311), s 13(2) (see PARA 308), s 14 (see PARA 315).

17 Patents Act 1977 s 81(3)(c).

18 Ie under the Patents Act 1977 s 15A (see PARA 318) and s 17 (see PARA 328).

19 Ie under the Patents Act 1977 s 18: see PARA 329.

20 Patents Act 1977 s 81(3)(d) (amended by SI 2004/2357). The Patents Act 1977 ss 15A, 17, 18 apply with any necessary modifications: s 81(3)(d).

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(4) THE COMMUNITY PATENT CONVENTION

679. The Community patent system.

Under the Community Patent Convention of the European Community¹ unitary patents will be issued, ultimately superseding the separate patents of national systems and of the European Patent Convention². Despite there being agreement on the need for a Community patent³, finalising the terms has proved difficult.

1 Convention for the European Patent for the Common Market (Luxembourg, 15 December 1975; Cmnd 6553) (amended by the Agreement Relating to Community Patents (OJ L401, 30.12.89, p 1)). See also note 3.

References in the Patents Act 1977 to the Convention for the European Patent for the Common Market are references to that Convention or any international convention or agreement replacing it, as amended or supplemented by any convention or international agreement, including in either case any protocol or annex, or in accordance with the terms of any such convention or agreement, and include references to any instrument made under any such convention or agreement: Patents Act 1977 s 130(1), (6)(b).

2 As to the meaning of 'European Patent Convention' see PARA 668 note 1.

3 See eg Communication from the Commission to the European Parliament and the Council - *Enhancing the patent system in Europe* (Brussels, COM (2007) 29.3.07).

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(5) THE PATENT LAW TREATY

680. Requirements and procedures under the Patent Law Treaty.

The Patent Law Treaty¹ was concluded on 1 June 2000 and has the aim of harmonising and streamlining patent law in respect of the administrative procedures associated with filing and prosecuting a patent application². In particular, provision is made relating to:

- 541 (1) the accordance of filing dates to applications³;
- 542 (2) the formal requirements for national and regional applications⁴;
- 543 (3) representation and communications⁵;
- 544 (4) validity of patents and revocation⁶;
- 545 (5) relief in respect of time limits⁷;
- 546 (6) the reinstatement of rights after a finding of due care or unintentionality by the patent authority⁸; and
- 547 (7) the correction or addition of priority claims and the restoration of priority rights⁹.

1 The Patent Law Treaty (Geneva, 1 June 2000; TS 6 (2006); Cm 6779). The United Kingdom instrument of ratification was deposited on 22 December 2005 and the treaty entered into force for the United Kingdom on 22 March 2006. The Patent Law Treaty is open to states members of the World Intellectual Property Organisation or states parties to the Paris Convention for the Protection of Industrial Property (see PARA 652 note 5). At the date at which this volume states the law, the following countries have ratified the Patent Law Treaty: Bahrain, Croatia, Denmark, Estonia, Finland, Hungary, Kyrgyzstan, Moldova, Nigeria, Oman, Romania, Slovakia, Slovenia, Sweden, Switzerland, Ukraine, United Kingdom, Uzbekistan.

2 On 1 January 2005, United Kingdom patent law was significantly deregulated by the Regulatory Reform (Patents) Order 2004, SI 2004/2357 (which amended the Patents Act 1977), and the accompanying Patents (Amendment) Rules 2004, SI 2004/2358 (revoked). As a result, the law already met or exceeded the standards laid down in the Patent Law Treaty, so no further legislative changes arose from the ratification of the treaty.

3 See the Patent Law Treaty art 5.

4 See the Patent Law Treaty art 6.

5 See the Patent Law Treaty arts 7-9.

6 See the Patent Law Treaty art 10.

7 See the Patent Law Treaty art 11.

8 See the Patent Law Treaty art 12.

9 See the Patent Law Treaty art 13.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(i) Legislation/681. Legislation relating to registered designs.

12. REGISTERED DESIGNS

(1) LEGISLATION AND ADMINISTRATION

(i) Legislation

681. Legislation relating to registered designs.

The current legislation relating to registered designs¹ is contained in the Registered Designs Act 1949², which consolidated most of the previous registered designs legislation³. The 1949 Act was itself substantially amended by the Copyright, Designs and Patents Act 1988⁴ with effect from 1 August 1989⁵. Some of the amendments affect only the registration of designs application for which was made on or after 1 August 1989. In respect of applications for registration made on or after that date the criteria for registrability are those contained in the substituted provisions of the Registered Designs Act 1949⁶. Applications for registration made before that date were required to satisfy the criteria for registrability contained in the Registered Designs Act 1949 as originally enacted⁷. All such applications which satisfied the old criteria have now matured into granted designs and therefore the regime for obtaining registration under the original Registered Designs Act 1949 is not set out in this work.

The 1949 Act was amended extensively again in 2001 by the Registered Designs Regulations⁸ which effected the changes necessary in order to comply with the European Directive on the legal protection of designs⁹. The treatment of current designs is therefore now covered by this legislation.

The term 'old design' is used in this title to denote designs granted pursuant to the Registered Designs Act 1949 as amended by the Copyright, Designs and Patents Act 1988; whilst the term 'current design' is used to denote designs granted pursuant to the Registered Designs Act 1949 after its amendment by the Registered Designs Regulations 2001. Where the term 'design' is used simpliciter, the Registered Designs Act 1949 as amended applies equally to both old and current designs.

A unified system for obtaining a community design to which uniform protection is given with uniform effect throughout the entire territory of the Community was set up in 2002¹⁰.

The UK Intellectual Property Office¹¹ procedure relating to registered designs is governed by rules made under the Registered Designs Act 1949¹². Certain matters relating to registered designs are regulated by other statutes¹³ and by rules of court¹⁴. The registered design legislation does not cover the parallel rights in artistic works¹⁵.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs). A product whose novelty resides in its design and not in its function may be protected as a registered design, as such a product is not patentable: see PARA 431.

2 The Registered Designs Act 1949 came into force on 1 January 1950: s 49(2). Its transitional provisions (ie s 48), although still in force, are for practical purposes spent.

3 Ie the Patents and Designs Act 1907 which replaced the Patents, Designs and Trade Marks Act 1883. Earlier statutes of importance in relation to designs included 5 & 6 Vict c 100 (Copyright of Designs) (1842); 6 & 7 Vict c 65 (Copyright of Designs) (1843); and the Copyright of Designs Act 1875 (all repealed).

4 le by the Copyright, Designs and Patents Act 1988 Pt IV (ss 265-273), s 303(2), Schs 3, 8. The text of the Registered Designs Act 1949 in its amended form is set out in the Copyright, Designs and Patents Act 1988 Sch 4.

5 le the commencement date of the Copyright, Designs and Patents Act 1988 Pt IV.

6 le the criteria set out in the Registered Designs Act 1949 s 1 (as substituted by the Copyright, Designs and Patents Act 1988); see PARA 740.

7 le the criteria set out in the Registered Designs Act 1949 s 1 (as originally enacted).

8 le the Registered Designs Regulations 2001, SI 2001/3949. Further amendments were made by the Registered Designs Regulations 2003, SI 2003/550.

9 le the EC Directive 98/71 of 13 October 1998 on the legal protection of designs (OJ L289, 28.10.1998, p 28) which provides for harmonisation in the European Community of the matters of registered design protection which most closely affect the functioning of the internal market. See *Oakley Inc v Animal Ltd* [2005] EWCA Civ 1191, [2006] Ch 337, [2006] RPC 301.

10 See EC Council Regulation 6/2002 of 13 December 2001 on Community Designs (OJ L3, 5.1.2002, p 1).

11 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

12 See the Registered Designs Act 1949 s 36; the Registered Designs Rules 2006, SI 2006/1975; and PARA 684.

13 Eg the Crown Proceedings Act 1947 s 3 (proceedings against the Crown for infringement: see PARA 771); and the Copyright, Designs and Patents Act 1988 Sch 1 paras 19, 20 (limitation of period of protection of artistic works which are registrable as designs: see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARAS 204, 379).

14 See CPR Pt 63; *Practice Direction--Patents and Other Intellectual Property Claims* PD 63. As to the constitution and special jurisdiction of the patents county court see PARA 644 et seq.

15 As to the concurrent existence of artistic copyright and design copyright see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 74.

UPDATE

681 Legislation relating to registered designs

NOTE 14--CPR Pt 63 substituted: SI 2009/2092.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(i) Legislation/682. Legislation relating to old designs.

682. Legislation relating to old designs.

The cancellation and invalidation of 'old designs', that is those designs resulting from an application made on or after 1 August 1989 and before 9 December 2001¹, remain governed by the Registered Designs Act 1949 as it had effect immediately before its amendment by the Registered Designs Regulations². In relation to ownership, assignment, compulsory licensing and infringement, the amendments made by those Regulations apply with some modification to old designs as well as current designs³.

Any licence granted before 9 December 2001 which permits anything which would otherwise be an infringement under the Registered Designs Act 1949 of the right in a registered design or the copyright in a registered design, continues in force, with necessary modifications, on or after that date⁴.

1 See PARA 681.

2 I.e. the Registered Designs Regulations 2001, SI 2001/3949. See reg 12(1)-(3). As to the validity of old designs see PARAS 740-756; and as to the validity of current designs see PARAS 734-739.

3 See the Registered Designs Regulations 2001, SI 2001/3949, reg 12(4)-(9). For further transitional provisions see reg 14(3)-(13).

4 Registered Designs Regulations 2001, SI 2001/3949, reg 14(1). As to licences see PARA 724. In determining the effect of any such licence, regard must be had to the purpose for which the licence was granted; and, in particular, a licence granted for the full term or extent of the right in a registered design or the copyright in a registered design is to be treated as applying, subject to its other terms and conditions, to the full term or extent of that right as extended by virtue of the Registered Designs Regulations 2001, SI 2001/3949: reg 14(2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(i) Legislation/683. Territorial scope; convention countries.

683. Territorial scope; convention countries.

The Registered Designs Act 1949 has effect throughout the United Kingdom¹ and the Isle of Man, subject to modifications in its application to Scotland², Northern Ireland³ and the Isle of Man⁴. For the purposes of that Act, the territorial waters of the United Kingdom are treated as part of the United Kingdom⁵. The 1949 Act applies to things done in the United Kingdom sector of the continental shelf⁶ on a structure or vessel which is present there for purposes directly connected with the exploration of the sea bed or subsoil or the exploration of their natural resources as it applies to things done in the United Kingdom⁷.

With a view to the fulfilment of a treaty, convention⁸, arrangement or engagement, Her Majesty may by Order in Council declare that any country, including a British overseas territory, specified in the Order is a convention country for the purposes either of all, or of some only, of the provisions of the Registered Designs Act 1949⁹.

1 As to the meaning of 'United Kingdom' see PARA 303 note 5.

2 See the Registered Designs Act 1949 s 45 (substituted by SI 2006/1028).

3 See the Registered Designs Act 1949 s 46 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 33, Sch 8; SI 2006/1028).

4 See the Registered Designs Act 1949 s 47 (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 24); and the Registered Designs (Isle of Man) Order 2001, SI 2001/3678.

5 Registered Designs Act 1949 s 47A(1) (s 47 added by the Copyright, Designs and Patents Act 1988 Sch 3 para 35).

6 For these purposes, 'United Kingdom sector of the continental shelf' means the areas designated by order under the Continental Shelf Act 1964 s 1(7) (see **INTERNATIONAL RELATIONS LAW** vol 61 (2010) PARA 172): Registered Designs Act 1949 s 47A(3) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 35).

7 Registered Designs Act 1949 s 47A(2) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 35).

8 See the International Convention further revising the Paris Convention for the Protection of Industrial Property (which includes industrial designs) of 20 March 1883 (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431); and PARA 652.

9 See the Registered Designs Act 1949 s 13; British Overseas Territories Act 2002 s 1(2). The convention countries so declared for all the purposes of the Act are listed in the Designs (Convention Countries) Order 2007, SI 2007/277.

UPDATE

683 Territorial scope; convention countries

NOTE 9--SI 2007/277 amended: SI 2009/2747.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/684. The Secretary of State and the registrar.

(ii) Administration

684. The Secretary of State and the registrar.

The Department for Innovation, Universities and Skills is the department responsible for the UK Intellectual Property Office¹. The Secretary of State² may make such rules as he thinks expedient for regulating the business of the UK Intellectual Property Office in relation to designs³ and for regulating all matters placed by the Registered Designs Act 1949 under the direction or control of the registrar or the Secretary of State⁴. Rules may in particular make provision:

- 548 (1) prescribing the form of applications for registration of designs and of any representations or specimens of designs or other documents which may be filed at the UK Intellectual Property Office, and requiring copies to be furnished of any such representations, specimens or documents⁵;
- 549 (2) requiring applications for registration of designs to specify: (a) the products to which the designs are intended to be applied or in which they are intended to be incorporated; (b) the classification of the designs by reference to such test as may be prescribed⁶;
- 550 (3) regulating the procedure to be followed in connection with any application or request to the registrar or in connection with any proceeding before him, and authorising the rectification of irregularities of procedure⁷;
- 551 (4) providing for the appointment of advisers to assist the registrar in proceedings before him⁸;
- 552 (5) regulating the keeping of the register of designs⁹;
- 553 (6) authorising the publication and sale of copies of representations of designs and other documents in the UK Intellectual Property Office¹⁰;
- 554 (7) prescribing anything authorised or required by the Registered Designs Act 1949 to be prescribed by rules¹¹.

Any power to make rules so conferred is exercisable by statutory instrument; and any statutory instrument containing rules so made is subject to annulment in pursuance of a resolution of either House of Parliament¹².

The Secretary of State appoints and supervises the Comptroller General of Patents, Designs and Trade Marks¹³, who has immediate control of the UK Intellectual Property Office¹⁴ and is the registrar for the purposes of the Registered Designs Act 1949¹⁵. In his annual report with respect to the execution of the Patents Act 1977¹⁶ the comptroller must include a report with respect to the execution of the Registered Designs Act 1949 as if it formed part of or was included in the Patents Act 1977¹⁷.

1 See the Secretaries of State for Children, Schools and Families, for Innovation, Universities and Skills and for Business, Enterprise and Regulatory Reform Order 2007, SI 2007/3224. The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 As to the Secretary of State see PARA 575.

3 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

4 Registered Designs Act 1949 s 36(1) (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 26(1), (2)). In exercise of the power so conferred the Secretary of State has made the Registered Designs Rules 2006, SI 2006/1975.

5 Registered Designs Act 1949 s 36(1A)(a) (s 36(1A) added by the Copyright, Designs and Patents Act 1988 Sch 3 para 26(1), (3)).

6 Registered Designs Act 1949 s 36(1A)(ab) (s 36(1A) (as added: see note 5); s 36(1A)(ab) added by SI 2001/3949).

7 Registered Designs Act 1949 s 36(1A)(b) (s 36(1A) as added: see note 5).

8 Registered Designs Act 1949 s 36(1A)(c) (s 36(1A) as added: see note 5). The remuneration of an adviser appointed to assist the registrar is determined by the Secretary of State with the consent of the Treasury and must be defrayed out of money provided by Parliament: Registered Designs Act 1949 s 36(1B) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 26(1), (3)).

9 Registered Designs Act 1949 s 36(1A)(d) (s 36(1A) as added: see note 5). As to the register of designs see PARA 699 et seq.

10 Registered Designs Act 1949 s 36(1A)(e) (s 36(1A) as added: see note 5).

11 Registered Designs Act 1949 s 36(1A)(f) (s 36(1A) as added: see note 5). Rules made under the Registered Designs Act 1949 s 36 may provide for the establishment of branch offices for designs and may authorise any document or thing required by or under the Registered Designs Act 1949 to be filed or done at the UK Intellectual Property Office to be filed or done at the branch office at Manchester or any other branch office established in pursuance of the rules: s 36(2).

Rules made by the Secretary of State may specify the hour at which the UK Intellectual Property Office is deemed to be closed on any day for the purposes of the transaction of public business or of any class of such business and may specify days as excluded days for any such purposes: Registered Designs Act 1949 s 39 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 29). The Secretary of State also has power to make rules relating to evidence before the registrar (see the Registered Designs Act 1949 s 31; and PARA 685) and to make rules prescribing fees (see s 40; and PARA 686).

12 See the Registered Designs Act 1949 s 37 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 27(1), (3)). The Registered Designs Act 1949 s 37 is amended by the Tribunals, Courts and Enforcement Act 2007 Sch 23 Pt 6 as from a day to be appointed. At the date at which this volume states the law no such day had been appointed.

13 See the Patents and Designs Act 1907 s 63(1); and PARA 577. The Secretary of State may authorise any officer to act for the comptroller: see s 62(3); and PARA 577. As to the comptroller see PARA 577.

14 See the Patents and Designs Act 1907 s 62(2); and PARA 575 et seq.

15 Registered Designs Act 1949 s 44(1).

16 As to the report see PARA 578.

17 Registered Designs Act 1949 s 42 (amended by the Patents Act 1977 Sch 5 para 3).

UPDATE

684 The Secretary of State and the registrar

NOTE 4--SI 2006/1975 amended: SI 2009/546.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/685. Proceedings before the registrar.

685. Proceedings before the registrar.

The registrar¹ must give to any party to a proceeding before him an opportunity to be heard before exercising adversely to any party any discretion vested in him by or under the Registered Designs Act 1949².

The registrar may not give a person less than 14 days' notice of any hearing³. Hearings before the registrar of proceedings between two or more parties relating to an application for a registered design or a registered design, are held in public⁴. However, any party to the proceedings may apply to the registrar for the hearing to be held in private⁵. The registrar may only grant such an application if it is in the interests of justice for the hearing to be held in private, and where all the parties to the proceedings have had an opportunity to be heard on the matter⁶.

The registrar may give such directions as to the management of the proceedings as he thinks fit, and in particular he may (1) require a document, information or evidence to be filed; (2) require a translation of any document; (3) require a party or a party's legal representative to attend a hearing; (4) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication; (5) allow a statement of case to be amended; (6) stay the whole, or any part, of the proceedings either generally or until a specified date or event; (7) consolidate proceedings; (8) direct that part of any proceedings be dealt with as separate proceedings⁷. At any stage of proceedings before him, the registrar may direct that the parties to the proceedings attend a case management conference or pre-hearing review⁸. The registrar may control the evidence by giving directions as to (a) the issues on which he requires evidence; (b) the nature of the evidence which he requires to decide those issues; and (c) the way in which the evidence is to be placed before him⁹. He may use his power to exclude evidence which would otherwise be admissible¹⁰.

Evidence may be given by witness statement, statement of case, affidavit, statutory declaration, or in any other form which would be admissible as evidence in proceedings before the court¹¹. The registrar has the powers of a judge of the Technology and Construction Court as regards the attendance of witnesses and their examination on oath, and as to the discovery and production of documents, but he has no power to punish summarily for contempt¹². The rules applicable to the attendance of witnesses before such a referee apply in relation to the attendance of witnesses in proceedings before the registrar¹³.

The registrar may appoint an adviser to assist him and must settle the question or instructions to be submitted or given to such adviser¹⁴. Where the registrar thinks fit, he may rectify any irregularity of procedure after giving the parties such notice, and subject to such conditions, as he may direct¹⁵.

¹ As to the registrar see PARA 684.

² Registered Designs Act 1949 s 29 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 18); Registered Designs Rules 2006, SI 2006/1975, r 18.

³ Registered Designs Rules 2006, SI 2006/1975, r 25.

⁴ Registered Designs Rules 2006, SI 2006/1975, r 20(1).

5 Registered Designs Rules 2006, SI 2006/1975, r 20(2). Any hearing or part of a hearing of an application under r 20(2) must be held in private: r 20(4), (5).

6 Registered Designs Rules 2006, SI 2006/1975, r 20(3).

7 Registered Designs Rules 2006, SI 2006/1975, r 19(3). The registrar may extend or shorten (or further extend or shorten) any period which has been specified: r 19(1).

8 Registered Designs Rules 2006, SI 2006/1975, r 19(2).

9 Registered Designs Rules 2006, SI 2006/1975, r 19(4). When the registrar gives directions he may make them subject to conditions and may specify the consequences of failure to comply with the directions or a condition: r 19(5).

10 Registered Designs Rules 2006, SI 2006/1975, r 19(4).

11 Registered Designs Act 1949 s 31(a) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 20); Registered Designs Rules 2006, SI 2006/1975, r 21(1). The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise: r 21(3). A witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally: r 21(5). A witness statement or a statement of case may only be given in evidence if it includes a statement of truth: r 21(2). A statement of truth means a statement that the person making the statement believes that the facts stated in a particular document are true, and it must be dated and signed by (1) in the case of a witness statement, the maker of the statement; (2) in any other case, the party or his legal representative: r 21(4).

12 Registered Designs Act 1949 s 31(b) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 20); Registered Designs Rules 2006, SI 2006/1975, r 24. As to the Technology and Construction Court see **COURTS** vol 10 (Reissue) PARA 616.

13 Registered Designs Act 1949 s 31(c) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 20); Registered Designs Rules 2006, SI 2006/1975, r 21.

14 Registered Designs Rules 2006, SI 2006/1975, r 37.

15 Registered Designs Rules 2006, SI 2006/1975, r 38.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/686. Fees, notices and communications.

686. Fees, notices and communications.

There must be paid in respect of the registration of designs and applications therefor, and in respect of other matters relating to designs arising under the Registered Designs Act 1949, such fees as may be prescribed by rules made by the Secretary of State with the consent of the Treasury¹. Such fees must be collected in money².

Any notice required or authorised to be given by or under the Registered Designs Act 1949, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post³.

The registrar must extend any time or period where he is satisfied that the failure to do something was wholly or mainly attributed to a delay in, or failure of, a communication service (that is a service by which documents may be sent and delivered and includes post, electronic communications and courier)⁴.

1 Registered Designs Act 1949 s 40 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 30). In exercise of this power the Registered Designs Rules 2006, SI 2006/1975, were made. As to the Secretary of State see PARA 575.

2 See the Public Offices Fees (Patents, Designs and Trade Marks) Order 1964, SI 1964/45, art 1.

3 Registered Designs Act 1949 s 41.

4 Registered Designs Rules 2006, SI 2006/1975, r 41. As to the registrar see PARA 684. As to the use of electronic communications see PARA 688.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/687. Address for service.

687. Address for service.

For the purposes of any proceedings under the Registered Designs Act 1949, an address for service must be furnished by (1) an applicant for the registration of a design¹; (2) a person who makes an application for a declaration of invalidity of a registered design²; (3) the registered proprietor of the design who opposes such an application³. The proprietor of a registered design, or any person who has registered any interest in a registered design, may furnish an address for service on the prescribed form⁴. Where a person has furnished an address for service he may substitute a new address for service by notifying the registrar⁵.

Where a person has failed to furnish an address for service and the registrar has sufficient information enabling him to contact that person, the registrar must direct that person to furnish an address for service⁶. Where such a direction has been given, the person must furnish an address for service within two months of the date of the direction⁷. Where such a direction has been given and the two month period has expired (or where the registrar had insufficient information to give a direction) and the person has failed to furnish an address for service⁸ then the person's application is treated as withdrawn⁹.

1 An address for service furnished under head (1) in the text must be an address in the United Kingdom, another EEA State (ie a member state, Iceland, Liechtenstein or Norway) or the Channel Islands: Registered Designs Rules 2006, SI 2006/1975, r 42(4), (6). As to registration of designs see PARA 707.

2 Ie under the Registered Designs Act 1949 s 11ZB: see PARA 757. An address for service furnished under head (2) in the text must be an address in the United Kingdom, unless in a particular case the registrar otherwise directs: Registered Designs Rules 2006, SI 2006/1975, r 42(5).

3 Registered Designs Rules 2006, SI 2006/1975, r 42(1). An address for service furnished under head (3) in the text must be an address in the United Kingdom, unless in a particular case the registrar otherwise directs: Registered Designs Rules 2006, SI 2006/1975, r 42(5). As to the proprietorship of registered designs see PARA 722.

4 Ie Form DF1A: Registered Designs Rules 2006, SI 2006/1975, r 42(2), Sch 1. An address for service furnished under this provision must be an address in the United Kingdom, another EEA State or the Channel Islands: r 42(4).

5 Ie on Form DF1A: Registered Designs Rules 2006, SI 2006/1975, r 42(3).

6 Registered Designs Rules 2006, SI 2006/1975, r 43(1), (5).

7 Registered Designs Rules 2006, SI 2006/1975, r 43(2).

8 Registered Designs Rules 2006, SI 2006/1975, r 43(3).

9 Ie (1) in the case of an applicant for the registration of a design, the application is treated as withdrawn; (2) in the case of a person applying under the Registered Designs Act 1949 s 11ZB for a declaration of invalidity, his application is treated as withdrawn; and (3) in the case of the proprietor who is opposing an application under s 11ZB, he is deemed to have withdrawn from the proceedings: Registered Designs Rules 2006, SI 2006/1975, r 43(4).

UPDATE

687 Address for service

NOTES 3-6--SI 2006/1975 r 42(4) substituted, r 42(5) revoked, r 43(5) amended: SI 2009/546.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/688. Use of electronic communications.

688. Use of electronic communications.

The registrar¹ may give directions as to the form and manner in which documents to be delivered in electronic form or using electronic communications are to be delivered to him². If a document to which a direction applies is delivered to the registrar in a form or manner which does not comply with the direction then the registrar may treat the document as not having been delivered³.

The registrar may give directions specifying how and when the fee is to be paid where a document is delivered using electronic communications and there is a requirement for a fee to accompany the document⁴. The registrar may give directions specifying that a person who delivers a document to the registrar in electronic form or using electronic communications cannot treat the document as having been delivered unless its delivery has been acknowledged⁵. He may also give directions specifying how a time of delivery is to be accorded to a document delivered to him in electronic form or using electronic communications⁶.

The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication⁷.

A requirement of the Registered Designs Act 1949 that something must be done in the prescribed manner is satisfied in the case of something that is done using a document in electronic form, or using electronic communications, only if the directions made by the registrar are complied with⁸.

A direction given by the registrar may be given generally, or in relation to a description of cases specified in the direction, or in relation to a particular person or persons; and it may be varied or revoked by a subsequent direction⁹.

1 As to the registrar see PARA 684.

2 Registered Designs Act 1949 s 37A(1) (s 37A added by SI 2006/1229). Such a direction may provide that in order for a document to be delivered in compliance with the direction it must be accompanied by one or more additional documents specified in the direction: Registered Designs Act 1949 s 37A(2) (as so added). Section 37A applies to delivery at the UK Intellectual Property Office as it applies to delivery to the registrar, and it applies to delivery by the UK Intellectual Property Office as it applies to delivery by the registrar: Registered Designs Act 1949 s 37A(13) (as so added). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 Registered Designs Act 1949 s 37A(3) (as added: see note 2).

4 Registered Designs Act 1949 s 37A(4), (5) (as added: see note 2).

5 Registered Designs Act 1949 s 37A(6) (as added: see note 2).

6 Registered Designs Act 1949 s 37A(7) (as added: see note 2).

7 Registered Designs Act 1949 s 37A(10) (as added: see note 2).

8 Registered Designs Act 1949 s 37A(11) (as added: see note 2). A reference in the Registered Designs Act 1949 to the application not having been made in accordance with rules under the Act includes a reference to its not having been made in accordance with any applicable directions under s 37A: s 37A(12) (as so added).

9 Registered Designs Act 1949 s 37A(8), (9) (as added: see note 2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/689. Costs and security for costs.

689. Costs and security for costs.

In any proceedings before him under the Registered Designs Act 1949 the registrar¹ may by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid². Any such order of the registrar may be enforced in the same way as an order of the High Court³.

The registrar may require a person to give security for the costs of any application for invalidation of the registration of a design or appeal from any decision of the registrar under the Registered Designs Act 1949⁴ if he is satisfied, having regard to all the circumstances of the case, that it is just to require such security, and that one or more of the following conditions applies⁵:

- 555 (1) the person is resident outside the United Kingdom but is not resident in a Brussels Contracting State, or a Lugano Contracting State, or a Regulation State⁶;
- 556 (2) the person is a company or other body (whether incorporated inside or outside the United Kingdom) and there is reason to believe that it will be unable to pay the other person's costs if ordered to do so⁷;
- 557 (3) the person has changed his address since filing an address for service with a view to evading the consequences of the proceedings⁸;
- 558 (4) the person has furnished an incorrect address for service⁹;
- 559 (5) the person has taken steps in relation to his assets that would make it difficult to enforce an order for costs against him¹⁰;
- 560 (6) the person has failed to pay a costs order in relation to previous proceedings before the registrar or a court (whether or not the proceedings were between the same parties)¹¹.

In default of such security being given the registrar may treat the application or appeal as abandoned¹².

1 As to the registrar see PARA 684.

2 Registered Designs Act 1949 s 30(1) (s 30 substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 19); Registered Designs Rules 2006, SI 2006/1975, r 22.

3 Registered Designs Act 1949 s 30(2)(a) (as substituted: see note 2).

4 Registered Designs Act 1949 s 30(3) (as substituted (see note 2); amended by SI 2001/3949). As to invalidation of registration see PARA 757.

5 Registered Designs Rules 2006, SI 2006/1975, r 23(1).

6 Registered Designs Rules 2006, SI 2006/1975, r 23(2)(a); Civil Jurisdiction and Judgments Act 1982 s 1(3); and see **CONFLICT OF LAWS** vol 8(3) (Reissue) PARA 65. As to the meaning of 'United Kingdom' see PARA 303 note 5.

7 Registered Designs Rules 2006, SI 2006/1975, r 23(2)(b).

8 Registered Designs Rules 2006, SI 2006/1975, r 23(2)(c).

9 Registered Designs Rules 2006, SI 2006/1975, r 23(2)(d).

- 10 Registered Designs Rules 2006, SI 2006/1975, r 23(2)(e).
- 11 Registered Designs Rules 2006, SI 2006/1975, r 23(2)(f).
- 12 Registered Designs Rules 2006, SI 2006/1975, r 23(3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(ii) Administration/690. Agents.

690. Agents.

Any act required or authorised by the Registered Designs Act 1949 to be done by or to any person in connection with the registration of a design, or any procedure relating to a registered design, may be done by or to an agent authorised by that person orally or in writing¹. An agent is only to be treated as authorised where he was nominated by the applicant at the time of making his application² and he has filed the relevant form³. Where an agent has been authorised, the registrar⁴ may, if he thinks fit in any particular case, require the signature or presence of his principal⁵.

The Secretary of State⁶ may make rules authorising the Comptroller-General of Patents, Designs and Trade Marks⁷ to refuse to recognise as agent in respect of any business under the Registered Designs Act 1949:

- 561 (1) a person who has been convicted of specified offences⁸;
- 562 (2) an individual whose name has been erased from and not restored to, or who is suspended from, the register of patent agents⁹ on the ground of misconduct;
- 563 (3) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent agents¹⁰, render him liable to have his name erased from the register on the ground of misconduct;
- 564 (4) a partnership or body corporate of which one of the partners or directors is a person whom the comptroller could refuse to recognise under head (1), (2) or (3) above¹¹.

The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may in particular prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct¹².

The comptroller is accordingly authorised to refuse to recognise as agent in respect of any business under the Registered Designs Act 1949:

- 565 (a) a person who has been convicted of specified offences¹³;
- 566 (b) an individual whose name has been erased from and not restored to the register on the ground of misconduct;
- 567 (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent agents, render him liable to have his name erased from the register on the ground of misconduct;
- 568 (d) a partnership or body corporate of which one of the partners or directors is a person whom the comptroller could refuse to recognise under head (a), (b) or (c) above¹⁴.

The comptroller must refuse to recognise as agent in respect of any business under the Registered Designs Act 1949 a person who neither resides nor has a place of business in the United Kingdom¹⁵, the Isle of Man or another member state of the European Community¹⁶.

- 1 Registered Designs Rules 2006, SI 2006/1975, r 36(1).
- 2 In his application for registration, or his application for a declaration of invalidity under the Registered Designs Act 1949 s 11ZB (see PARA 757), or his application under s 19(1) or s 19(2) (see PARA 700).
- 3 Registered Designs Rules 2006, SI 2006/1975, r 36(2). The relevant form is Form DF1A: see r 36(2), Sch 1.
- 4 As to the registrar see PARA 684.
- 5 Registered Designs Rules 2006, SI 2006/1975, r 36(3).
- 6 As to the Secretary of State see PARA 575.
- 7 As to the comptroller see PARA 577.
- 8 In an offence under the Patents Act 1949 s 88 (repealed), the Patents Act 1977 114 (repealed) or the Copyright, Designs and Patents Act 1988 s 276 (see PARA 615).
- 9 Note that as from a day to be appointed the reference to 'patent agent' is repealed and replaced with the term 'patent attorney' by the Legal Services Act 2007 Sch 21 paras 75, 78. At the date at which this volume states the law no such day had been appointed.
- 10 See note 9.
- 11 Copyright, Designs and Patents Act 1988 s 281(1), (2). In exercise of the power so conferred the Secretary of State has made the Patent Agents (Non-recognition of Certain Agents by Comptroller) Rules 1990, SI 1990/1454, which came into force on 13 August 1990: r 1.
- 12 Copyright, Designs and Patents Act 1988 s 281(3). Such rules must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: s 281(4).
- 13 See note 8.
- 14 Patent Agents (Non-recognition of Certain Agents by Comptroller) Rules 1990, SI 1990/1454, rr 2, 3.
- 15 As to the meaning of 'United Kingdom' see PARA 303 note 5.
- 16 Copyright, Designs and Patents Act 1988 s 281(5).

UPDATE

690 Agents

TEXT AND NOTES 13, 14--SI 1990/1454 rr 2, 3 amended: SI 2009/3348.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/ (iii) The Court and Appeal Tribunal/691. The court.

(iii) The Court and Appeal Tribunal

691. The court.

In the Registered Designs Act 1949, 'court' means in England and Wales the High Court¹ or any patents county court² having jurisdiction³. In practice references and applications under that Act are heard by the Patents Court or the patents county court. A claim for infringement is not a reference or application for this purpose, but must also be heard by the Patents Court or the patents county court⁴.

1 Provision may be made by rules of court with respect to proceedings in the High Court in England and Wales for references and applications under the Registered Designs Act 1949 to be dealt with by such judge of that court as the Lord Chief Justice, after consulting with the Lord Chancellor, may select for the purpose: s 27(2) (s 27 substituted by the Copyright, Designs and Patents Act 1988 s 272, Sch 3 para 16; the Registered Designs Act 1949 s 27(2) amended by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 35, 36(1), (2)). Proceedings are assigned to the Patents Court: see CPR 63.3(2)(d), 63.4, 63.4A. As to the Patents Court see PARA 637 et seq. The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4) (see **COURTS**)) to exercise his functions under the Registered Designs Act 1949 s 27(2): s 27(3) (added by the Constitutional Reform Act 2005 Sch 4 paras 35, 36(1), (3)).

2 ie having jurisdiction by virtue of an order under the Copyright, Designs and Patents Act 1988 s 287: see PARA 644. As to the patents county court see PARA 644 et seq.

3 Registered Designs Act 1949 s 27(1) (as substituted: see note 1); Registered Designs Act 1949 s 44(1) (definition substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 31(1), (6)).

4 See CPR Pt 63; and note 1.

UPDATE

691 The court

TEXT AND NOTE 4--CPR Pt 63 substituted: SI 2009/2092.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/ (iii) The Court and Appeal Tribunal/692. Appeals from decisions of the registrar.

692. Appeals from decisions of the registrar.

Until a day to be appointed¹, any appeal from the registrar² under the Registered Designs Act 1949 lies to the Registered Designs Appeal Tribunal³. The tribunal consists of one or more judges of the High Court nominated by the Lord Chief Justice after consulting the Lord Chancellor and one judge of the Court of Session nominated by the Lord President of the Court⁴. It is not part of the High Court, but is an inferior tribunal subject to control through the prerogative orders obtained on judicial review⁵. A party to an appeal before the tribunal may appear and be heard either in person or by a patent agent, a solicitor or counsel⁶. The tribunal may examine witnesses on oath and administer oaths for that purpose⁷, although it normally acts on the evidence which was produced before the registrar⁸. Costs or expenses may be awarded by order⁹ and the tribunal may direct how and by what parties the costs are to be paid¹⁰, and may in prescribed circumstances require security for costs¹¹. On an appeal any power which could have been exercised by the registrar in the proceedings from which the appeal is brought is exercisable by the tribunal¹². Subject to these provisions, the tribunal may make its own rules for regulating all matters relating to proceedings before it under the Registered Designs Act 1949 including rights of audience¹³. There is an appeal to the tribunal only where one is provided by statute¹⁴.

As from a day to be appointed¹⁵, an appeal from the registrar under the Registered Designs Act 1949 lies to the court¹⁶. On an appeal, the court may exercise any power which could have been exercised by the registrar in the proceeding from which the appeal is brought¹⁷. An appeal brought in England and Wales must, if there is a patents county court that has jurisdiction to entertain the appeal¹⁸, be brought in such a patents county court¹⁹.

1 As from a day to be appointed, the Registered Designs Act 1949 s 28 is repealed by the Tribunals, Courts and Enforcement Act 2007 ss 143(1), 146, Sch 23 Pt 6 and the Registered Designs Act 1949 s 27A (see the text and notes 15-19) is added by the Tribunals, Courts and Enforcement Act 2007 s 143(2). At the date at which this volume states the law no such day had been appointed.

2 As to the registrar see PARA 684.

3 Registered Designs Act 1949 s 28(1). See note 1.

4 Registered Designs Act 1949 s 28(2) (substituted by the Copyright, Designs and Patents Act 1988 s 272, Sch 3 para 17(1), (2); and amended by the Constitutional Reform Act 2005 s 15(1), Sch 4 paras 35, 37(1), (2)). The Lord Chief Justice may nominate a judicial office holder (as defined in the Constitutional Reform Act 2005 s 109(4) (see **COURTS**)) to exercise his functions under the Registered Designs Act 1949 s 28(2): s 28(11) (added by the Constitutional Reform Act 2005 Sch 4 paras 35, 37(1), (3)).

In the Registered Designs Act 1949, and the rules made under it, the Registered Designs Appeal Tribunal is referred to simply as the Appeal Tribunal: see s 44(1) (definition substituted by the Administration of Justice Act 1969 s 35(1), Sch 1). At any time when it consists of two or more judges, the jurisdiction of the Appeal Tribunal: (1) where in the case of any particular appeal the senior of those judges so directs, is to be exercised in relation to that appeal by both of the judges, or (if there are more than two) by two of them sitting together; and (2) in relation to any appeal in respect of which no such direction is given, may be exercised by any one of the judges; and, in the exercise of the jurisdiction, different appeals may be heard at the same time by different judges: Registered Designs Act 1949 s 28(2A) (added by the Administration of Justice Act 1969 s 24). The Lord Chancellor may appoint additional judges who are either judges of the Court of Appeal or persons who have held office as judges of the Court of Appeal or the High Court or one of Her Majesty's counsel: see the Administration of Justice Act 1970 s 10(1), (1A) (s 10(1) amended, and s 10(1A) added, by the Constitutional Reform Act 2005 Sch 4 para 66(1), (2)). The expenses of the Appeal Tribunal must be defrayed and the fees to be taken therein may be fixed as if the tribunal were a court of the High Court: Registered Designs Act 1949 s 28(3).

5 An appeal to the Appeal Tribunal is not deemed to be a proceeding in the High Court: Registered Designs Act 1949 s 28(9). As to the prerogative orders generally see **JUDICIAL REVIEW** vol 61 (2010) PARA 602 et seq.

6 Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 5A(1) (added by SI 1970/1075).

7 Registered Designs Act 1949 s 28(4).

8 See the Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 6.

9 In awarding costs the Appeal Tribunal may either fix the amount or direct by whom and in what manner the amount is to be ascertained (Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 10); and, if the costs are not paid within 14 days after the amount has been fixed or ascertained, or such shorter period as may be directed, the party to whom they are payable may apply to the tribunal for an order for payment (r 11). The practice is for the tribunal to award a fixed sum, not intended to amount to a full indemnity for the actual costs.

10 Registered Designs Act 1949 s 28(5) (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 17(1), (3); and SI 2006/1028). Any such order may be enforced in England and Wales in the same way as an order of the High Court: Registered Designs Act 1949 s 28(5)(a) (as so amended).

11 See PARA 689.

12 Registered Designs Act 1949 s 28(7).

13 Registered Designs Act 1949 s 28(8) (amended by the Administration of Justice Act 1970 s 10(5)). At any time when the Appeal Tribunal consists of two or more judges, the power to make rules is exercisable by the senior of those judges; but another of those judges may exercise that power if it appears to him that it is necessary for rules to be made and that judge or, if more than one, each of the judges, senior to him is for the time being prevented by illness, absence or otherwise from making them: Registered Designs Act 1949 s 28(8A) (added by the Administration of Justice Act 1969 s 24). The seniority of judges is to be reckoned by reference to the dates on which they were appointed judges of the High Court or the Court of Session: Registered Designs Act 1949 s 28(10) (added by the Administration of Justice Act 1969 s 24; and substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 17(1), (4)).

14 Cf *Re Monotype Corpn Ltd's Application* (1939) 56 RPC 243, Patents Appeal Tribunal.

15 See note 1.

16 Registered Designs Act 1949 s 27A(1), (2) (s 27A prospectively added by the Tribunals, Courts and Enforcement Act 2007 s 143(2)). At the date at which this volume states the law no day had been appointed for the coming into force of the Registered Designs Act 1949 s 27A. As to the meaning of 'court' see PARA 691.

17 Registered Designs Act 1949 s 27A(3) (as prospectively added: see note 16).

18 Ie by virtue of an order under the Copyright, Designs and Patents Act 1988 s 287: see PARA 644.

19 Registered Designs Act 1949 s 27A(4) (as prospectively added: see note 16). This provision is not to be taken to prejudice the application of the County Courts Act 1984 s 42 (transfer of proceedings to High Court by order of county court) (see **CIVIL PROCEDURE** vol 11 (2009) PARA 69) in relation to proceedings on an appeal brought in a patents county court: Registered Designs Act 1949 s 27A(5) (as prospectively added: see note 16). Rules of court may make provision as to the exercise of the power under the County Courts Act 1984 s 42(2) in relation to proceedings on an appeal brought in a patents county court: Registered Designs Act 1949 s 27A(6) (as prospectively added: see note 16). See CPR 30.3; and **CIVIL PROCEDURE** vol 11 (2009) PARA 69.

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693. Procedure on appeal to the tribunal.

An appeal to the Registered Designs Appeal Tribunal must be lodged¹, on a matter of procedure, within 14 days, and in any other case within six weeks, after the date of the decision appealed from². The registrar may determine whether any decision is on a matter of procedure and any such determination is itself a decision on a matter of procedure³. The registrar may grant an extension on a request received before the expiration of the period specified, and the tribunal has power to grant such extensions as it may think fit on special application being made to it⁴. When a notice of appeal has been given, it is the duty of the registrar to transmit to the registrar of the tribunal all the papers relating to the matter⁵. At the request of any party, any person who has made a declaration in the proceedings may be required to attend for cross-examination⁶.

1 To be filed by filing with the Registrar of the Appeal Tribunal at the Royal Courts of Justice, London, a notice of appeal in the form set out in the Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, Schedule (amended by SI 1970/1075): Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 1(1) (r 1 substituted by SI 1970/1075). The notice may be sent by post: Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 12. Within two days of filing a notice of appeal the appellant must send a copy to the registrar and to any person who appeared, or gave notice of opposition, in the proceedings before the registrar: r 2 (amended by SI 1970/1075). A fee in cash or, if permitted by the registrar, by cheque must be taken on the filing of every notice of appeal: see the Registered Designs Appeal Tribunal (Fees) Order 1973, SI 1973/165, arts 2, 3. If, owing to exceptional circumstances, payment of the fee would cause undue hardship, it may be reduced or remitted by the Lord Chancellor in any particular case: see art 4. As to the registrar see PARA 684.

2 Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 1(1), (2) (as substituted: see note 1). Where the registrar refuses to register a design included in an application, he must send to the applicant the written reasons for his decision; and the date on which the written reasons were sent to the applicant is deemed to be the date of the decision for the purposes of any appeal: Registered Designs Rules 2006, SI 2006/1975, r 8(5), (6).

3 Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 1(3) (as substituted: see note 1).

4 See the Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 4 (substituted by SI 1970/1075). Not less than seven days' notice of the time and place appointed for the hearing of the appeal must be given by the Registrar of the Appeal Tribunal to the appellant and the registrar and to any opposing party, unless the tribunal expressly allows shorter notice: r 5.

5 Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 3.

6 Registered Designs Appeal Tribunal Rules 1950, SI 1950/430, r 8.

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694. Appeal to the Court of Appeal.

Permission to appeal must be obtained from the judge at first instance or, if he refuses, the Court of Appeal¹. The appellate court acts by way of review of the decision rather than by way of a rehearing. Unless, therefore, the judge has misdirected himself there is no ground for interfering with his conclusion².

1 See CPR 52.3; and **CIVIL PROCEDURE** vol 12 (2009) PARA 1660.

2 See *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] 1 All ER 700 at 702, [2000] 1 WLR 2416, HL, per Lord Bingham of Cornhill. See also *Thermos Ltd v Aladdin Sales & Marketing Ltd* [2001] EWCA Civ 667, [2001] All ER (D) 129 (May); *Proctor & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 208.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(1) LEGISLATION AND ADMINISTRATION/(iv) Offences/695. Offences against secrecy provisions.

(iv) Offences

695. Offences against secrecy provisions.

If any person¹ fails to comply with a direction relating to the secrecy of a design², or makes or causes to be made an application for the registration of a design in contravention of the statutory provisions relating to secrecy³, he is guilty of an offence and liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or to both, or on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or to both⁴.

1 As to the meaning of 'person' see PARA 307 note 1. As to offences by bodies corporate see PARA 698.

2 Ie a direction given under the Registered Designs Act 1949 s 5: see PARA 710.

3 Ie in contravention of the Registered Designs Act 1949 s 5: see PARA 710.

4 Registered Designs Act 1949 s 33(1) (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 22(1), (2)). The 'statutory maximum', with reference to a fine or penalty on summary conviction for an offence, is the prescribed sum within the meaning of the Magistrates' Courts Act 1980 s 32: see the Interpretation Act 1978 s 5, Sch 1 (definition added by the Criminal Justice Act 1988 s 170(1), Sch 15 para 58); and **SENTENCING AND DISPOSITION OF OFFENDERS** vol 92 (2010) PARA 140. As to the prescribed sum see PARA 336 note 17.

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696. Falsification of the register.

If any person¹ makes or causes to be made a false entry in the register of designs², or a writing falsely purporting to be a copy of an entry in that register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he is guilty of an offence and liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine, or to both, or on summary conviction to imprisonment for a term not exceeding six months or a fine not exceeding the statutory maximum, or to both³.

1 As to the meaning of 'person' see PARA 307 note 1. As to offences by bodies corporate see PARA 698.

2 As to the register of designs see PARA 699.

3 Registered Designs Act 1949 s 34 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 23). As to the statutory maximum see PARA 695 note 4.

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697. Falsely representing a design as registered.

If any person¹ falsely represents that a design applied to, or incorporated in, any product sold by him is registered, he is liable on summary conviction to a fine not exceeding level 3 on the standard scale².

If any person, after the right in a registered design has expired, marks any product to which the design has been applied or in which it has been incorporated with the word 'registered', or any word or words implying that there is a subsisting right in the design under the Registered Designs Act 1949, or causes any such product to be so marked, he is liable on summary conviction to a fine not exceeding level 1 on the standard scale³.

1 As to the meaning of 'person' see PARA 307 note 1. As to offences by bodies corporate see PARA 698.

2 Registered Designs Act 1949 s 35(1) (amended by SI 2001/3949). As to the standard scale see PARA 609 note 2.

A person who sells a product having stamped, engraved or impressed on it or otherwise applied to it the word 'registered', or any other word expressing or implying that the design applied to, or incorporated in, the product is registered, is deemed to represent that the design applied to, or incorporated in, the product is registered: Registered Designs Act 1949 s 35(1) (amended by SI 2001/3949).

3 Registered Designs Act 1949 s 35(2) (amended by SI 2001/3949).

For these purposes, the use in the United Kingdom in relation to a design of the word 'registered', or of any other word or symbol importing a reference (express or implied) to registration, is deemed to be a representation as to registration under the Registered Designs Act 1949 unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the design is in fact so registered: s 35(3) (added by SI 2005/2339). As to the meaning of 'United Kingdom' see PARA 303 note 5.

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698. Offences by corporations.

Where an offence under the Registered Designs Act 1949 committed by a body corporate is proved to have been committed with the consent or connivance of a director¹, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly².

1 For these purposes, in relation to a body corporate whose affairs are managed by its members, 'director' means a member of the body corporate: Registered Designs Act 1949 s 35A(2) (s 35A added by the Copyright, Designs and Patents Act 1988 Sch 3 para 25).

2 Registered Designs Act 1949 s 35A(1) (as added: see note 1).

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(2) THE REGISTER

699. Keeping of the register.

The registrar¹ must maintain the register of designs, in which must be entered:

- 569 (1) the names and addresses of proprietors² of registered designs;
- 570 (2) notices of assignments³ and of transmissions of registered designs; and
- 571 (3) such other matters as may be prescribed or as the registrar may think fit⁴.

The public has a right⁵ to inspect the register at the UK Intellectual Property Office⁶ at all convenient times⁷, but the register need not be kept in documentary form⁸.

The register is prima facie evidence of any matters required or authorised by the Registered Designs Act 1949 to be entered in it⁹; but no notice of any trust, whether express, implied or constructive, may be entered in the register, and the registrar is not affected by any such notice¹⁰.

1 As to the registrar see PARA 684.

2 As to the proprietorship of registered designs see PARA 722.

3 As to assignments see PARA 723.

4 Registered Designs Act 1949 s 17(1) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). The prescribed matters for the purposes of the Registered Designs Act 1949 s 17(1) are: (1) the registered proprietor's address for service; (2) the grant or cancellation of a licence under a registered design; (3) the granting or cancelling of a security interest (whether fixed or floating) over a registered design or any right in or under it; (4) an order of a court or other competent authority transferring a registered design or any right in or under it: Registered Designs Rules 2006, SI 2006/1975, r 27(1). An application to the registrar to enter any other matter in the register must be made in writing: r 27(2). Where the registrar has doubts about whether he should enter a matter in the register he must inform the person making the application of the reasons for his doubts, and he may require that person to furnish evidence in support of the application: r 27(4). As to rectification of the register see PARAS 719-720.

5 le subject to the provisions of the Registered Designs Act 1949 and to rules made by the Secretary of State.

6 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

For the transaction of relevant business (ie the filing of any application or other document except an application for an extension under the Registered Designs Act 1949 s 8 or an application for the registration of a design or designs made by virtue of s 14 by the public) the UK Intellectual Property Office is open (1) on Monday to Friday between 9.00 am and midnight; and (2) on Saturday between 9.00 am and 1.00 pm: Registered Designs Rules 2006, SI 2006/1975, r 45(1), (3). For the transaction of all other business by the public under the Registered Designs Act 1949 the UK Intellectual Property Office is open between 9.00 am and 5.00 pm: Registered Designs Rules 2006, SI 2006/1975, r 45(2).

Any business done under the Registered Designs Act 1949 on any day after the hours at which the UK Intellectual Property Office is deemed to be closed, or on a day which is an excluded day, is deemed to have been done on the next following day not being an excluded day; and, where the time for doing anything expires on an excluded day, that time is extended to the next following day not being an excluded day: s 39(2). The following days are excluded days for the transaction by the public of business under the Registered Designs Act 1949: a Sunday, Good Friday, Christmas day or a day which is specified or proclaimed to be a bank holiday by or under the Banking and Financial Dealings Act 1971 s 1: Registered Designs Rules 2006, SI 2006/1975, r

46(1). A Saturday is an excluded day for the transaction by the public of business except relevant business (see r 45(1)); r 46(2).

The registrar may certify any day as an interrupted day where (1) there is an event or circumstance causing an interruption in the normal operation of the UK Intellectual Property Office; or (2) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom: r 40(1). Any certificate of the registrar made under r 40(1) must be posted in the UK Intellectual Property Office and advertised in the journal: rr 40(2), 44. The registrar must, where the time for doing anything under the rules expires on an interrupted day, extend that time to the next following day not being an interrupted day (or an excluded day): r 40(3). 'Interrupted day' means a day which has been certified as such under r 40(1), and 'excluded day' means a day specified as such by r 46: r 40(4). As to the extension of time periods see r 39. As to delays in communication services see r 41; and PARA 686.

7 Registered Designs Act 1949 s 17(4) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). As to inspection of the register see PARA 701.

8 Registered Designs Act 1949 s 17(3) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). In relation to any portion of the register kept otherwise than in documentary form: (1) the right of inspection conferred by the Registered Designs Act 1949 s 17(4) is a right to inspect the material on the register; and (2) the right to a copy or extract conferred by s 17(5) or rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible: s 17(7) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3).

9 Registered Designs Act 1949 s 17(8) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). See PARA 706.

10 Registered Designs Act 1949 s 17(2) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). See also PARA 587. The Registered Designs Act 1949 does not, however, contain a provision as to the effect of non-registration corresponding to the Patents Act 1977 s 33(1) (see PARA 589) but the Registered Designs Act 1949 s 19(5) (see PARA 700) provides a strong practical sanction against non-registration.

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700. Registration of assignments etc.

Where any person becomes entitled by assignment, transmission or operation of law to a registered design or to a share in a registered design, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a registered design, he must apply¹ to the registrar² in the prescribed manner for the registration of his title as proprietor³ or co-proprietor or, as the case may be, of notice of his interest, in the register of designs⁴.

Where application is so made for the registration of the title of any person, the registrar must, upon proof of title to his satisfaction:

- 572 (1) where that person is entitled to a registered design or a share in a registered design, register him in the register of designs as proprietor or co-proprietor of the design and enter in that register particulars of the instrument or event by which he derives title; or
- 573 (2) where that person is entitled to any other interest in the registered design, enter in that register notice of his interest, with particulars of the instrument, if any, creating it⁵.

Where national unregistered design right⁶ subsists in a registered design, the registrar may not so register an interest unless he is satisfied that the person entitled to that interest is also entitled to a corresponding interest in the national unregistered design right⁷. Where national unregistered design right subsists in a registered design and the proprietor of the registered design is also the design right owner, an assignment of the national unregistered design right is to be taken to be also an assignment of the right in the registered design, unless a contrary intention appears⁸.

An application for the registration of the title of any person becoming entitled by assignment to a registered design or a share in a registered design, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a registered design, may be made⁹ in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be¹⁰.

Where a body corporate has re-registered under the Companies Act 1985¹¹ with the same name as that with which it was registered immediately before the re-registration save for the substitution as, or the inclusion as, the last part of the name of the words 'public limited company' or their Welsh equivalent or the abbreviation 'plc' or its Welsh equivalent, then references to the name of the body corporate in any application to the registrar, in the register of designs and in any other record kept at, or any document issued by, the UK Intellectual Property Office and relating to designs are to be treated on and after the date of such re-registration as references to the name with which the body corporate is so re-registered¹².

Except for the purposes of an application to rectify the register¹³, a document in respect of which no entry has been made in the register¹⁴ may not be admitted in any court as evidence of the title of any person to a registered design or share of or interest in a registered design unless the court otherwise directs¹⁵.

1 There is no penalty for failure to comply. 'Registered proprietor' means the person or persons for the time being entered in the register of designs as proprietor of the design: Registered Designs Act 1949 s 44(1). As to the proprietorship of registered designs see PARA 722.

- 2 As to the registrar see PARA 684.
- 3 See PARA 722.
- 4 Registered Designs Act 1949 s 19(1). An application under s 19(1) or s 19(2) must be made on Form DF12A: Registered Designs Rules 2006, SI 2006/1975, r 27(3), Sch 1. As to the register see PARA 699 et seq. As to rectification of the register see PARAS 719-720.
- 5 Registered Designs Act 1949 s 19(3).
- 6 As to national unregistered design right see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 486 et seq.
- 7 Registered Designs Act 1949 s 19(3A) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 10; and amended by SI 2001/3949).
- 8 Registered Designs Act 1949 s 19(3B) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 10; and amended by SI 2001/3949).
- 9 le without prejudice to the Registered Designs Act 1949 s 19(1).
- 10 Registered Designs Act 1949 s 19(2). See also note 4.
- 11 As to re-registration under the Companies Act 1985 see **COMPANIES** vol 14 (2009) PARA 167 et seq.
- 12 Designs (Companies Re-registration) Rules 1982, SI 1982/299, rr 1, 2; Companies Consolidation (Consequential Provisions) Act 1985 s 31(1), (2). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.
- 13 As to rectification see PARA 720.
- 14 le under the Registered Designs Act 1949 s 19(3).
- 15 Registered Designs Act 1949 s 19(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(2) THE REGISTER/701. Inspection of the register and supply of copies or extracts.

701. Inspection of the register and supply of copies or extracts.

The register of designs is in general¹ open to inspection by the public². Any person who applies for a certified copy³ of an entry in the register or a certified extract⁴ from the register is entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts⁵.

1 As to the secrecy of certain designs see PARA 710.

2 See the Registered Designs Act 1949 s 17(4); and PARA 699. The register and any representation or specimen of a registered design are open for inspection at the UK Intellectual Property Office during the hours the UK Intellectual Property Office is open for all classes of public business: Registered Designs Rules 2006, SI 2006/1975, r 28(1). As to the hours of business see PARA 699 note 6. However, whilst a direction under the Registered Designs Act 1949 s 5(1) (see PARA 710) in respect of a design remains in force, no representation or specimen of the design is open to inspection: Registered Designs Rules 2006, SI 2006/1975, r 28(2). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 For these purposes, 'certified copy' means a copy certified by the registrar and sealed with the seal of the UK Intellectual Property Office: Registered Designs Act 1949 s 17(12) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3).

4 For these purposes, 'certified extract' means an extract certified by the registrar and sealed with the seal of the UK Intellectual Property Office: Registered Designs Act 1949 s 17(12) (as substituted: see note 3).

5 Registered Designs Act 1949 s 17(5) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). Applications under the Registered Designs Act 1949 s 17(5) or rules made by virtue thereof must be made in such manner as may be prescribed: s 17(6) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3). An application under the Registered Designs Act 1949 s 17(5) for a certified copy of an entry in the register or a certified extract from the register must be made on Form DF23 and be accompanied by the prescribed fee: Registered Designs Rules 2006, SI 2006/1975, r 32, Sch 1. A person may apply in writing accompanied by the prescribed fee to the registrar for a certified copy of any representation or specimen of a design, and that person is entitled to such a copy: r 33.

As to the right to a copy or extract where the register is kept otherwise than in documentary form see the Registered Designs Act 1949 s 17(7)(b); and PARA 699. As to certified copies and certified extracts being admissible in evidence see s 17(10); and PARA 706.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(2) THE REGISTER/702. Inspection of registered designs.

702. Inspection of registered designs.

Subject to special rules as to secrecy¹, where a design has been registered, the representation or specimen of the design is open to inspection at the UK Intellectual Property Office² on and after the day on which the certificate of registration³ is granted⁴.

Where registration of a design has been refused or an application for registration has been abandoned in relation to any design, the application, so far as relating to that design, and any representation, specimen or other document which has been filed and relates to that design, are not at any time open to inspection at the UK Intellectual Property Office; nor are they published by the registrar⁵.

1 See PARA 710.

2 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 As to the certificate of registration see PARA 715.

4 Registered Designs Act 1949 s 22(1) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 12(1), (2); and amended by SI 2001/3949; SI 2006/1974). The Registered Designs Act 1949 s 22(1) has effect subject to s 22(4) and to any rules made under s 5(2) (see PARA 710): s 22(1) (as so substituted and amended). As to inspection by the public see PARAS 699, 701.

5 Registered Designs Act 1949 s 22(4) (substituted by SI 2006/1974). As to the registrar see PARA 684.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(2) THE REGISTER/703. Information as to the existence of right in registered designs.

703. Information as to the existence of right in registered designs.

On the request¹ of a person furnishing such information as may enable the registrar² to identify the design, and on payment of the prescribed fee³, the registrar must inform him whether the design is registered, and whether any extension of the period of the right in the registered design has been granted, and must also state the date of registration and the name and address of the registered proprietor⁴.

1 The request must be made on Form DF21 and be accompanied by the prescribed fee: Registered Designs Rules 2006, SI 2006/1975, r 31(1), Sch 1. Where the registration number is known by the person making the request, the request must include that number, and in any other case, it must be accompanied by a representation or specimen of the product in which the design has been incorporated or to which the design has been applied: r 31(2).

2 As to the registrar see PARA 684.

3 As to fees see PARA 686.

4 Registered Designs Act 1949 s 23 (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 13; and amended by SI 2001/3949). As to the meaning of 'registered proprietor' see PARA 700 note 1. As to the proprietorship of registered designs see PARA 722.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(2) THE REGISTER/704. Confidential information.

704. Confidential information.

Where a person files a document at the UK Intellectual Property Office¹ or sends it to the registrar² or the UK Intellectual Property Office, any person may request that the document be treated as a confidential document³. A request to treat a document as confidential must be made before the end of the period of 14 days beginning with the date on which the document was filed at the UK Intellectual Property Office or received by the registrar or at the UK Intellectual Property Office, and must include reasons for the request⁴.

Where such a request has been made, the document must be treated as confidential until the registrar refuses that request or makes a direction⁵. Where it appears that there is good reason for the document to remain confidential, the registrar may direct that the document is to be treated as a confidential document; otherwise he must refuse the request⁶. Where, however, the registrar believes there is no longer a good reason for the direction⁷ to remain in force, he must revoke it⁸.

1 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

2 As to the registrar see PARA 684.

3 Registered Designs Rules 2006, SI 2006/1975, r 30(1). References to a document include part of a document: r 29(4). As to the inspection of documents see PARA 705.

4 Registered Designs Rules 2006, SI 2006/1975, r 30(2).

5 Registered Designs Rules 2006, SI 2006/1975, r 30(3). The direction referred to in the text is one under r 30(4): see the text and note 6.

6 Registered Designs Rules 2006, SI 2006/1975, r 30(4).

7 I.e. the direction under the Registered Designs Rules 2006, SI 2006/1975, r 30(4): see the text and note 6.

8 Registered Designs Rules 2006, SI 2006/1975, r 30(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(2) THE REGISTER/705. Inspection of documents.

705. Inspection of documents.

Where a design¹ has been registered under the Registered Designs Act 1949, every document kept at the UK Intellectual Property Office² in connection with that design is open to inspection at the UK Intellectual Property Office on and after the date on which the certificate of registration is granted³. However, no document may be inspected before the end of the period of 14 days beginning with the day it was filed at the UK Intellectual Property Office or received by the registrar or the UK Intellectual Property Office⁴. No document may be inspected where it was prepared by the registrar or the UK Intellectual Property Office for internal use only⁵. Nor may a document be inspected where it includes matter which in the registrar's opinion disparages any person in a way likely to damage him, or where its inspection would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour⁶.

Unless, in a particular case, the registrar otherwise directs, no document may be inspected:

- 574 (1) where (a) the document was prepared by the registrar or the UK Intellectual Property Office other than for internal use; and (b) it contains information which the registrar considers should remain confidential⁷;
- 575 (2) where it is treated as a confidential document⁸.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 References to a document include part of a document: Registered Designs Rules 2006, SI 2006/1975, r 29(4). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

3 Registered Designs Rules 2006, SI 2006/1975, r 29(1).

4 Registered Designs Rules 2006, SI 2006/1975, r 29(2)(a). As to the registrar see PARA 684.

5 Registered Designs Rules 2006, SI 2006/1975, r 29(2)(b).

6 Registered Designs Rules 2006, SI 2006/1975, r 29(2)(c).

7 Registered Designs Rules 2006, SI 2006/1975, r 29(3)(a).

8 Registered Designs Rules 2006, SI 2006/1975, r 29(3)(b). As to documents treated as confidential under r 30 see PARA 704.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(2) THE REGISTER/706. Evidence of entries, specimens and documents.

706. Evidence of entries, specimens and documents.

A certificate purporting to be signed by the registrar¹ and certifying that any entry which he is authorised by or under the Registered Designs Act 1949 to make has or has not been made, or that any other thing which he is authorised to do has or has not been done, is prima facie evidence of the matters so certified². A copy of any entry in the register³ or an extract from the register⁴ or of any representation, specimen or document kept in the UK Intellectual Property Office⁵ or an extract from any such document which purports to be a certified copy⁶ or certified extract⁷ must be admitted in evidence without further proof and without production of any original⁸.

1 As to the registrar see PARA 684.

2 Registered Designs Act 1949 s 17(9) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3).

3 As to the register see PARA 699 et seq.

4 ie a copy or extract supplied under the Registered Designs Act 1949 s 17(5): see PARA 701.

5 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 As to the meaning of 'certified copy' see PARA 701 note 3.

7 As to the meaning of 'certified extract' see PARA 701 note 4.

8 Registered Designs Act 1949 s 17(10) (substituted by the Patents, Designs and Marks Act 1986 Sch 1 para 3; and amended by the Criminal Justice Act 2003 Sch 37 Pt 6).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/707. Procedure for making application for registration.

(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS

707. Procedure for making application for registration.

An application for the registration of a design¹ (or designs) must be made by the person claiming to be the proprietor² of the design (or designs) in the prescribed form³ and must be filed at the UK Intellectual Property Office⁴ in the prescribed manner⁵. An application for the registration of a design (or designs) in which national unregistered design right subsists must be made by the person claiming to be the design right owner⁶. An application for the registration of a design which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed is deemed to be abandoned⁷.

1 le any design application for registration of which is registered after 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, reg 1): see PARA 681. As to the meaning of 'design' see PARA 734. A design may be cancelled if registered on the application of someone not entitled to apply: *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, Patents County Court.

2 As to the proprietorship of registered designs see PARA 722.

3 Applications for the registration of a design or designs must be made on form DF2A: Registered Designs Rules 2006, SI 2006/1975, r 4(1). It must include the identity of the person making the application, and in relation to each design, must either include a representation of the design, or be accompanied by a specimen of the design, and it must also be accompanied by the prescribed fee: r 4(1). An application for the registration of a design or designs, which is a subsequent application for the purposes of the Registered Designs Act 1949 s 3B(3) (see PARA 709), must be made on Form DF2B and be accompanied by the prescribed fee: Registered Designs Rules 2006, SI 2006/1975, r 4(2), Sch 1. Where an application includes a representation of the design, the applicant may give his consent for its publication on Form DF2A or Form DF2B: r 4(3), Sch 1. A representation or specimen filed may be accompanied by a brief description of the design: r 4(5). A specimen may not be filed if it is hazardous or perishable; and where such a specimen is so filed it must be disregarded: r 4(6). An application for the registration of a design which is a repeating surface pattern is only treated as such if (1) the representation or specimen filed includes the complete pattern and a sufficient portion of the repeat in length and width to show how the pattern repeats; and (2) the application contains a statement that it relates to a repeating surface pattern: r 4(7).

An application for the registration of a design must comply with the following requirements (r 5(1)):

- 3 (1) The first requirement is that the applicant has specified the product to which the design is intended to be applied or in which it is intended to be incorporated (r 5(2)).
- 4 (2) The second requirement is that the dimensions of any specimen of the design filed under r 4 must not exceed 29.7cm x 21cm x 1cm (r 5(3)).

Nothing done to comply with the first requirement is to be taken to affect the scope of the protection conferred by the registration of a design: r 5(5).

4 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

5 Registered Designs Act 1949 s 3(1), (2) (s 3 substituted by SI 2001/3949). Where a person purports to file something under the Registered Designs Act 1949 s 3(1) and it is not in the prescribed form or it is not accompanied by the prescribed fee, then the registrar must notify that person accordingly: Registered Designs Rules 2006, SI 2006/1975, r 4(4).

6 Registered Designs Act 1949 s 3(3) (as substituted: see note 5).

7 Registered Designs Act 1949 s 3(5) (as substituted: see note 5). The time prescribed for the purposes of s 3(5) is 12 months beginning with the date on which the application for registration of the design was made or treated as made (disregarding s 14): Registered Designs Rules 2006, SI 2006/1975, r 10(1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/708. Determination of applications for registration.

708. Determination of applications for registration.

Subject to the design satisfying the requirements of registrability¹, the registrar² may not generally refuse to register a design³ included in an application under the Registered Designs Act 1949⁴. However, he must refuse to register a design in the following circumstances. If it appears to the registrar that an application for the registration of a design (or designs) has not been made in accordance with the rules made under the Act, he may refuse to register any design included in it⁵. If it appears to the registrar that the applicant is not entitled⁶ to apply for the registration of a design included in the application, he must refuse to register that design⁷. If it appears to the registrar that the application for registration includes something which does not fulfil the statutory requirements⁸ or includes a design to which a ground of refusal⁹ described below applies he must refuse to register that thing or that design¹⁰.

A design must be refused registration if it involves the use of certain royal arms¹¹, national flags¹², insignias¹³ or controlled Olympic representations¹⁴. A design must also be refused registration if it involves the use of emblems of Paris Convention countries¹⁵, or the emblems of certain international organisations¹⁶. An appeal lies from any decision of the registrar under the provisions described above¹⁷.

Where it appears to the registrar that he should refuse to register a design included in an application¹⁸ he must notify the applicant accordingly¹⁹. The notification must include a 'statement of objections' setting out why it appears to the registrar that he should refuse to register the design²⁰. The applicant may, before the end of the period of two months beginning with the date of the notification, send his written observations on the statement of objections to the registrar²¹. The registrar must give the applicant an opportunity to be heard²². Where the registrar refuses to register a design included in an application, he must send to the applicant the written reasons for his decision²³.

Where the registrar decides that he should not refuse to register the design²⁴ and no representation of the design has been filed or a representation has been filed but it is not suitable for publication, then the registrar must direct the applicant to provide a suitable representation²⁵. Where such a direction is given, the applicant must, before the end of the period of three months beginning with the date of the direction, file a suitable representation (otherwise the registrar may refuse to register the design)²⁶.

1 Ie the requirements of the Registered Designs Act 1949 ss 1-1D: see PARAS 734-739.

2 As to the registrar see PARA 684.

3 As to the meaning of 'design' see PARA 734.

4 Registered Designs Act 1949 s 3A(1) (s 3A substituted by SI 2001/3949; and amended by SI 2006/1974).

5 Registered Designs Act 1949 s 3A(2) (as substituted and amended: see note 4).

6 Ie under the Registered Designs Act 1949 s 3(2) or s 3(3) (see PARA 707) or s 14 (see PARA 712). See also *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, Patents County Court.

7 Registered Designs Act 1949 s 3A(3) (as substituted and amended: see note 4).

8 Ie (1) something which does not fulfil the requirements of the Registered Designs Act 1949 s 1(2) (see PARA 734); or (2) a design that does not fulfil the requirements of s 1C or s 1D (see PARAS 737-739).

9 le a design to which a ground of refusal mentioned in the Registered Designs Act 1949 Sch A1 applies: see the text and notes 11-17.

10 Registered Designs Act 1949 s 3A(4) (substituted by SI 2006/1974).

11 A design must be refused registration if it involves the use of:

- 5 (1) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it;
- 6 (2) a representation of the Royal crown or any of the Royal flags;
- 7 (3) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or
- 8 (4) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation;

unless it appears to the registrar that consent for such use has been given by or on behalf of Her Majesty or (as the case may be) the relevant member of the Royal family: Registered Designs Act 1949 Sch A1 para 1(1) (Sch A1 added by SI 2001/3949).

12 A design must be refused registration if it involves the use of:

- 9 (1) the national flag of the United Kingdom (commonly known as the Union Jack); or
- 10 (2) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

and it appears to the registrar that the use would be misleading or grossly offensive: Registered Designs Act 1949 Sch A1 para 1(2) (as added: see note 11).

13 A design must be refused registration if it involves the use of:

- 11 (1) arms to which a person is entitled by virtue of a grant of arms by the Crown; or
- 12 (2) insignia so nearly resembling such arms as to be likely to be mistaken for them;

unless it appears to the registrar that consent for such use has been given by or on behalf of the person concerned and the use is not in any way contrary to the law of arms: Registered Designs Act 1949 Sch A1 para 1(3) (as added: see note 11).

14 A design must be refused registration if it involves the use of a controlled representation within the meaning of the Olympic Symbol etc (Protection) Act 1995 unless it appears to the registrar that: (1) the application is made by the person for the time being appointed under the Olympic Symbol etc (Protection) Act 1995 s 1(2) (power of Secretary of State to appoint a person as the proprietor of the Olympics association right); or (2) consent for such use has been given by or on behalf of the person mentioned in head (1): Registered Designs Act 1949 Sch A1 para 1(4) (as added: see note 11).

15 A design must be refused registration if it involves the use of the flag of a Paris Convention country unless: (1) the authorisation of the competent authorities of that country has been given for the registration; or (2) it appears to the registrar that the use of the flag in the manner proposed is permitted without such authorisation: Registered Designs Act 1949 Sch A1 para 2(1) (as added: see note 11). For these purposes, 'Paris Convention country' means a country, other than the United Kingdom, which is a party to the Paris Convention for the Protection of Industrial Property of 20 March 1883: Registered Designs Act 1949 Sch A1 para 5 (as so added).

A design must be refused registration if it involves the use of the armorial bearings or any other state emblem of a Paris Convention country which is protected under the Paris Convention unless the authorisation of the competent authorities of that country has been given for the registration: Registered Designs Act 1949 Sch A1 para 2(2) (as so added).

A design must be refused registration if:

- 13 (a) the design involves the use of an official sign or hallmark adopted by a Paris Convention country and indicating control and warranty;
- 14 (b) the sign or hallmark is protected under the Paris Convention; and

- 15 (c) the design could be applied to or incorporated in goods of the same, or a similar, kind as those in relation to which the sign or hallmark indicates control and warranty;

unless the authorisation of the competent authorities of that country has been given for the registration: Sch A1 para 2(3) (as so added).

The provisions Sch A1 para 2 as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark: Sch A1 para 2(4) (as so added). Nothing in Sch A1 para 2 prevents the registration of a design on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country: Sch A1 para 2(5) (as so added).

State emblems of a Paris Convention country (other than the national flag), and official signs or hallmarks, are regarded as protected under the Paris Convention only if, or to the extent that: (i) the country in question has notified the United Kingdom that it desires to protect that emblem, sign or hallmark; (ii) the notification remains in force; and (iii) the United Kingdom has not objected to it or any such objection has been withdrawn: Registered Designs Act 1949 Sch A1 para 4(1), (3) (as so added).

- 16 A design must be refused registration if it involves the use of the armorial bearings, flags or other emblems or the abbreviations and names of international intergovernmental organisations of which one or more Paris Convention countries are members unless: (1) the authorisation of the international organisation concerned has been given for the registration; or (2) it appears to the registrar that the use of the emblem, abbreviation or name in the manner proposed is not such as to suggest to the public that a connection exists between the organisation and the design, or is not likely to mislead the public as to the existence of a connection between the user and the organisation: Registered Designs Act 1949 Sch A1 para 3(1), (2) (as added: see note 11).

The provisions of Sch A1 para 3 as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem: Sch A1 para 3(3) (as so added). Nothing in Sch A1 para 3 affects the rights of a person whose bona fide use of the design in question began before 4 January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom): Registered Designs Act 1949 Sch A1 para 3(4) (as so added).

For these purposes the emblems, abbreviations and names of an international organisation are regarded as protected under the Paris Convention only if, or to the extent that: (1) the organisation in question has notified the United Kingdom that it desires to protect that emblem, abbreviation or name; (2) the notification remains in force; and (3) the United Kingdom has not objected to it or any such objection has been withdrawn: Registered Designs Act 1949 Sch A1 para 4(2), (3).

- 17 Registered Designs Act 1949 s 3D (added by SI 2001/3949).

- 18 (1) by reason of the application for the registration of that design not being made in accordance with the Registered Designs Rules 2006, SI 2006/1975, other than r 9(2) (see the Registered Designs Act 1949 s 3A(2)); or (2) by reason of s 3A(3) or s 3A(4) (see the text and notes 7-10): Registered Designs Rules 2006, SI 2006/1975, r 8(1)(a), (b).

- 19 Registered Designs Rules 2006, SI 2006/1975, r 8(1). Where the applicant files a representation of the design after being notified under r 8(1) that the application does not comply with the requirement that the dimensions of any specimen of the design filed under r 4(1)(b)(ii) must not exceed 29.7cm x 21cm x 1cm, then that representation is deemed to have been filed under r 4(1)(b)(i), and any specimen filed under r 4(1)(b)(ii) is treated as not having been filed (see PARA 707): r 5(4).

- 20 Registered Designs Rules 2006, SI 2006/1975, r 8(2).

- 21 Registered Designs Rules 2006, SI 2006/1975, r 8(3).

- 22 Registered Designs Rules 2006, SI 2006/1975, r 8(4).

- 23 Registered Designs Rules 2006, SI 2006/1975, r 8(5). The date on which the written reasons were sent to the applicant is deemed to be the date of the decision for the purposes of any appeal: r 8(6).

- 24 (1) for the reasons mentioned in the Registered Designs Rules 2006, SI 2006/1975, r 8(1)(a) or r 8(1)(b): see note 18.

- 25 Registered Designs Rules 2006, SI 2006/1975, r 9(1). 'Suitable representation' means a representation of the design which is suitable for publication: r 9(5).

- 26 Registered Designs Rules 2006, SI 2006/1975, r 9(2). See the Registered Designs Act 1949 s 3A(2); and the text and note 5. Where a suitable representation has been filed, the applicant must file his consent for its

publication on Form DF2C (r 9(3), Sch 1), but this does not apply where the applicant consented to publication in accordance with r 4(3): r 9(4). See note 19.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/709. Modification of applications for registration.

709. Modification of applications for registration.

The registrar¹ may, at any time before an application for the registration of a design² (or designs) is determined, permit the applicant to make such modifications of the application as the registrar thinks fit³.

Where, before it has been determined, an application for the registration of a design (or designs) has been modified in such a way that any design included in the application has been altered significantly, the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character⁴, direct that the application so far as relating to that design is to be treated as having been made on the date on which it was so modified⁵.

Where (1) an application for the registration of a design has disclosed more than one design and has been modified before it has been determined to exclude one or more designs from the application; and (2) a subsequent application for the registration of a design so excluded has, within such period (if any) as has been prescribed for such applications, been made by the person who made the earlier application or his successor in title, then the registrar may, for the purpose of deciding whether and to what extent the design is new or has individual character, direct that the subsequent application is to be treated as having been made on the date on which the earlier application was, or is treated as having been, made⁶.

Where the registration of a design has been refused⁷, the application for the design may be modified by the applicant if it appears to the registrar that the identity of the design is retained and that the modifications have been made in accordance with any rules made under the Registered Designs Act 1949⁸.

Any such modification may, in particular, be effected by making a partial disclaimer in relation to the application⁹.

An appeal lies from any decision of the registrar under the provisions described above¹⁰.

1 As to the registrar see PARA 684.

2 As to the meaning of 'design' see PARA 734.

3 Registered Designs Act 1949 s 3B(1) (s 3B added by SI 2001/3949; and amended by SI 2006/1974).

4 As to a design being new and having individual character see PARA 735.

5 Registered Designs Act 1949 s 3B(2) (as added and amended: see note 3).

6 Registered Designs Act 1949 s 3B(3) (as added and amended: see note 3). The period prescribed for the purposes of s 3B(3) is the period of two months beginning with the date on which the earlier application was modified under s 3B(3): Registered Designs Rules 2006, SI 2006/1975, r 10.

7 ie on the ground that the design does not fulfil the requirements of the Registered Designs Act 1949 s 1C or s 1D (see PARAS 737-739), or on the ground of refusal mentioned in Sch A1 (see PARA 708): see s 3A(4); and PARA 708.

8 Registered Designs Act 1949 s 3B(4) (as added and amended: see note 3). An application modified under s 3B(4) is to be treated as the original application and, in particular, as made on the date on which the original application was made or is treated as having been made: s 3B(5) (as so added).

9 Registered Designs Act 1949 s 3B(6) (as added and amended: see note 3). An application for the registration of a design may be accompanied by a disclaimer which (1) limits the scope or extent of protection

being applied for in relation to the design; or (2) indicates that the application for registration relates to a design that forms only a part of the appearance of a product: Registered Designs Rules 2006, SI 2006/1975, r 6.

10 Registered Designs Act 1949 s 3D (added by SI 2001/3949).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/710. Secrecy of certain designs.

710. Secrecy of certain designs.

Where an application for the registration of a design¹ has been made and it appears to the registrar² that the design is one of a class notified to him by the Secretary of State³ as relevant for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the design or the communication of such information to any person or class of persons specified in the directions⁴. The Secretary of State must by rules make provision for securing that, where such directions are given, the representation or specimen of the design is not open to public inspection at the UK Intellectual Property Office⁵ during the continuance in force of the directions⁶.

Where the registrar gives any such directions, he must give notice of the application and of the directions to the Secretary of State, and thereupon the following provisions have effect:

- 576 (1) the Secretary of State must, upon receipt of such notice, consider whether the publication of the design would be prejudicial to the defence of the realm and, unless a notice under head (3) below has previously been given by that authority to the registrar, must reconsider that question before the expiration of nine months from the date of filing of the application for registration of the design and at least once in every subsequent year⁷;
- 577 (2) for the above purpose, the Secretary of State may, at any time after the design has been registered or, with the consent of the applicant, at any time before the design has been registered, inspect the representation or specimen of the design filed in pursuance of the application⁸;
- 578 (3) if upon consideration of the design at any time it appears to the Secretary of State that the publication of the design would not, or would no longer, be prejudicial to the defence of the realm, he must give notice to the registrar to that effect⁹;
- 579 (4) on the receipt of any such notice the registrar must revoke the direction and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorised to be done by or under the Registered Designs Act 1949 in connection with the application or registration, whether or not that time has previously expired¹⁰.

1 As to the meaning of 'design' see PARA 734.

2 As to the registrar see PARA 684.

3 As to the Secretary of State see PARA 684.

4 Registered Designs Act 1949 s 5(1) (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 3(1), (2)). Failure to comply with such directions is an offence: see PARA 695. These provisions have little or no application in practice.

5 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 Registered Designs Act 1949 s 5(2) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 3(1), (3); and amended by SI 2001/3949). Whilst a direction under the Registered Designs Act 1949 s 5(1) in respect of a design remains in force, no representation or specimen of the design is open to inspection: Registered Designs Rules 2006, SI 2006/1975, r 28.

- 7 Registered Designs Act 1949 s 5(3)(a).
- 8 Registered Designs Act 1949 s 5(3)(b) (amended by SI 2001/3949).
- 9 Registered Designs Act 1949 s 5(3)(c).
- 10 Registered Designs Act 1949 s 5(3)(d).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/711. Filing abroad.

711. Filing abroad.

Except under the authority of a written permit granted by or on behalf of the registrar¹, no person resident in the United Kingdom² may make or cause to be made any application outside the United Kingdom for registration of a design of any prescribed class³ unless an application for the registration of the same design has been made in the United Kingdom not less than six weeks before the application outside the United Kingdom, and either no directions have been given⁴ in relation to the application in the United Kingdom or all such directions have been revoked⁵. These provisions do not, however, apply in relation to a design for which an application for protection has first been filed in a country outside the United Kingdom by a person resident outside the United Kingdom⁶.

1 As to the registrar see PARA 684.

2 As to the meaning of 'United Kingdom' see PARA 303 note 5. As to the territorial scope of the Registered Designs Act 1949 see PARA 683.

3 I.e. any class which may be prescribed for the purposes of the Registered Designs Act 1949 s 5(4): see PARA 710. 'Prescribed' means prescribed by rules made by the Secretary of State: s 44(1). At the date at which this volume states the law no such rules had been made.

4 I.e. directions of the registrar under the Registered Designs Act 1949 s 5(1): see PARA 710.

5 Registered Designs Act 1949 s 5(4).

6 Registered Designs Act 1949 s 5(4) proviso.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/712. Applications under international convention.

712. Applications under international convention.

Certain countries which are parties to the International Convention for the Protection of Industrial Property¹ are declared to be convention countries for the purposes of the Registered Designs Act 1949². An application for registration of a design (or designs)³ in respect of which protection has been applied for in a convention country may be made by the person by whom the application for protection was made or his personal representative⁴ or assignee⁵; but no application may be so made after the expiration of six months⁶ from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application⁷.

Where an application for registration of a design or designs is made in this way, the application is to be treated, for the purpose of determining whether (and to what extent) that or any other design is new or has individual character, as made on the date of the application for protection in the convention country or, if more than one such application was made, on the date of the first such application⁸.

Where a person has applied for protection for a design or designs by an application which:

- 580 (1) in accordance with the terms of a treaty subsisting between two or more convention countries is equivalent to an application duly made in any one of those convention countries; or
- 581 (2) in accordance with the law of any convention country is equivalent to an application duly made in that convention country,

he is deemed to have applied in that convention country⁹.

1 I.e. the International Convention further revising the Paris Convention for the Protection of Industrial Property of 20 March 1883 (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431).

2 See the Registered Designs Act 1949 s 13; and PARA 683.

3 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

4 For these purposes, 'personal representative', in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside the United Kingdom: Registered Designs Act 1949 s 44(4) (amended by SI 2001/3949). As to the meaning of 'United Kingdom' see PARA 303 note 5. As to the territorial scope of the Registered Designs Act 1949 see PARA 683.

5 For these purposes, 'assignee' includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person: Registered Designs Act 1949 s 44(1).

6 There is no power to extend the time limit in individual cases, but rules may be made providing for extensions by reciprocal arrangement with other convention countries, in special circumstances: see the Registered Designs Act 1949 s 15 (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 8; and SI 2001/3949). At the date at which this volume states the law no such rules were in force.

7 Registered Designs Act 1949 s 14(1) (amended by SI 2006/1974). As to the date of registration, and as to protection from prior publication and registration, see PARA 714. As to the priority given to a convention application see *Deyhle's Design Applications* [1982] RPC 526, Registered Designs Appeal Tribunal; and PARA 713.

8 Registered Designs Act 1949 s 14(2) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 7; and amended by SI 2001/3949; SI 2006/1974). This is not to be construed as excluding the power to give directions under the Registered Designs Act 1949 s 3B(2) or s 3B(3) (see PARA 709) in relation to an application made by virtue of s 14: s 14(3) (amended by SI 2001/3949). As to the circumstances in which a design based on an application in a convention country can be registered under the Registered Designs Act 1949 s 14 with the priority date of the foreign application see *Deyhle's Design Applications* [1982] RPC 526, Registered Designs Appeal Tribunal. Patent priority may not, however, be claimed from a foreign design application: see *Agfa-Gevaert AG's Application* [1982] RPC 441. There is no power to postdate a convention application: *Allibert Exploitation's Application* [1978] RPC 261, Registered Designs Appeal Tribunal.

9 Registered Designs Act 1949 s 14(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(3) PROCEDURE FOR REGISTRATION OF CURRENT DESIGNS/713. Requisites for convention application.

713. Requisites for convention application.

Where an application for the registration of a design or designs¹ is made² the applicant must comply with the following requirements³. The application must contain a declaration specifying both the date of making of each convention application and the country it was made in or in respect of⁴. The applicant must, before the end of the period of three months beginning with the date on which the application was filed, file at the UK Intellectual Property Office⁵ a copy of the representation of the design that was the subject of each convention application⁶. A copy of the representation must either be duly certified by the authority with which it was filed, or be verified to the satisfaction of the registrar⁷. Where any document relating to the convention application is in a language other than English or Welsh, the registrar may direct the applicant to provide a translation of the whole or any part of that document⁸, and the translation must be filed before the end of the period of three months beginning with the date of the direction⁹.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 I.e. a convention application by virtue of the Registered Designs Act 1949 s 14: see PARA 712. A 'convention application' means an application for the protection of a design which has been made in a convention country: Registered Designs Rules 2006, SI 2006/1975, r 7(9).

3 Registered Designs Rules 2006, SI 2006/1975, r 7(1).

4 Registered Designs Rules 2006, SI 2006/1975, r 7(2).

5 The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

6 Registered Designs Rules 2006, SI 2006/1975, r 7(3).

7 Registered Designs Rules 2006, SI 2006/1975, r 7(4). However, this does not apply where a copy of the convention application is kept at the UK Intellectual Property Office: r 7(5). Where the applicant fails to file a copy of the representation of the design which has been certified or verified in accordance with r 7(4), the convention application is to be disregarded for the purposes of the Registered Designs Act 1949 s 14(2) (see PARA 712): Registered Designs Rules 2006, SI 2006/1975, r 7(8).

8 Registered Designs Rules 2006, SI 2006/1975, r 7(6). Where the applicant fails to comply with a direction given under r 7(6), the convention application is to be disregarded for the purposes of the Registered Designs Act 1949 s 14(2) (see PARA 712): Registered Designs Rules 2006, SI 2006/1975, 7(8).

9 Registered Designs Rules 2006, SI 2006/1975, r 7(7).

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(4) DURATION, RESTORATION AND SURRENDER

(i) Registration and its Duration

714. Date of registration.

In general, a design¹, when registered, is registered as of the date on which the application was made or is treated as having been made². However, this rule does not apply to registrations of designs where application for protection in a convention country has been made, or where an application for registration has been modified³.

1 This provision applies both to current designs and old designs by virtue of the Registered Designs Regulations 2001, SI 2001/3949, reg 12(4), (6). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 Registered Designs Act 1949 s 3C(1) (s 3C added by SI 2001/3949). As to applications for registration see PARA 707.

3 The Registered Designs Act 1949 s 3C(1) does not apply to an application which is treated as having been made on a particular date by s 14(2) (see PARA 712) or by virtue of the operation of s 3B(3) or s 3B(5) (see PARA 709) by reference to s 14(2): s 3C(2) (as added: see note 2). A design, when registered, is registered as of:

- 16 (1) in the case of an application which is treated as having been made on a particular date by s 14(2), the date on which the application was made (s 3C(3)(a) as so added);
- 17 (2) in the case of an application which is treated as having been made on a particular date by virtue of the operation of s 3B(3) by reference to s 14(2), the date on which the earlier application was made (s 3C(3)(b) as so added);
- 18 (3) in the case of an application which is treated as having been made on a particular date by virtue of the operation of s 3B(5) by reference to s 14(2), the date on which the original application was made (s 3C(3)(c) as so added).

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715. Certificate of registration.

The registrar¹ must grant a certificate of registration in the prescribed form to the registered proprietor² of a design³ when the design is registered⁴. The certificate of registration of a design must include: (1) the name of the registered proprietor; (2) the date of registration; and (3) the registration number of the design⁵.

When a design has been registered, the registrar must publish a representation of that design in the journal as soon as possible after the certificate of registration is granted⁶.

In a case where he is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he thinks it expedient, the registrar may furnish one or more copies of the certificate⁷. Any request by the registered proprietor for a copy of the certificate of registration must be in writing and be accompanied by the prescribed fee⁸. Before considering the request, the registrar may require the person making the request to provide such information or evidence as the registrar thinks fit⁹.

1 As to the registrar see PARA 684.

2 As to the proprietorship of registered designs see PARA 722.

3 This provision applies both to current designs and old designs by virtue of the Registered Designs Regulations 2001, SI 2001/3949, reg 12(4), (6). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

4 Registered Designs Act 1949 s 18(1).

5 Registered Designs Rules 2006, SI 2006/1975, r 26(1). Certificates of registration of old designs were governed by the corresponding provisions of the Registered Designs Rules 1995, SI 1995/2912 (revoked).

6 Registered Designs Rules 2006, SI 2006/1975, r 11(1), (3). When the registrar publishes the representation, he may also publish any other information he thinks is relevant to that design: r 11(2).

7 Registered Designs Act 1949 s 18(2).

8 Registered Designs Rules 2006, SI 2006/1975, r 26(2).

9 Registered Designs Rules 2006, SI 2006/1975, r 26(3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(4) DURATION, RESTORATION AND SURRENDER/(i) Registration and its Duration/716. Duration of right in registered design.

716. Duration of right in registered design.

The right in a registered design subsists in the first instance for a period of five years from the date of the registration of the design¹. The period for which the right subsists may be extended for a second, third, fourth and fifth period of five years, by applying to the registrar for an extension and paying the prescribed renewal fee². If the first, second, third or fourth period expires without such application and payment being made, the right ceases to have effect; and the registrar must notify the proprietor³ of that fact⁴. If during the period of six months immediately following the end of that period an application for extension is made and the prescribed renewal fee and any prescribed additional fee are paid, the right is treated as if it had never expired, with the result that:

- 582 (1) anything done under or in relation to the right during that further period is treated as valid⁵;
- 583 (2) an act which would have constituted an infringement of the right if it had not expired is treated as an infringement⁶; and
- 584 (3) an act which would have constituted use of the design for the services of the Crown⁷ if it had not expired is treated as such use⁸.

1 Registered Designs Act 1949 s 8(1) (s 8 substituted by the Copyright, Designs and Patents Act 1988 s 269(1)). As to the date of registration see PARA 715. As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

In relation to old designs, the Registered Designs Act 1949 s 8 is subject to the proviso that the right in a design registered for further articles by virtue of the Registered Designs Act 1949 s 4 (now repealed) does not, however, extend beyond the end of the period, and any extended period, for which the right subsists in the original registered design: s 8(6) (as so substituted; repealed in relation to current designs); Registered Designs Regulations 2001, SI 2001/3949, reg 12(9).

2 Registered Designs Act 1949 s 8(2) (as substituted: see note 1). An application for an extension under s 8(2) or s 8(4) must be made on Form DF9A: Registered Designs Rules 2006, SI 2006/1975, r 12(1), Sch 1. An application under the Registered Designs Act 1949 s 8(2) may only be made during the period of six months ending with the date on which the relevant period of five years expires: Registered Designs Rules 2006, SI 2006/1975, r 12(2). On receipt of the prescribed renewal fee the registrar must notify the registered proprietor of the extension of the right in the registered design: r 12(3). As to fees see PARA 686. As to the registrar see PARA 684.

3 As to the proprietorship of registered designs see PARA 722.

4 Registered Designs Act 1949 s 8(3) (as substituted: see note 1). Where the right in a registered design has ceased to have effect by reason of s 8(3), the registrar must, before the end of the period of six weeks beginning with the date on which the right ceased, send written notice to the registered proprietor of that fact: Registered Designs Rules 2006, SI 2006/1975, r 12(4). However, this does not apply where the renewal fee and the prescribed additional fee is paid before a notice is sent: r 12(5).

5 Registered Designs Act 1949 s 8(4)(a) (as substituted: see note 1).

6 Registered Designs Act 1949 s 8(4)(b) (as substituted: see note 1). As to infringement see PARA 762 et seq.

7 As to Crown use see PARA 728 et seq.

8 Registered Designs Act 1949 s 8(4)(c) (as substituted: see note 1).

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(ii) Restoration of Lapsed Designs

717. Restoration of lapsed right in designs.

Where the right in a registered design¹ has expired by reason of a failure to extend² the period for which the right subsists, an application for the restoration of the right in the design may be made to the registrar³ within 12 months from the date on which the right in the registered design expired⁴. The application may be made by the person who was the registered proprietor⁵ of the design or by any other person who would have been entitled to the right in the design if it had not expired; and, where the design was held by two or more persons jointly, the application may, with the leave of the registrar, be made by one or more of them without joining the others⁶. The registrar must enter in the register⁷ notice of the application and must publish such notice in the Official Journal (Patents)⁸.

If the registrar is satisfied that failure of the proprietor to see that the period for which the right subsisted was extended was unintentional, he must, on payment of any unpaid renewal fee and any prescribed additional fee⁹, order the restoration of the right in the design¹⁰. The order may be made subject to such conditions as the registrar thinks fit; and, if the proprietor of the design does not comply with any condition, the registrar may revoke the order and give such consequential directions as he thinks fit¹¹.

Where, however, upon consideration of that evidence, the registrar is not satisfied that a case for an order¹² has been made out, he must notify the applicant accordingly¹³. The applicant may, before the end of the period of one month beginning with the date of that notification, request to be heard by the registrar¹⁴. Where the applicant requests such a hearing, the registrar must give him an opportunity to be heard; after which the registrar must determine whether the application is to be granted or refused¹⁵. Where the registrar decides not to make the order he must give the applicant written reasons for his refusal¹⁶.

1 The provisions in the Registered Designs Act 1949 s 8A with regard to restoration of lapsed current designs apply equally to old designs: see the Registered Designs Regulations 2001, SI 2001/3949, reg 12(4). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 I.e. in accordance with the Registered Designs Act 1949 s 8(2) or s 8(4): see PARA 716.

3 As to the registrar see PARA 684.

4 Registered Designs Act 1949 s 8A(1) (s 8A added by the Copyright, Designs and Patents Act 1988 s 269(1)); Registered Designs Rules 2006, SI 2006/1975, r 13(2). Rules altering the period for the purposes of the Registered Designs Act 1949 s 8A(1) may contain such transitional provisions and savings as appear to the Secretary of State to be necessary or expedient: s 8A(6). An application for the restoration of the right in a design under the Registered Designs Act 1949 s 8A must be made on Form DF29, and be supported by evidence of the statements made in the application: Registered Designs Rules 2006, SI 2006/1975, r 13(1), Sch 1.

5 As to the proprietorship of registered designs see PARA 722.

6 Registered Designs Act 1949 s 8A(2) (as added: see note 4).

7 As to the register see PARA 699 et seq.

8 Registered Designs Act 1949 s 8A(3) (as added: see note 4); Registered Designs Rules 2006, SI 2006/1975, r 13(3). As to the Journal see r 44; and PARA 580.

9 As to fees see PARA 686.

10 Registered Designs Act 1949 s 8A(4) (as added (see note 4); amended by SI 2006/1974). As to the effect of an order for restoration of the right in a registered design see PARA 718.

11 Registered Designs Act 1949 s 8A(5) (as added: see note 4).

12 le an order under the Registered Designs Act 1949 s 8A.

13 Registered Designs Rules 2006, SI 2006/1975, r 13(4).

14 Registered Designs Rules 2006, SI 2006/1975, r 13(5).

15 Registered Designs Rules 2006, SI 2006/1975, r 13(6).

16 Registered Designs Rules 2006, SI 2006/1975, r 13(7).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(4) DURATION, RESTORATION AND SURRENDER/(ii) Restoration of Lapsed Designs/718. Effect of restoration of right order.

718. Effect of restoration of right order.

Where an order for the restoration of the right in a registered design¹ is made², anything done under or in relation to the right during the period between expiry and restoration is treated as valid³; and anything done during that period which would have constituted an infringement if the right had not expired is treated as an infringement⁴:

- 585 (1) if done at a time when it was possible for an application for an extension to be made⁵; or
- 586 (2) if it was a continuation or repetition of an earlier infringing act⁶.

If, after it was no longer possible for such an application for extension to be made and before publication of notice of the application for restoration⁷, a person:

- 587 (a) began in good faith to do an act which would have constituted an infringement of the right in the design if it had not expired; or
- 588 (b) made in good faith effective and serious preparations to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the right in the design; but this does not extend to granting a licence to another person to do the act⁸.

If, however, the act was done, or the preparations were made, in the course of a business, the person entitled to such right may:

- 589 (i) authorise the doing of that act by any partners of his for the time being in that business; and
- 590 (ii) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made⁹.

The above provisions apply in relation to the use of a registered new design for the services of the Crown as they apply in relation to infringement of the right in the design¹⁰.

¹ The provisions in the Registered Designs Act 1949 s 8B apply to both current designs and old designs: see the Registered Designs Regulations 2001, SI 2001/3949, reg 12(4). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

² ie under the Registered Designs Act 1949 s 8A: see PARA 717.

³ Registered Designs Act 1949 s 8B(1), (2) (s 8B added by the Copyright, Designs and Patents Act 1988 s 269).

⁴ As to what constitutes infringement see PARA 762 et seq.

⁵ ie under the Registered Designs Act 1949 s 8(4): see PARA 716.

⁶ Registered Designs Act 1949 s 8B(1), (3) (as added: see note 3).

7 As to publication of the notice see PARA 717.

8 Registered Designs Act 1949 s 8B(1), (4) (as added: see note 3). Where a product is disposed of to another in exercise of the rights conferred by the Registered Designs Act 1949 s 8B(4) or s 8B(5), that other and any other person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the design: s 8B(6) (as so added; and amended by SI 2001/3949). As to the meaning of 'product' see PARA 734 note 1. As to the proprietorship of registered designs see PARA 722.

9 Registered Designs Act 1949 s 8B(1), (5) (as added: see note 3). See also note 8.

10 Registered Designs Act 1949 s 8B(1), (7) (as added: see note 3). As to Crown use see PARA 728 et seq.

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(iii) Correction; Rectification; Voluntary Cancellation

719. Corrections.

The registrar¹ may correct any error in an application for the registration, or in the representation of a design², or any error in the register of designs³. A correction may be so made either upon a request in writing made by any person interested and accompanied by the prescribed fee⁴, or without such a request⁵. Where, however, he proposes to make any such correction otherwise than in pursuance of a request, the registrar must give notice of the proposal to the registered proprietor⁶ or the applicant for registration of the design, as the case may be, and to any other person who appears to him to be concerned, and must give them an opportunity to be heard before making the correction⁷.

Any person may request⁸ that an alteration to his name or address be entered in the register or be made to any application or other document filed at the UK Intellectual Property Office⁹. Where the registrar has doubts about whether he should make the alteration to a name or address he must inform the person making the request of the reason for his doubts, and he may require that person to furnish evidence in support of the request¹⁰. Where the registrar has no doubts (or no longer has doubts) about whether he should make the alteration, it must be entered in the register or made to the application or document¹¹.

1 As to the registrar see PARA 684.

2 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

3 Registered Designs Act 1949 s 21(1); applied to old designs by the Registered Designs Regulations 2001, SI 2001/3949, reg 12(4). As to the register of designs see PARA 699 et seq.

4 As to fees see PARA 686.

5 Registered Designs Act 1949 s 21(2).

6 As to the proprietorship of registered designs see PARA 722.

7 Registered Designs Act 1949 s 21(3).

8 The request in relation to an alteration to his name must be made on Form DF16A; and in relation to his address, must be made on Form DF16A or in writing: Registered Designs Rules 2006, SI 2006/1975, r 34(2), Sch 1.

9 Registered Designs Rules 2006, SI 2006/1975, r 34(1). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

10 Registered Designs Rules 2006, SI 2006/1975, r 34(3).

11 Registered Designs Rules 2006, SI 2006/1975, r 34(4).

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720. Rectification by court order.

On the application of the relevant person¹, the court² may order the register of designs³ to be rectified by the making of an entry in it or the variation or deletion of any entry in it⁴. Applications fall into two classes: those affecting the proprietorship of the design⁵; and those affecting its validity. Orders which may be made by the court include, in particular, declarations of partial invalidity⁶.

Notice of the application must be given in the prescribed form to the registrar⁷, who is entitled to appear and be heard on the application and must appear if so directed by the court⁸. Any order so made by the court must direct that notice of the order be served on the registrar⁹; and, on receipt of the notice, the registrar must rectify the register accordingly¹⁰.

A rectification of the register under the above provisions has effect as follows:

- 591 (1) an entry made has effect from the date on which it should have been made;
- 592 (2) an entry varied has effect as if it had originally been made in its varied form;
and
- 593 (3) an entry deleted is deemed never to have had effect,

unless, in any case, the court directs otherwise¹¹.

1 'Relevant person' means, in relation to current designs:

- 19 (1) in the case of an application invoking any ground referred to in the Registered Designs Act 1949 s 11ZA(1)(c) (see PARA 757), any person concerned by the use in question (s 20(1A)(a) (added by SI 2001/3949; and amended by SI 2006/1974));
- 20 (2) in the case of an application invoking the ground mentioned in the Registered Designs Act 1949 s 11ZA(1A) (see PARA 757), the appropriate person (s 20(1A)(b) (added by SI 2001/3949; and amended by SI 2006/1974));
- 21 (3) in the case of an application invoking any ground mentioned in the Registered Designs Act 1949 s 11ZA(2), (3) or (4) (see PARA 757) the person able to make the objection (s 20(1A)(c) (added by SI 2001/3949)).

In relation to old designs and in relation to current designs in any case other than those mentioned in heads (1)-(3), 'relevant person' is any person aggrieved: Registered Designs Act 1949 s 20(1A)(d) (added by SI 2001/3949); applied to old designs by the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (4).

'Appropriate person' means, in relation to an earlier design protected by virtue of registration under the Registered Designs Act 1949 or EC Council Regulation 6/2002 of 13 December 2001 on Community Designs (OJ L 3, 5.1.2002, p 1) or an application for such registration, the registered proprietor of the design, the holder of the registered community design or (as the case may be) the applicant: Registered Designs Act 1949 s 20(1B) (added by SI 2001/3949; amended by SI 2003/550).

'Person aggrieved' is widely interpreted and generally includes any person who is, or probably might be, injured or affected by the error, entry or omission in question: see *Re Read and Greswell's Design* (1889) 42 Ch D 260, 6 RPC 471.

2 As to the meaning of 'court' see PARA 691.

3 As to the register of designs see PARA 699 et seq.

4 Registered Designs Act 1949 s 20(1) (amended by SI 2001/3949). See *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, Patents County Court.

In proceedings under the Registered Designs Act 1949 s 20 the court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register: s 20(2). As to the procedure see CPR 63; *Practice Direction--Patents and other Intellectual Property Claims* PD 63. As to counterclaims for rectification in an infringement action see PARA 769; and as to applications to the registrar for cancellation see PARA 758.

5 Where an agent had by mistake registered a design under his own name, rectification was granted: see *Re Guiterman's Registered Designs* (1885) 55 LJ Ch 309; *Re Grocott's Design* (1899) 17 RPC 139. See also *Leara Trading Co Ltd's Designs* [1991] RPC 609.

6 Registered Designs Act 1949 s 20(6) (added by SI 2001/3949). Where a claim is made for the rectification of the register of designs, the claimant must at the same time as serving the other parties, serve a copy of the claim form and accompanying documents on the Comptroller or registrar, as appropriate: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 16.1. Where documents are thus served on the Comptroller or registrar, he is entitled to take part in the proceedings: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 16.2.

7 The prescribed manner of giving notice to the registrar for the purposes of the Registered Designs Act 1949 s 20(3) is by giving written notice: Registered Designs Rules 2006, SI 2006/1975, r 35(1). As to the registrar see PARA 684.

8 Registered Designs Act 1949 s 20(3). The registrar does not in general appear, but, if he does, the unsuccessful party will in general be ordered to pay his costs, and, even if he does not, a sum is ordered to be paid to cover his costs of considering the application: see *Re Saxton, Chatterton & Co's Design* (1914) 32 RPC 331; *Re Kestos Ltd Registered Design (No 725,716), Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp* (1935) 53 RPC 139 at 158.

9 The prescribed manner of service on the registrar for the purposes of the Registered Designs Act 1949 s 20(4) is by filing a copy of the order at the UK Intellectual Property Office: Registered Designs Rules 2006, SI 2006/1975, r 35(2). The UK Intellectual Property Office is an operating name of the Patent Office: see the UK Intellectual Property Office Name Change Fact Sheet; and PARA 579.

10 Registered Designs Act 1949 s 20(4).

11 Registered Designs Act 1949 s 20(5) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 11).

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721. Voluntary cancellation.

The registrar¹ may, upon a request made in the prescribed manner² by the registered proprietor³, cancel the registration of a design⁴. The registered proprietor may thus save costs by surrendering his design rather than become a party to legal proceedings⁵. A cancellation of registration takes effect from the date of the registrar's decision or from such other date as the registrar may direct⁶.

1 As to the registrar see PARA 684.

2 A request to cancel the registration of a design must be made on Form DF19C: Registered Designs Rules 2006, SI 2006/1975, r 14, Sch 1.

3 As to the proprietorship of registered designs see PARA 722.

4 Registered Designs Act 1949 s 11 (substituted by SI 2001/3949). An appeal lies from any decision of the registrar under the Registered Designs Act 1949 s 11: s 11ZF (added by SI 2001/3949).

5 As to rectification by court order see PARA 720.

6 Registered Designs Act 1949 s 11ZE(1) (added by SI 2001/3949). An appeal lies from any decision of the registrar under the Registered Designs Act 1949 s 11ZE: s 11ZF (as added: see note 4).

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(5) OWNERSHIP; ASSIGNMENT; LICENCES; CROWN USE

(i) Ownership

722. Proprietorship of registered designs.

The author¹ of a design² is generally treated for the purposes of the Registered Designs Act 1949 as the original proprietor of the design³. However, there are exceptions to this rule. Where a design is created in pursuance of a commission for money or money's worth, the person commissioning the design is treated as the original proprietor of the design⁴. Where a design is created by an employee in the course of his employment, his employer is treated as the original proprietor of the design⁵.

Where a design becomes vested, whether by assignment, transmission or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor⁶, that other person, or as the case may be the original proprietor and that other person, must be treated as the proprietor of the design⁷.

1 'Author' of a design means the person who creates it: Registered Designs Act 1949 s 2(3) (added by the Copyright Designs and Patents Act 1988 s 267). In the case of a design generated by computer in circumstances such that there is no human author, the person by whom the arrangements necessary for the creation of the design are made is to be taken to be the author: Registered Designs Act 1949 s 2(4) (substituted by the Copyright Designs and Patents Act 1988 s 267).

2 As to the meaning of 'design' see PARA 734.

3 Registered Designs Act 1949 s 2(1) (substituted by the Copyright Designs and Patents Act 1988 s 267).

4 Registered Designs Act 1949 s 2(1A) (added by the Copyright Designs and Patents Act 1988 s 267).

5 Registered Designs Act 1949 s 2(1B) (added by the Copyright Designs and Patents Act 1988 s 267). This exception only applies in a case not falling within the Registered Designs Act 1949 s 2(1A): see s 2(1B). For these purposes, 'employee', 'employment' and 'employer' refer to employment under a contract of service or of apprenticeship: Registered Designs Act 1949 s 44(1) (definition amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 31(1), (8)).

6 This would appear to include a licensee: cf *Woolley v Broad* [1892] 1 QB 806, 9 RPC 208, DC.

7 Registered Designs Act 1949 s 2(2) (amended by SI 2001/3949). See also *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, Patents County Court.

UPDATE

722 Proprietorship of registered designs

NOTE 7--See *Ifejika v Ifejika* [2010] EWCA Civ 563, [2010] All ER (D) 258 (May).

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(ii) Assignment and Devolution

723. Property in and dealing with registered designs and applications.

A registered design¹ or an application for a registered design² is personal property³ and is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal property⁴.

Any transmission of a registered design or an application for a registered design is subject to any rights vested in any other person of which notice is entered in the register of designs⁵, or in the case of applications, notice is given to the registrar⁶. An assignment⁷ of, or an assent relating to, a registered design or application for a registered design is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative⁸.

A registered design or application for a registered design may be the subject of a charge in the same way as other personal property⁹.

The proprietor of a registered design may grant a licence to use that registered design¹⁰.

Any equities in respect of a registered design or an application for a registered design may be enforced in like manner as in respect of any other personal property¹¹.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 As to applications see PARA 722 et seq.

3 Registered Designs Act 1949 s 15A (ss 15A-15C added by SI 2006/1028). See **PERSONAL PROPERTY** vol 35 (Reissue) PARA 1204.

4 Registered Designs Act 1949 s 15B(1) (as added: see note 3). See **PERSONAL PROPERTY** vol 35 (Reissue) PARA 1249 et seq.

5 As to the register of designs see PARA 699.

6 Registered Designs Act 1949 s 15B(2) (as added: see note 3). As to the registrar see PARA 684.

7 The Registered Designs Act 1949 s 15B(3), (4) (see the text and note 8) apply to assignment by way of security as in relation to any other assignment: s 15B(5) (as added: see note 3).

8 Registered Designs Act 1949 s 15B(3) (as added: see note 3). This requirement may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal: s 15B(4) (as added: see note 3).

9 Registered Designs Act 1949 s 15B(6) (as added: see note 3). See **CHOSES IN ACTION** vol 13 (2009) PARA 26.

10 Registered Designs Act 1949 s 15B(7) (as added: see note 3).

11 Registered Designs Act 1949 s 15B(8) (as added: see note 3).

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(iii) Licences

724. Licences.

There are no special requirements relating to the grant of licences in respect of a registered design¹. An 'exclusive licence' is a licence in writing signed by or on behalf of the proprietor of the registered design authorising the licensee to the exclusion of all other persons, including the person granting the licence to exercise a right which would otherwise be exercisable exclusively by the proprietor². The licensee under an exclusive licence has the same rights against any successor in title who is bound by the licence as he has against the person granting the licence³ and has, except as against the registered proprietor, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment⁴.

1 In relation to old designs (see PARA 740), any licence which: (1) permits anything which would otherwise be an infringement under the Registered Designs Act 1949 of the right in a registered design or the copyright in a registered design; and (2) was granted by the registered proprietor of the design, or under s 10 or s 11A (see PARA 725), before 9 December 2001, continues in force, with necessary modifications, on or after that date: Registered Design Regulations 2001, SI 2001/3949, reg 14(1). In determining the effect of any such licence, regard must be had to the purpose for which the licence was granted; and, in particular, a licence granted for the full term or extent of the right in a registered design or the copyright in a registered design is to be treated as applying, subject to its other terms and conditions, to the full term or extent of that right as extended by virtue of the Registered Design Regulations 2001, SI 2001/3949: reg 14(2).

2 Registered Designs Act 1949 s 15C(1) (s 15C added by SI 2006/1028). See note 1. Cf an exclusive licensee under a patent: see PARA 380 note 7.

3 Registered Designs Act 1949 s 15C(2) (as added: see note 2). See note 1.

4 Registered Designs Act 1949 s 24F(1) (added by SI 2006/1028). See note 1. As to the rights and remedies of the exclusive licensee see PARA 768.

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(iv) Compulsory Licences

725. Powers exercisable for the protection of the public interest.

Where a report of the Competition Commission¹ has been laid before Parliament containing conclusions to the effect:

- 594 (1) on a competition reference, that a person was engaged in an anti-competitive practice which operated or may be expected to operate against the public interest; or
- 595 (2) on a reference of public bodies and certain other persons², that a person is pursuing a course of conduct which operates against the public interest,

the appropriate minister or ministers³ may apply to the registrar⁴ to take action under these provisions⁵.

Before making such an application, the appropriate minister or ministers must publish, in such manner as he or they think appropriate, a notice describing the nature of the proposed application and must consider any representations which may be made within 30 days of such publication by persons whose interests appear to him or them to be affected⁶.

If on such an application it appears to the registrar that the matters specified in the Commission's report as being those which in the Commission's opinion operate, or operated or may be expected to operate, against the public interest include conditions in licences granted in respect of a registered design by its proprietor⁷ restricting the use of the design by the licensee or the right of the proprietor to grant other licences, he may by order cancel or modify any such condition⁸.

An appeal lies from any order of the registrar to the Appeal Tribunal⁹.

1 As to the Competition Commission see **COMPETITION** vol 18 (2009) PARA 9 et seq.

2 Ie a reference under the Competition Act 1980 s 11: see **COMPETITION** vol 18 (2009) PARA 10.

3 For these purposes, 'appropriate minister or ministers' means the minister or ministers to whom the report of the Competition Commission was made: Registered Designs Act 1949 s 11A(7) (s 11A added by the Copyright, Designs and Patents Act 1988 s 270; the Registered Designs Act 1949 s 11A(7) amended by SI 1999/506).

4 As to the registrar see PARA 684.

5 Registered Designs Act 1949 ss 11A(1) (as added (see note 3); and amended by the Enterprise Act 2002 s 278, Sch 25 para 1(1), (2), Sch 26; and SI 1999/506).

6 Registered Designs Act 1949 ss 11A(2) (as added: see note 3).

7 As to the proprietorship of registered designs see PARA 722. As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

8 Registered Designs Act 1949 s 11A(3) (as added (see note 3); and amended by SI 2001/3949); Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4).

9 Registered Designs Act 1949 s 11A(6) (as added: see note 3), s 28(1). As to the Appeal Tribunal see PARAS 692-693.

UPDATE

725 Powers exercisable for the protection of the public interest

NOTE 2--Competition Act 1980 s 11 amended: SI 2009/1941.

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726. Powers exercisable following merger and market investigations.

The Competition Commission¹ or, as the case may be, the Secretary of State² may apply to the registrar³ to take action⁴ where:

- 596 (1) the provisions of the Enterprise Act 2002 relating to powers to take remedial action following merger or market investigations⁵ apply⁶;
- 597 (2) the Competition Commission or, as the case may be, the Secretary of State considers that it would be appropriate to make an application⁷ for the purpose of remedying, mitigating or preventing a matter which cannot be dealt with under the enactment concerned⁸; and
- 598 (3) the matter concerned involves conditions in licences granted in respect of a registered design by its proprietor⁹ restricting the use of the design by the licensee or the right of the proprietor to grant other licences¹⁰.

Before making an application the Competition Commission or, as the case may be, the Secretary of State must publish, in such manner as it or he thinks appropriate, a notice describing the nature of the proposed application and must consider any representations which may be made within 30 days of such publication by persons whose interests appear to it or him to be affected¹¹.

The registrar may, if it appears to him on an application that the application is made in accordance with the above provisions, by order cancel or modify any condition concerned of the kind mentioned in head (3) above¹². An appeal lies from any order of the registrar¹³.

1 As to the Competition Commission see **COMPETITION** vol 18 (2009) PARA 9 et seq. References to the Competition Commission, in cases where the Enterprise Act 2002 s 75(2) applies, are to be read as references to the Office of Fair Trading: Registered Designs Act 1949 s 11AB(6) (s 11AB added by the Enterprise Act 2002 s 278, Sch 25 para 1(1), (3)).

2 As to the Secretary of State see PARA 684.

3 As to the registrar see PARA 684.

4 Registered Designs Act 1949 s 11AB(2) (as added: see note 1). References in the Enterprise Act 2002 s 35, 36, 47, 63, 134 or 141 (questions to be decided by the Competition Commission in its reports) to taking action under s 41(2), 55, 66, 138 or 147 (see **COMPETITION**) include references to taking action under the Registered Designs Act 1949 s 11AB(2): s 11AB(7) (as added: see note 1). See also the Enterprise Act 2002 (Protection of Legitimate Interests) Order 2003, SI 2003/1592, art 16, Sch 4 para 2.

5 I.e. the Enterprise Act 2002 s 41(2), 55(2), 66(6), 75(2), 83(2), 138(2), 147(2) or s 160(2), or Sch 7 paras 5(2), 10(2): see **COMPETITION**.

6 Registered Designs Act 1949 s 11AB(1)(a) (as added: see note 1). An order made by virtue of s 11AB in consequence of action under s 11AB(2) (see the text to notes 1-4) where an enactment mentioned in s 11AB(1)(a) applies is to be treated, for the purposes of the Enterprise Act 2002 ss 91(3), 92(1)(a), 162(1) and 166(3) (duties to register and keep under review enforcement orders etc) (see **COMPETITION**), as if it were made under the relevant power in Pt 3 (ss 22-130) or (as the case may be) Pt 4 (ss 131-184) to make an enforcement order (within the meaning of the Part concerned): Registered Designs Act 1949 s 11AB(8) (as added: see note 1).

7 I.e. under the Registered Designs Act 1949 s 11AB.

- 8 Registered Designs Act 1949 s 11AB(1)(b) (as added: see note 1).
- 9 As to the proprietorship of registered designs see PARA 722. As to the meaning of 'registered design' see PARA 681.
- 10 Registered Designs Act 1949 s 11AB(1)(c) (as added: see note 1).
- 11 Registered Designs Act 1949 s 11AB(3) (as added: see note 1).
- 12 Registered Designs Act 1949 s 11AB(4) (as added: see note 1).
- 13 Registered Designs Act 1949 s 11AB(5) (as added: see note 1). As to appeals see PARAS 692-694.

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727. War emergency licensing.

Where an enemy or enemy subject is the proprietor of a registered design, the comptroller¹ may grant a licence in respect of the design to any person who is not an enemy or an enemy subject². The comptroller must, however, be satisfied that the would-be licensee³ desires to apply the design and is in a position to do so, and that the licence would be in the interest of all or any of Her Majesty's subjects⁴. Licences may be granted on any terms which the comptroller thinks fit, may be exclusive and may be made notwithstanding the existence of any other licence⁵. The comptroller has a general discretion to vary or revoke licences⁶. A licensee may sue for infringement⁷.

1 Ie the registrar for the purposes of the Registered Designs Act 1949: see PARA 684.

2 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(1). See further PARA 401 where this enactment, which extends similarly to patents and copyrights of enemies, is more fully discussed.

3 Application must be made by the would-be licensee and accompanied where necessary by evidence and a statement setting out the principal conditions of the proposed licence: see the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 ss 2(1), 9.

4 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(1).

5 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(2)-(4), (6).

6 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(7), (8).

7 See the Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 2(5).

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(v) Crown Use

728. Crown rights of use.

Any government department, and any person authorised in writing by a government department¹, may use any registered design for the services of the Crown². For these purposes, the services of the Crown are deemed to include:

- 599 (1) the supply to the government of any country outside the United Kingdom³, in pursuance of an agreement or arrangement between Her Majesty's government in the United Kingdom and the government of that country, of products⁴ required for the defence of that country or for the defence of any other country whose government is party to any agreement or arrangement with Her Majesty's government in respect of defence matters;
- 600 (2) the supply to the United Nations, or to the government of any country belonging to that organisation, in pursuance of an agreement or arrangement between Her Majesty's government and that organisation or government, of products required for any armed forces operating in pursuance of a resolution of that organisation or any organ of that organisation⁵.

The power to use a registered design includes power to sell any such products to any such government or to that organisation and to sell to any person any products made in the exercise of these powers⁶ which are no longer required for the purpose for which they were made⁷.

During the period of any emergency⁸ the above powers include power to use the registered design for any purpose which appears to the department necessary or expedient:

- 601 (a) for the efficient prosecution of any war in which Her Majesty may be engaged;
- 602 (b) for the maintenance of supplies and services essential to the life of the community;
- 603 (c) for securing a sufficiency of supplies and services essential to the well-being of the community;
- 604 (d) for promoting the productivity of industry, commerce and agriculture;
- 605 (e) for fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade;
- 606 (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
- 607 (g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory outside the United Kingdom which is in grave distress as the result of war;

and any references to the services of the Crown⁹ are to be construed as including a reference to those purposes¹⁰.

The purchaser of any products sold in the exercise of the Crown powers, and any person claiming through him, has power to deal with them in the same manner as if the rights in the registered design were held on behalf of the Crown¹¹.

1 The authority of a government department may be given either before or after the design is registered and either before or after the acts in respect of which the authority is given are done, and it may be given to any person whether or not he is authorised directly or indirectly by the registered proprietor to use the design: Registered Designs Act 1949 s 12, Sch 1 para 1(4). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs); and as to the meaning of 'registered proprietor' see PARA 700 note 1. In practice these provisions are not used.

2 Registered Designs Act 1949 Sch 1 para 1(1). For the corresponding provisions relating to patents see PARA 405 et seq.

The power conferred by Sch 1 para 1(1) on a government department, or person authorised in writing by a government department, in relation to the use of registered designs for the services of the Crown is exercisable for the purposes of a visiting force or headquarters to the extent that it would be exercisable if the visiting force or headquarters were a part of any of the home forces: Visiting Forces and International Headquarters (Application of Law) Order 1999, SI 1999/1736, art 6, Sch 4 para 1(1). As to visiting forces see **ARMED FORCES** vol 2(2) (Reissue) PARA 135 et seq. This provision does not have effect to authorise the doing in relation to a registered design of anything falling within the Registered Designs Act 1949 Sch 1 para 1(6) (see the text to notes 3-5): Visiting Forces and International Headquarters (Application of Law) Order 1999, SI 1999/1736, art 6, Sch 4 para 1(2). In relation to the exercise of the powers conferred by Sch 4 para 1(1), the Registered Designs Act 1949 Sch 1 paras 1(2)-(5), (7), 2-3 has effect with any reference in those provisions to Crown use of a registered design being construed as a reference to the use of such a design for the purposes of a visiting force or headquarters: Visiting Forces and International Headquarters (Application of Law) Order 1999, SI 1999/1736, art 6, Sch 4 para 1(3).

3 As to the meaning of 'United Kingdom' see PARA 303 note 5; and as to the territorial scope of the Registered Designs Act 1949 see PARA 683.

4 As to the meaning of 'product' see PARA 734 note 1.

5 Registered Designs Act 1949 Sch 1 para 1(6) (substituted by the Defence Contracts Act 1958 s 1(1), (4); and amended by SI 2001/3949). As to the United Nations see **INTERNATIONAL RELATIONS LAW** vol 61 (2010) PARA 520 et seq. The amendment by SI 2001/3949 also applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4). As to the validity of old designs see PARA 740.

6 I.e. the powers conferred by the Registered Designs Act 1949 Sch 1 para 1.

7 Registered Designs Act 1949 Sch 1 para 1(6) (as substituted and amended: see note 5).

8 For these purposes, 'period of emergency' means a period beginning on such date as may be declared by Order in Council to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency for these purposes: Registered Designs Act 1949 Sch 1 para 4(2) (amended by the Copyright, Designs and Patents Act 1988 s 272, Sch 3 para 37). No Order in Council may be submitted to Her Majesty unless a draft of it has been laid before and approved by a resolution of each House of Parliament: Registered Designs Act 1949 Sch 1 para 4(3). At the date at which this volume states the law no such order was in force.

9 I.e. in the Registered Designs Act 1949 Sch 1: see the text and notes 1-8; and PARAS 729-733.

10 Registered Designs Act 1949 Sch 1 para 4(1).

11 Registered Designs Act 1949 Sch 1 para 1(7). Nothing in the Registered Designs Act 1949 affects the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use products forfeited under the laws relating to customs and excise: s 43(2) (amended by SI 2001/3949). As to the Crown's rights to dispose of or use articles so forfeited see the Customs and Excise Management Act 1979 s 139(4), (5), Sch 3 para 16; and **CUSTOMS AND EXCISE** vol 12(3) (2007 Reissue) PARA 1155 et seq.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(5) OWNERSHIP; ASSIGNMENT; LICENCES; CROWN USE/(v) Crown Use/729. Compensation for Crown use.

729. Compensation for Crown use.

In so far as a design¹ has, before its date of registration, been duly recorded by or applied by or on behalf of a government department otherwise than in consequence of the communication of the design directly or indirectly by the registered proprietor² or any person from whom he derives title, any use of the design under Crown powers³ may be made free of any royalty or other payment to the registered proprietor⁴. In so far as a design has not been so recorded or applied, however, any such use of the design made at any time after the date of its registration, or in consequence of any such communication, must, unless the design is invalid⁵, be made on such terms as may be agreed on, either before or after use, between the government department and the registered proprietor with Treasury approval or as may, in default of agreement, be determined by the court⁶, on a reference⁷.

Where any use of a design is so made by or with the authority of a government department, then, unless it appears to the department that it would be contrary to the public interest to do so, the department must notify the registered proprietor as soon as practicable after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require⁸.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 As to the meaning of 'registered proprietor' see PARA 700 note 1.

3 Ie under the Registered Designs Act 1949 s 12, Sch 1 para 1: see PARA 728.

4 Registered Designs Act 1949 Sch 1 para 1(2).

5 See the Registered Designs Act 1949 Sch 1 para 3(2); and PARA 733.

6 Ie under the Registered Designs Act 1949 Sch 1 para 3: see PARA 733. As to the meaning of 'court' see PARA 691.

7 Registered Designs Act 1949 Sch 1 para 1(3).

8 Registered Designs Act 1949 Sch 1 para 1(5).

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730. Persons entitled to compensation.

In general, compensation for the use of a design under Crown powers¹ is payable to the registered proprietor². In certain circumstances, however, other persons may be entitled to compensation as follows:

- 608 (1) where an exclusive licence³ granted otherwise than for royalties or other benefits determined by reference to the use of the design is in force under the design, then, in relation to any use of the design which would, but for the provisions as to Crown powers of use, be an infringement of the rights of the licensee, any compensation is payable to the licensee⁴;
- 609 (2) where there is any other exclusive licence, the licensee is entitled to part of the compensation payable to the registered proprietor; and the apportionment must be such as, in default of agreement, may be determined by the court⁵ as just, having regard to any expenditure incurred by the licensee in developing the design, or in making payments to the registered proprietor, other than royalties or other payments determined by reference to the use of the design, in consideration of the licence⁶;
- 610 (3) subject to the entitlement under head (1) above, where the registered design, or the right to apply for or obtain registration of the design, has been assigned to the registered proprietor in consideration of royalties or other benefits determined by reference to the use of the design, the compensation must be divided between the registered proprietor and the assignor⁷.

1 le under the Registered Designs Act 1949 s 12, Sch 1 para 1: see PARA 728.

2 See the Registered Designs Act 1949 Sch 1 para 1(3); and PARA 729. As to the meaning of 'registered proprietor' see PARA 700 note 1.

3 For these purposes, 'exclusive licence' means a licence from a registered proprietor which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons, including the registered proprietor, any right in respect of the registered design: Registered Designs Act 1949 Sch 1 para 2(5).

4 Registered Designs Act 1949 Sch 1 para 2(2)(a). There is then no right of compensation if the licensee uses the design under Crown authority: see Sch 1 para 2(2)(b).

5 As to the meaning of 'court' see PARA 691. As to the settlement of disputes see PARA 733.

6 Registered Designs Act 1949 Sch 1 para 2(4). If, before the amount of compensation has been agreed between the registered proprietor and the department, the licensee gives notice of his interest to the department, any agreement as to amount is of no effect unless made with the licensee's consent: Sch 1 para 2(4).

7 Registered Designs Act 1949 Sch 1 para 2(3)(a). Use by the registered proprietor, such as the Crown has power to authorise, to the order of a government department then attracts compensation as if made under Crown authority: Sch 1 para 2(3)(b).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(5) OWNERSHIP; ASSIGNMENT; LICENCES; CROWN USE/(v) Crown Use/731. Rights of third persons.

731. Rights of third persons.

Where any use of a registered design, or a design in respect of which an application for registration is pending, is made for the services of the Crown¹ either by a government department or a person authorised by a government department, or by the registered proprietor² or applicant for registration to the order of a government department, then the provisions of any licence, assignment or agreement made between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than a government department are of no effect so far as those provisions restrict or regulate the use of the design or any model, document or information relating to the design, or provide for the making of payments in respect of any such use or calculated by reference to such use³. In connection with such use of a design, the reproduction or publication of any model or document is not deemed to be an infringement of any copyright or national unregistered design right⁴ subsisting in the model or document⁵. In such a case, the rules governing compensation for Crown use and the procedure for determination of disputes as to Crown use⁶ apply as if the person entitled to the contractual provision or copyright or design right concerned was a registered proprietor⁷.

1 Ie under the Registered Designs Act 1949 s 12, Sch 1 para 1: see PARA 728.

2 As to the meaning of 'registered proprietor' see PARA 700 note 1.

3 Registered Designs Act 1949 Sch 1 para 2(1). Nothing in the Registered Designs Act 1949 Sch 1 para 2 is, however, to be construed as authorising the disclosure to a government department or any other person of any model, document or information to the use of which that provision applies in contravention of any such licence, assignment or agreement: Defence Contracts Act 1958 s 1(3), (4). See **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 54 et seq (copyright), and PARA 501 et seq (design right).

4 'National unregistered design right' means design right within the meaning of the Copyright, Designs and Patents Act 1988 Pt III (see s 213; and **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 10); Registered Designs Act 1949 s 44(1) (definition added by SI 2001/3949).

5 Registered Designs Act 1949 Sch 1 para 2(1) (amended by the Copyright, Designs and Patents Act 1988 s 272, Sch 3 para 37(1), (2); and by SI 2001/3949); Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4).

6 Ie the Registered Designs Act 1949 Sch 1 para 1(3) (see PARA 728) and Sch 1 para 3 (see PARA 733).

7 See the Defence Contracts Act 1958 s 1(2), (4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(5) OWNERSHIP; ASSIGNMENT; LICENCES; CROWN USE/(v) Crown Use/732. Compensation for loss of profit.

732. Compensation for loss of profit.

Where Crown use¹ is made of a registered design, the government department concerned² must pay to the registered proprietor³ or, if there is an exclusive licence⁴ in force in respect of the design, to the exclusive licensee compensation for any loss resulting from his not being awarded a contract to supply the products⁵ to which the design is applied or in which it is incorporated⁶. Compensation is payable only to the extent that such a contract could have been fulfilled from his existing manufacturing capacity; but it is payable notwithstanding the existence of circumstances rendering him ineligible for the award of such a contract⁷. In determining the loss, regard must be had to the profit which would have been made on such a contract and to the extent to which any manufacturing capacity was underused⁸. No compensation is, however, payable in respect of any failure to secure contracts for the supply of products to which the design is applied or in which it is incorporated otherwise than for the services of the Crown⁹. The amount so payable, if not agreed between the registered proprietor or licensee and the government department concerned with the approval of the Treasury, must be determined¹⁰ by the court¹¹; and it is in addition to any amount payable¹² in respect of Crown use¹³.

1 For these purposes, 'Crown use', in relation to a design, means the doing of anything by virtue of the Registered Designs Act 1949 s 12, Sch 1 para 1 (see PARAS 728-729) which would otherwise be an infringement of the right in the design: Sch 1 para 2A(6) (Sch 1 para 2A added by the Copyright, Designs and Patents Act 1988 s 271(1), (2)). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 For these purposes, 'government department concerned', in relation to Crown use, means the government department by whom or on whose authority the act was done: Registered Designs Act 1949 Sch 1 para 2A(6) (as added: see note 1).

3 As to the meaning of 'registered proprietor' see PARA 700 note 1.

4 As to the meaning of 'exclusive licence' see PARA 730 note 3.

5 As to the meaning of 'product' see PARA 734 note 1.

6 Registered Designs Act 1949 Sch 1 para 2A(1) (as added (see note 1); and amended by SI 2001/3949); Registered Design Regulations 2001, SI 2001/3949, regs 1, 12(4). Cf the Patents Act 1977 s 57A; and PARA 409.

7 Registered Designs Act 1949 Sch 1 para 2A(2) (as added: see note 1).

8 Registered Designs Act 1949 Sch 1 para 2A(3) (as added: see note 1).

9 Registered Designs Act 1949 Sch 1 para 2A(4) (as added (see note 1); and amended by SI 2001/3949); Registered Design Regulations 2001, SI 2001/3949, regs 1, 12(4).

10 Ie on a reference under the Registered Designs Act 1949 Sch 1 para 3: see PARA 733.

11 As to the meaning of 'court' see PARA 691.

12 Ie in addition to any amount payable under the Registered Designs Act 1949 Sch 1 para 1 (see PARA 730) or Sch 1 para 2 (see PARA 731).

13 Registered Designs Act 1949 Sch 1 para 2A(5) (as added: see note 1).

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733. Settlement of disputes.

Any dispute as to:

- 611 (1) the exercise by a government department or a person authorised by a government department of its powers to authorise use of designs¹; or
- 612 (2) terms for the use of a design for the services of the Crown²; or
- 613 (3) the right of any person to receive any part of any compensation payable³; or
- 614 (4) the right of any person to receive compensation for loss of profit⁴,

may be referred to the court⁵ by either party to the dispute⁶.

The court may at any time order the whole of any such proceedings, or any question or issue of fact arising in them, to be referred to a special or official referee or an arbitrator on such terms as the court may direct⁷.

In any such proceedings to which a government department is a party, the department may:

- 615 (a) if the registered proprietor⁸ is a party to the proceedings and the department is a relevant person⁹, apply for invalidation of the registration of the design upon any ground upon which the registration of a design may be declared invalid on an application to the court¹⁰;
- 616 (b) in any case and provided that the department would be the relevant person¹¹ if it had made an application on the grounds for invalidity being raised put in issue the validity of the registration of the design without applying for its invalidation¹².

In determining any dispute between a government department and any person as to terms for the use of a design for the services of the Crown, the court must have regard to any benefit or compensation which that person, or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly from any government department in respect of the design in question¹³. If in such proceedings any question arises whether a design has been previously recorded or applied so as to exclude any right to compensation, and the disclosure of any document recording the design, or of any evidence of its application, would in the department's opinion be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon¹⁴.

1 le the powers conferred by the Registered Designs Act 1949 s 12, Sch 1 para 1: see PARAS 728-729.

2 le under the Registered Designs Act 1949 Sch 1 para 1: see PARAS 728-729.

3 le under the Registered Designs Act 1949 Sch 1 para 1(3): see PARA 729.

4 le under the Registered Designs Act 1949 Sch 1 para 2A: see PARA 732.

5 As to the meaning of 'court' see PARA 691.

6 Registered Designs Act 1949 Sch 1 para 3(1) (substituted by the Copyright, Designs and Patents Act 1988 s 271(1), (3)).

7 Registered Designs Act 1949 Sch 1 para 3(5). References to the court in Sch 1 para 3(1)-(4) are to be construed accordingly: Sch 1 para 3(5). As to references to a special or official referee generally see **ARBITRATION** vol 2 (2008) PARA 1226; **CIVIL PROCEDURE** vol 12 (2009) PARA 1544.

8 As to the meaning of 'registered proprietor' see PARA 700 note 1.

9 le within the meaning of the Registered Designs Act 1949 s 20: see PARA 720.

10 le under the Registered Designs Act 1949 s 20: see PARA 720.

11 See note 9.

12 Registered Designs Act 1949 Sch 1 para 3(2) (amended by SI 2001/3949); Registered Design Regulations 2001, SI 2001/3949, regs 1, 12(4).

13 Registered Designs Act 1949 Sch 1 para 3(4).

14 Registered Designs Act 1949 Sch 1 para 3(3).

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(6) VALIDITY

(i) Current Designs

734. Meaning of 'design'.

'Design' means the appearance of the whole or a part of a product¹ resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation².

1 'Product' means any industrial or handicraft item other than a computer program; and, in particular, includes packaging, get-up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product: Registered Designs Act 1949 s 1(3) (s 1 substituted by SI 2001/3949). 'Complex product' means a product which is composed of at least two replaceable component parts permitting disassembly and reassembly of the product: s 1(3) (as so substituted).

2 Registered Designs Act 1949 s 1(2) (as substituted: see note 1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(i) Current Designs/735. Requirement of novelty and individual character.

735. Requirement of novelty and individual character.

A design¹ is protected by a right in a registered design to the extent that the design is both new and has individual character². For these purposes, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the relevant date³. A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the relevant date⁴.

In determining the extent to which a design has individual character, the degree of freedom of the author in creating the design is to be taken into consideration⁵.

A design applied to or incorporated in a product which constitutes a component part of a complex product is only considered to be new and to have individual character (1) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product⁶; and (2) to the extent that those visible features of the component part are in themselves new and have individual character⁷.

1 As to the meaning of 'design' see PARA 734.

2 Registered Designs Act 1949 s 1B(1) (s 1B added by SI 2001/3949). This legislation applies to the validity of any design application for which was made on or after 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, reg 1. As to the legislation relating to old designs see PARA 740. See *Bailey (t/a Elite Angling Products) v Haynes (t/a RAGS)* [2006] EWPCC 5, [2007] FSR 199, where this requirement is considered in the context of the Community unregistered design right.

3 Registered Designs Act 1949 s 1B(2) (as added: see note 2). 'Relevant date' means the date on which the application for the registration of the design was made or is treated by virtue of s 3B(2), (3) or (5) (see PARA 709) or s 14(2) (see PARA 712) as having been made: s 1B(7) (as so added). The 'sector concerned' is that corresponding to the prior art: *Green Lane Products Ltd v PMS International Group Ltd* [2007] EWHC 1712 (Pat), [2007] All ER (D) 305 (Jul); affd [2008] EWCA Civ 358, [2008] All ER (D) 313 (Apr). As to when a design is made available to the public see PARA 736.

4 Registered Designs Act 1949 s 1B(3) (as added: see note 2). See note 3. See *Bailey (t/a Elite Angling Products) v Haynes (t/a RAGS)* [2006] EWPCC 5, [2007] FSR 199. As to the interpretation of 'informed user' in the context of EC Council Regulation 6/2002 of 13 December 2001 on Community Designs (OJ L3, 5.1.2002, p 1) art 10 see *Proctor & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 208. See also *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1; *J Choo (Jersey) Ltd v Towerstone Ltd* [2008] EWHC 346 (Ch), [2008] All ER (D) 35 (Jan), [2008] FSR 485; *Rolawn Ltd v Turfmech Machinery Ltd* [2008] EWHC 989 (Pat) at [110], [2008] All ER (D) 77 (May) at [110].

5 Registered Designs Act 1949 s 1B(4) (as added: see note 2). See *Proctor & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] FSR 290, affd [2007] EWCA Civ 936, [2008] FSR 208.

6 Registered Designs Act 1949 s 1B(8)(a) (as added: see note 2). 'Normal use' means use by the end user; but does not include any maintenance, servicing or repair work in relation to the product: s 1B(9) (as so added). As to the meanings of 'product' and 'complex product' see PARA 734 note 1.

7 Registered Designs Act 1949 s 1B(8)(b) (as added: see note 2).

UPDATE

735 Requirement of novelty and individual character

NOTE 3--*Green Lane Products*, cited, reported at [2008] EWCA Civ 358, [2009] IP & T 233.

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736. Made available to the public.

A design¹ has been made available² to the public before the relevant date³ if:

- 617 (1) it has been published (whether following registration or otherwise), exhibited,
used in trade or otherwise disclosed before that date⁴; and
 - 618 (2) the disclosure does not fall within any of the following categories⁵:
- 24
- 37. (a) it could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned⁶;
 - 38. (b) it was made to a person other than the designer, or any successor in title of his, under conditions of confidentiality (whether express or implied)⁷;
 - 39. (c) it was made by the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date⁸;
 - 40. (d) it was made by a person other than the designer, or any successor in title of his, during the period of 12 months immediately preceding the relevant date in consequence of information provided or other action taken by the designer or any successor in title of his⁹; or
 - 41. (e) it was made during the period of 12 months immediately preceding the relevant date as a consequence of an abuse in relation to the designer or any successor in title of his¹⁰.

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1 As to the meaning of 'design' see PARA 734.

2 As to the meaning of 'made available' see *Dyson Ltd v Qualtex (UK) Ltd* [2004] EWHC 2981 (Ch), [2005] RPC 395; affd [2006] EWCA Civ 166, [2006] RPC 769 (taking orders for articles not yet in existence does not make the design available).

3 As to the relevant date see PARA 735 note 3.

4 Registered Designs Act 1949 s 1B(5)(a) (s 1B added by SI 2001/3949). The concept is similar but not identical to that of prior publication in relation to old designs: see PARA 751.

5 Registered Designs Act 1949 s 1B(5)(b) (as added: see note 4).

6 Registered Designs Act 1949 s 1B(6)(a) (as added: see note 4).

7 Registered Designs Act 1949 s 1B(6)(b) (as added: see note 4).

8 Registered Designs Act 1949 s 1B(6)(c) (as added: see note 4).

9 Registered Designs Act 1949 s 1B(6)(d) (as added: see note 4).

10 Registered Designs Act 1949 s 1B(6)(e) (as added: see note 4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(i) Current Designs/737. Designs dictated by their technical function.

737. Designs dictated by their technical function.

A right in a registered design¹ does not subsist in features of appearance of a product² which are solely dictated by the product's technical function³.

1 As to the meaning of 'design' see PARA 734.

2 As to the meaning of 'product' see PARA 734 note 1.

3 Registered Designs Act 1949 s 1C(1) (s 1C added by SI 2001/3949). See *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285, [2006] All ER (D) 17 (Aug), [2007] FSR 181 at 194. See also *Bailey (t/a Elite Angling Products) v Haynes (t/a RAGS)* [2006] EWPCC 5, [2007] FSR 199, where it was held that a design is only excluded from registration if it is the only design by which the product can perform its function. Cf the position in relation to old designs: see PARA 746. This legislation applies to the registration of any design application for which was made on or after 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, reg 1. As to the validity of old designs see PARA 740.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(i) Current Designs/738. The 'must fit' exclusion.

738. The 'must fit' exclusion.

A right in a registered design¹ does not subsist in features of appearance of a product² which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function³. However, this does not prevent a right in a registered design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system⁴.

1 As to the meaning of 'design' see PARA 734.

2 As to the meaning of 'product' see PARA 734 note 1.

3 Registered Designs Act 1949 s 1C(2) (s 1C added by SI 2001/3949). This legislation applies to the registration of any design application for which was made on or after 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, reg 1. As to the validity of old designs see PARA 740.

4 Registered Designs Act 1949 s 1C(3) (as added: see note 3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(i) Current Designs/739. Designs contrary to public policy or morality.

739. Designs contrary to public policy or morality.

A right in a registered design¹ does not subsist in a design which is contrary to public policy or to accepted principles of morality².

¹ As to the meaning of 'design' see PARA 734.

² Registered Designs Act 1949 s 1D (added by SI 2001/3949). This legislation applies to the registration of any design application for which was made on or after 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, reg 1. As to the validity of old designs see PARA 740. See *Masterman's Design* [1991] RPC 89, Registered Design Appeal Tribunal (considering the Registered Designs Act 1949 s 43(1) (now repealed), which provided that nothing in the Registered Designs Act 1949 was to be construed as authorising or requiring the registrar to register a design the use of which would, in his opinion, be contrary to law or morality).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/740. Meaning of 'design'.

(ii) Old Designs

740. Meaning of 'design'.

In relation to old designs¹, 'design' means features of shape, configuration, pattern or ornament² applied to an article³ by any industrial process, being features which in the finished article appeal to and are judged by the eye⁴, but does not include:

- 619 (1) a method or principle of construction; or
- 620 (2) features of shape or configuration of an article which:
- 26
- 42. (a) are dictated solely by the function⁵ which the article has to perform; or
- 43. (b) are dependent upon the appearance of another article of which the article is intended by the author⁶ of the design to form an integral part⁷.
- 27

An old design is not validly registered unless it complies with this statutory definition⁸. In addition, no design in respect of any article or set of articles is validly registered unless it was new at the date of application⁹; but a design is not to be regarded as new if it is the same as a design registered in respect of the same or any other article in pursuance of a prior application or published in the United Kingdom¹⁰ in respect of the same or any other article before the date of the application, or if it differs from such a design only in immaterial details or in features which were variants commonly used in the trade¹¹.

An old design is not validly registered in respect of an article if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the design were to be applied to the article¹². The Secretary of State¹³ has made rules providing for excluding from registration designs for certain articles of a primarily literary or artistic character¹⁴.

1 The designs applications for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. The Registered Designs Act 1949, so far as it applies in relation to any registration made before 9 December 2001 which is in respect of any features of shape, configuration, pattern or ornament which do not fall within the new definition of 'design' in that Act (see PARA 734), applies as if the features concerned were included within the new definition of 'design': Registered Designs Regulations 2001, SI 2001/3949, reg 14(12), (13).

2 See PARA 742. Dimensions may form part of a 'design': *A Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] RPC 499; affd [2003] EWCA Civ 1514, [2004] RPC 301.

3 As to the meaning of 'article' see PARA 743.

4 As to the eye as judge see PARA 744.

5 See PARA 746.

6 As to the meaning of 'author' see PARA 722.

7 Registered Designs Act 1949 s 1(1) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)). See further PARA 747. This legislation applies to the registration of any design application for which was made

before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734.

8 See eg *Amp Inc v Utilux Pty Ltd* [1972] RPC 103, HL; and PARA 744.

9 Registered Designs Act 1949 s 1(2) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)).

10 As to the meaning of 'United Kingdom' see PARA 303 note 5.

11 Registered Designs Act 1949 s 1(4) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)). The Registered Designs Act 1949 s 1(4) has effect subject to s 4 (see PARA 756), s 6 (see PARAS 752-755) and s 16 (protection of designs communicated under international agreements): s 1(4) (as so substituted). As to novelty see PARA 750.

12 Registered Designs Act 1949 s 1(3) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)). As to material appearance see PARA 744.

13 As to the Secretary of State see PARA 575.

14 Registered Designs Act 1949 s 1(5) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)). In exercise of the power so conferred the Secretary of State made the Registered Designs Rules 1995, SI 1995/2912, r 26.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/741. Capability of something being applied to an article.

741. Capability of something being applied to an article.

In relation to old designs¹, a design is not for the article itself but for something capable of being applied to the article². In the case of a design for shape this distinction is chiefly a matter of words³, but in other cases it may be of importance, as questions of novelty and infringement have to be determined not merely by looking at the design as shown in the drawing lodged with the application, but also by considering how its appearance would be affected by alterations in the shape of the article to which it is applied⁴.

1 Old designs applications for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 *Dover Ltd v Nürnberger Celluloidwaren Fabrik Gebrüder Wolff* [1910] 2 Ch 25 at 28, 27 RPC 498 at 503, CA. See also *Re Clarke's Registered Design, Clarke v Sax & Co Ltd* [1896] 2 Ch 38 at 43, 13 RPC 351 at 359, CA; *Re Bayer's Design, Bayer v Symington* (1907) 25 RPC 56, HL; *Deyhle's Design Applications* [1982] RPC 526, Registered Designs Appeal Tribunal; *Ford Motor Co Ltd's Design Applications* [1995] RPC 167 at 178, HL.

3 *Re Clarke's Registered Design, Clarke v Sax & Co Ltd* [1896] 2 Ch 38 at 43, 13 RPC 351 at 359, CA.

4 *Re Bayer's Design, Bayer v Symington* (1907) 25 RPC 56, HL. As to flexible articles see *Schmittzehe v Roberts* (1955) 72 RPC 122. Cf *Bailey (t/a Elite Angling Products) v Haynes (t/a RAGS)* [2006] EWPCC 5, [2007] FSR 199 at 213.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/742. Shape, configuration, pattern or ornament.

742. Shape, configuration, pattern or ornament.

In relation to old designs¹ there is no statutory definition of 'shape', 'configuration', 'pattern' or 'ornament', but it has been said that shape and configuration apply to three dimensions, and pattern or ornament to two². Two identical designs may be validly registered, one for pattern and one for shape³. Where a design is registered for pattern and for shape, all that is protected is the combination⁴. Although there was a distinction between registering a design for a shape and registering for a pattern, one cannot, in a pattern design, ignore earlier shape designs when considering novelty⁵. It is not necessary that a design should be apparent upon an external examination of the article; it is sufficient that it will in practice have customer eye appeal⁶.

1 Old designs applications for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 *Re Kestos Ltd Registered Design (No 725,716)*, *Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp* (1935) 53 RPC 139 at 152; and see *Sommer Alibert (UK) Ltd v Flair Plastics Ltd* [1987] RPC 599, CA. It was not necessary, however, for the applicant to elect between them: *Heath & Sons Ltd v Rollason* [1898] AC 499, 15 RPC 441, HL.

3 *Pearson v Morris Wilkinson & Co* (1906) 23 RPC 738. There cannot, however, be two registrations of the design of a single article differing only in statements claiming novelty for the shape of different parts of the article: *Evered & Co Ltd's Applications (Design)* [1961] RPC 105, Patents Appeal Tribunal.

4 *John Harper & Co Ltd v Wright and Butler Lamp Manufacturing Co Ltd* [1896] 1 Ch 142, 12 RPC 483, CA; *Re Manchester's Designs, Manchester v Umfreville & Son* (1907) 24 RPC 782.

5 *Dymo Industries Inc's Application* [1982] RPC 437, Registered Designs Appeal Tribunal.

6 *P Ferrero and CSpA's Application* [1978] RPC 473, Registered Designs Appeal Tribunal (multi-layered chocolate egg); *KK Suwa Seikosha's Design Application* [1982] RPC 166, Registered Designs Appeal Tribunal (display panel for digital watch visible only when battery connected); *Apple Computer Inc's Design Applications* [2002] FSR 602, [2001] All ER (D) 336 (Oct) (computer icons only visible after computer switched on). As to eye appeal see further PARA 744.

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743. Article.

In relation to old designs¹, a design could be registered in respect of any article, or set of articles². 'Article' means any article of manufacture and includes any part of an article if that part is made and sold separately³. An article must, however, perform some function other than merely carrying the design⁴, and a building is not an article within this definition⁵. Moreover, there were excluded from registration designs to be applied to any of the following articles, namely:

- 621 (1) works of sculpture, other than casts or models used or intended to be used as models or patterns to be multiplied by any industrial process⁶;
- 622 (2) wall plaques, medals and medallions⁷;
- 623 (3) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dress-making patterns, greetings cards, labels, leaflets, maps, plans, playing cards, postcards, stamps, trade advertisements, trade forms and cards, transfers and similar articles⁸.

¹ Old designs applications for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, reg 1): see PARA 681. As to the meaning of 'design' see PARA 740.

² For these purposes, 'set of articles' means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied: Registered Designs Act 1949 s 44(1). Any reference to an article in respect of which a design is registered is to be construed, in the case of a design registered in respect of a set of articles, as a reference to any article of that set: s 44(2). Any question whether a number of articles constitute a set is to be determined by the registrar; and notwithstanding anything in the Registered Designs Act 1949 any such determination of the registrar is final: s 44(3). See *Apple Computer Inc's Design Applications* [2002] FSR 602, [2001] All ER (D) 336 (Oct) (consideration of 'article'). This legislation applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734.

³ Registered Designs Act 1949 s 44(1). The meaning of the protection afforded by a registration is not ambiguous merely because the design is intended to be applied only to part of the article which is not sold separately: see *Portable Concrete Buildings Ltd v Bathcrete Ltd* [1962] RPC 49. Parts of articles which are not, in themselves, intended by the proprietor to be made and sold separately are not 'articles' within the definition: *Sifam Electrical Instrument Co Ltd v Sangamo Weston Ltd* [1971] 2 All ER 1074, [1973] RPC 899 (fronts of electrical meters held not to be 'articles'); *Ford Motor Co Ltd and Iveco Fiat SpA's Design Applications* [1993] RPC 399, Registered Designs Appeal Tribunal; affd sub nom *R v Registered Designs Appeal Tribunal, ex p Ford Motor Co Ltd* [1995] 1 WLR 18, [2005] RPC 167, HL (vehicle component parts such as main body panels, doors, bonnet lids, boot lids and windscreens for motor cars); *A Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] RPC 499 (an umbrella case held to be 'an article').

⁴ *Re Littlewoods Pools Ltd's Application* (1949) 66 RPC 309, Patents Appeal Tribunal (decided under the Patents and Designs Act 1907 (repealed), but there seems no reason why a similar principle should not apply).

⁵ *Re Collier & Co Ltd's Application* (1937) 54 RPC 253, Assistant Comptroller. A design for a portable building is registrable: see *Portable Concrete Buildings Ltd v Bathcrete Ltd* [1962] RPC 49.

⁶ Registered Designs Rules 1995, SI 1995/2912, r 26(1). As to the Secretary of State's power to make rules providing for the exclusion from registration of designs see PARA 740. As to the preservation of the Registered Designs Rules 1995, SI 1995/2912, in relation to old designs see the Registered Designs (Amendment) Rules 2001, SI 2001/3950, rr 27-30 (revoked). As to the rules governing current designs see the Registered Designs Rules 2006, SI 2006/1975; and PARA 734 et seq.

7 Registered Designs Rules 1995, SI 1995/2912, r 26(2); and see *Reliance (Nameplates) Ltd v Art Jewels Ltd* [1953] 1 All ER 759, [1953] 1 WLR 530, 70 RPC 86 (coronation medallion).

8 Registered Designs Rules 1995, SI 1995/2912, r 26(3). A preprinted web for a computer was held not to be printed matter of a primarily artistic character: see *Lamson Industries Ltd's Application* [1978] RPC 1, Registered Designs Appeal Tribunal.

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744. Eye the judge.

Old designs¹ are validly registered only in respect of features of shape, configuration, pattern or ornament² which in the finished article appeal to and are judged by the eye³. It is necessary that a design should show some new effect clearly distinguishable by the eye from what has gone before⁴ and that the change should be such that some degree of real mental activity has been needed for its production⁵. The criteria on which the court acts differ according to whether the improvement has or lacks artistic merit. A new and agreeable artistic effect often defies analysis of its causes, and the eye rightly appreciates it as something really different from what has gone before, without considering in what the distinction consists⁶. The eye is the judge of the existence of a difference between a design and what has gone before⁷, but in judging the importance of that difference it would seem that other factors may properly be taken into account. Although increased utility is not a necessary ingredient of a novel design⁸, it may assist in showing that the design is really new and distinct from what has gone before, for, had such variation in fact been obvious and needed no mental activity, the probability is that it would have been made before, and on account of its increased utility would have persisted⁹.

Those designs which appeal to the eye might nevertheless be invalid if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the design were to be applied to the article¹⁰.

1 Old designs applications for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 See PARA 742.

3 See the Registered Designs Act 1949 s 1(1); and PARA 740. This legislation applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734. 'Judged by the eye' means the eye using normal vision: *Amp Inc v Utilux Pty Ltd* [1970] RPC 397, CA; *revsd* [1972] RPC 103, HL, without affecting this point. It is the eye of the customer not the court which is relevant: see *Amp Inc v Utilux Pty Ltd* [1972] RPC 103, HL; *Kevi A/S v Suspa-Verein UK Ltd* [1982] RPC 173; *A Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] RPC 499; *affd* [2003] EWCA Civ 1514, [2004] RPC 301.

4 *Re Le May's Registered Design, Le May v Welch* (1884) 28 ChD 24, CA. See also *Lazarus v Charles* (1873) LR 16 Eq 117; *Re Smith's Registered Design, Smith v Hope Bros* (1889) 6 RPC 200; *Re Kestos Ltd Registered Design (No 725,716), Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp* (1935) 53 RPC 139 at 153. For examples of decisions where variations have been considered too small to support novelty see *Negretti and Zambra v W F Stanley & Co Ltd* (1925) 42 RPC 358; *Re Wingate's Registered Design (No 768,611)* (1934) 52 RPC 126; *Re Associated Colour Printers Ltd's Application (No 814,271)* (1937) 54 RPC 203, Patents Appeal Tribunal. For small improvements held registrable see *Jackson v Testar* (1919) 36 RPC 289; *Rose v J W Pickavant & Co Ltd* (1923) 40 RPC 320; *Cartwright v Coventry Radiator Co* (1925) 42 RPC 351; *Wells v Attaché Case Manufacturing Co Ltd* (1931) 49 RPC 113; *Re Kestos Ltd Registered Design (No 725,716), Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp*. In most of these latter cases, although the design was upheld, it was held not to be infringed.

5 *Dover Ltd v Nürnberger Celluloidwaren Fabrik Gebrüder Wolff* [1910] 2 Ch 25 at 28, 27 RPC 498 at 503, CA.

6 Cf *Heath & Sons Ltd v Rollason* [1898] AC 499 at 502, 503, 15 RPC 441 at 447, HL, per Lord Herschell; *Wallpaper Manufacturers Ltd v Derby Paper Staining Co* (1925) 42 RPC 443.

7 *Re Morton's Design* (1899) 17 RPC 117; *Gillard v Worrall* (1904) 22 RPC 76; *Re Bayer's Design, Bayer v Symington* (1907) 25 RPC 56, HL. See also *Harrison v Taylor* (1859) 4 H & N 815, Ex Ch.

8 *Hecla Foundry Co v Walker, Hunter & Co* (1889) 14 App Cas 550 at 556, 6 RPC 554 at 559, HL. See also *Re Clarke's Registered Design, Clarke v Sax & Co Ltd* [1896] 2 Ch 38 at 43, 13 RPC 351 at 358, CA; *Re Morton's Design* (1899) 17 RPC 117. As to shapes dictated purely by function see PARA 746.

9 *Tyler & Sons v Sharpe Bros & Co* (1893) 11 RPC 35 (where a large sale was considered some evidence of substantial novelty); *Gillard v Worrall* (1904) 22 RPC 76. There are dicta opposed to this view (see the cases cited in note 8), but, with the possible exception of *Re Clarke's Registered Design, Clarke v Sax & Co Ltd* [1896] 2 Ch 38 at 43, 13 RPC 351 at 358, CA, the remarks were directed to the non-essentiality of utility, or to the point that the protection accorded to the design did not cover other designs attaining the same end, rather than to the exclusion of the consideration of utility on the question of substantial novelty: *Walker, Hunter & Co v Falkirk Iron Co* (1887) 4 RPC 390; *Hecla Foundry Co v Walker, Hunter & Co* (1889) 14 App Cas 550, 6 RPC 554, HL; *Heinrichs v Bastendorff* (1893) 10 RPC 160; *Infields v Rosen Ltd* [1939] 1 All ER 121, 56 RPC 163.

10 Registered Designs Act 1949 s 1(3) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)). The purpose of this provision was to exclude from registration articles which have some appeal to the eye but which are purchased or acquired primarily for their function and where little or no attention is paid to the look of the article.

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745. Method or principle of construction.

In relation to old designs¹, although a design might in some cases incidentally protect a mode of manufacture², a registration would not be valid if it was for a method or principle of construction in itself³; and the registration of a design in order to cover all alternatives is invalid, as it would give the same result⁴. If what is registered, however, has the requisites of a novel and original design, it is no objection that it could also have been protected by letters patent⁵, or that it is in fact protected by letters patent granted to the proprietor, so long as there has been no prior publication⁶. A design cannot be considered as protecting a combination of movements of machinery used in its manufacture⁷.

1 Old designs applications for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 *Re Bayer's Design, Bayer v Symington* (1907) 25 RPC 56 at 60, HL, per Lord Macnaghten.

3 See the Registered Designs Act 1949 s 1(1)(a); and PARA 740. This legislation applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734.

See *Moody v Tree* (1892) 9 RPC 333 (basket made by osiers being worked in singly with the butt ends outwards); *Cooper v Symington* (1893) 10 RPC 264 (method of fixing corset bucks); *Re Bayer's Design, Bayer v Symington* (1907) 25 RPC 56, HL (corset with seams cut horizontally); *Pugh v Riley Cycle Co Ltd* [1912] 1 Ch 613, 29 RPC 196; *E J Pearson & Sons v D B Harris & Sons Ltd* (1912) 29 RPC 632; *Phillips v Harbro Rubber Co* (1920) 37 RPC 233, HL; *Re Kestos Ltd Registered Design (No 725,716)*, *Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp* (1935) 53 RPC 139. For examples of unsuccessful attempts to invalidate design as covering a method or principle of construction see *Rosedale Associated Manufacturers Ltd v Airfix Products Ltd* [1956] RPC 360 (on appeal [1957] RPC 239, CA); *Gardex Ltd v Sorata Ltd* [1986] RPC 623. See also *A Fulton Co Ltd v Grant Barnett & Co* [2001] RPC 257, [2000] All ER (D) 1270; *Oren v Red Box Toy Factory Ltd* [1999] FSR 785, [1999] All ER (D) 98; *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285, [2006] All ER (D) 17 (Aug), [2007] FSR 181; *Bailey (t/a Elite Angling Products) v Haynes (t/a RAGS)* [2006] EWPC 5, [2007] FSR 199.

4 *Phillips v Harbro Rubber Co* (1920) 37 RPC 233, HL; *Re Kestos Ltd Registered Design (No 725,716)*, *Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp* (1935) 53 RPC 139; *Wilson v Chalco Ltd* (1922) 39 RPC 252.

5 *Walker, Hunter & Co v Falkirk Iron Co* (1887) 4 RPC 390; *Rogers v Driver* (1850) 16 QB 102. In practice, since the decision in *Amp Inc v Utilux Pty Ltd* [1972] RPC 103, HL, it is unlikely that a registered design could validly co-exist with a patent for the same article; but see *Gardex Ltd v Sorata Ltd* [1986] RPC 623.

6 *Werner Motors Ltd v A W Gamage Ltd* [1904] 2 Ch 580, 21 RPC 621, CA. As to prior publication see PARA 788.

7 *Re Plackett's Registered Design* (1892) 9 RPC 436 at 438.

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746. Function of article.

An old design¹ is invalid if it is registered in respect of features of shape or configuration which are dictated solely by the function which the article² to be made in that shape or configuration has to perform³; nor can valid protection be acquired for a mere mechanical device⁴. Where an article is purely functional, so that its shape has no customer or consumer⁵ eye appeal, that shape is not a design and therefore any registration for the same is invalid⁶.

A particular shape or configuration is dictated solely by function if its relevant features are brought about by, or are attributable only to, the function which the article in that shape or configuration is to perform, even if the same function could equally well be performed by an article of a different shape⁷. The exclusion of features dictated by function must be construed as treating the whole shape or configuration as registrable, assuming that it had eye appeal, unless every feature was dictated solely by functional considerations, in which case the exclusion operates even though the article might also have eye appeal; but any feature which went beyond those dictated solely by function would entitle the shape or configuration as a whole to protection⁸ unless the appearance of the article is not material⁹.

1 le a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 As to the meaning of 'article' see PARA 743.

3 See the Registered Designs Act 1949 s 1(1)(b)(i); and PARA 740. This legislation applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734.

See *Stenor Ltd v Whitesides (Clitheroe) Ltd* [1948] AC 107, [1947] 2 All ER 241, 65 RPC 1, HL; *Rosedale Associated Manufacturers Ltd v Airfix Products Ltd* [1957] RPC 239, CA; *P B Cow & Co Ltd v Cannon Rubber Manufacturers Ltd* [1959] RPC 240 (on appeal [1959] RPC 347, CA); *Scripto Inc v Tallon Ltd* [1960] RPC 262.

4 *Tecalemit Ltd v Ewatts Ltd (No 2)* (1927) 44 RPC 503; *Re Kestos Ltd Registered Design (No 725,716)*, *Kestos Ltd v Kempat Ltd and Vivian Fitch Kemp* (1935) 53 RPC 139 at 151.

5 See *Kevi A/S v Suspa Verein UK Ltd* [1982] RPC 173, expressly extending the decision in *Amp Inc v Utilux Pty Ltd* [1972] RPC 103, HL, to ultimate consumers as well as immediate customers.

6 *Amp Inc v Utilux Pty Ltd* [1972] RPC 103, HL, where electrical connectors were held not to be designs within the meaning of the Registered Designs Act 1949, notwithstanding the fact that they might, in order to perform their function, have been differently shaped. See *Lamson Industries Ltd's Application* [1978] RPC 1, Registered Designs Appeal Tribunal (preprinted web for a computer held not to be a design because it had no customer eye appeal).

7 *Interlego AG v Tyco Industries Inc* [1988] RPC 343 at 355, PC.

8 *Interlego AG v Tyco Industries Inc* [1988] RPC 343 at 353-355, PC.

9 See the Registered Designs Act 1949 s 1(3); and PARA 740. As to the appearance of an article being material see PARA 744.

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747. Features dependent upon appearance of another article (the 'must match' exclusion).

An old design¹ is invalid if it is registered in respect of features of shape or configuration which are dependent upon the appearance of another article² of which the article is intended by the author of the design to form an integral part³. The word 'integral' is present so as not to exclude from valid registration items which do not stand alone but which nevertheless do not form part of a whole article such as cups and saucers, knives and forks⁴. Items such as vehicle main body panels, doors, bonnet lids, boot lids and windscreens have been held not to be validly registrable whilst items such as wing mirrors, wheels, seats and steering wheels have been held not to be so excluded from registrability on the basis that the first category of articles do form an integral part of a vehicle and, on replacement, must be replaced by another article of the same shape or configuration⁵.

1 le a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 As to the meaning of 'article' see PARA 743.

3 See the Registered Designs Act 1949 s 1(1)(b)(ii); and PARA 740. This provision is often referred to as the 'must match' exclusion. This legislation applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734.

4 *Ford Motor Co Ltd and Iveco Fiat SpA's Design Applications* [1993] RPC 399, Registered Designs Appeal Tribunal; affd sub nom *R v Registered Designs Appeal Tribunal, ex p Ford Motor Co Ltd* [1995] 1 WLR 18, HL. Cf, in relation to unregistered design right, *Dyson Ltd v Qualtex (UK) Ltd* [2006] EWCA Civ 166, [2006] RPC 769 at 789.

5 *Ford Motor Co Ltd and Iveco Fiat SpA's Design Applications* [1993] RPC 399 at 420, Registered Designs Appeal Tribunal; affd sub nom *R v Registered Designs Appeal Tribunal, ex p Ford Motor Co Ltd* [1994] RPC 545 (affd, on a different point, [1995] RPC 167). Items in the first category were also held unregistrable as not being 'articles' within the meaning of the Registered Designs Act 1949 s 44(1): see PARA 743.

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748. Novelty.

In order to be validly registered, an old design¹ had to be 'new'². There was no requirement for originality³. There is no statutory definition of 'new' but a design is not to be regarded as 'new' if it is the same as a design registered in respect of the same or any other article in pursuance of a prior application or published in the United Kingdom in respect of the same or any other article before the date of the application, or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade⁴.

A design must be considered as applied to the article for which it was to be registered, and valid registration could be obtained for the application of a design such as a picture to a particular article, even though the picture itself was old⁵.

1 le a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740. See also *Oakley Inc v Animal Ltd* [2005] EWCA Civ 1191, [2006] Ch 337, [2006] RPC 301.

2 See the Registered Designs Act 1949 s 1(2); and PARA 740. This legislation applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2). As to the validity of current designs see PARA 734. As to the requirement of novelty in current designs see PARA 735.

3 Cf the Registered Designs Act 1949 s 1 (as originally enacted).

4 See the Registered Designs Act 1949 s 1(4); and PARA 740. See *Household Articles Ltd's Registered Design* [1998] FSR 676, Patents Court; *A Fulton Co Ltd v Totes Isotoner (UK) Ltd* [2003] RPC 499 (affd [2003] EWCA Civ 1514, [2004] RPC 301). As to the meaning of 'United Kingdom' see PARA 303 note 5.

5 *Saunders v Wiel* [1893] 1 QB 470, 10 RPC 29, CA, overruling *Adams v Clementson* (1879) 12 ChD 714. See also *Dover Ltd v Nürnberger Celluloidwaren Fabrik Gebrüder Wolff* [1910] 2 Ch 25 at 29, 27 RPC 498 at 504. The novelty of the design may consist in contriving a copy or imitation of a figure, which may itself be common to the world, in such a manner as to render it applicable to an article of manufacture: see *Saunders v Wiel* [1893] 1 QB 470 at 476, 10 RPC 29 at 33, CA. See also *Dean's Rag Book Co Ltd v Pomerantz & Sons and Re Dean's Rag Book Co Ltd and Patents and Designs Acts 1907 to 1928* (1930) 47 RPC 485 (figure of Mickey Mouse); *Re Gutta Percha and Rubber (London) Ltd (No 789,574)* (1935) 52 RPC 383, Patents Appeal Tribunal (embossing to imitate coconut matting). As to the meaning of 'article' see PARA 743.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/749. Combinations, improvements and trade variants.

749. Combinations, improvements and trade variants.

In relation to old designs¹, a design might be new even if the parts of which it was composed were old², but two matters could not be combined together and validly registered as a new design. Although the requirements for a valid combination are not as strict as in the case of patents³, as a general rule there has to be some artistic or other advantage from the combination besides that possessed by the parts separately⁴, or at least the combination must have involved some artistic or mental effort⁵. In particular, the choice of variants commonly used in the trade⁶, or of the leading features of well-known articles, do not in general constitute a valid combination⁷. The omission of certain parts might also constitute novelty, but not where that omission is a mere result of a new use of the article⁸. Similarly, purely functional features must be ignored when considering novelty⁹.

While the court bears in mind that the law of designs exists for the purpose of protecting innovations which do not involve such invention as is necessary for the subject matter of a patent¹⁰, it rightly considers that there must be some check on the hampering of industries which would result if every unimportant alteration of shape or pattern could become the subject of a monopoly¹¹.

1 In a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 *Sherwood and Cotton v Decorative Art Tile Co* (1887) 4 RPC 207; *Heinrichs v Bastendorff* (1893) 10 RPC 160; *Re Rollason's Registered Design* [1897] 1 Ch 237, 14 RPC 909, CA (affd sub nom *Heath & Sons Ltd v Rollason* [1898] AC 499, 15 RPC 441, HL).

3 In the following cases combinations were held registrable: *Heinrichs v Bastendorff* (1893) 10 RPC 160 (writing table, the various parts of which were old); *S Knowles & Co Ltd v Bennett & Sons and Bigio* (1895) 12 RPC 137; *Nevill v John Bennett & Sons* (1898) 15 RPC 412; *Wallpaper Manufacturers Ltd v Derby Paper Staining Co* (1925) 42 RPC 443 (combination of old floral designs in a wallpaper).

4 In the following cases combinations were held not registrable: *Hothersall v Moore* (1891) 9 RPC 27 (combination of old red border with yellow chamois leather centre); *Lazarus v Charles* (1873) LR 16 Eq 117 (combination of two old baskets to form double basket); *Mulloney v Stevens* (1864) 10 LT 190 (three ribbons and a button all considered old, combined into a badge; this, however, is a very doubtful case, and is overruled in part by *Saunders v Wiel* [1893] 1 QB 470, 10 RPC 29, CA; *Repetition Woodwork Co Ltd and Hilton v Briggs (t/a Lifford Office Equipment Manufacturing Co)* (1924) 41 RPC 449). See also *Gramophone Co Ltd v Magazine Holder Co* (1911) 28 RPC 221, HL; *Re Universal Plastics Ltd's Application* [1958] RPC 439; *Sebel & Co Ltd's Application (No 1)* [1959] RPC 12; *Sebel & Co Ltd's Application (No 2)* [1959] RPC 19; *Vlisco BV's Application* [1980] RPC 509, Designs Registry.

5 *Phillips v Harbro Rubber Co* (1919) 36 RPC 79 at 85, CA. See also *Re Britvic's Application* [1960] RPC 201, Patents Appeal Tribunal; note 4; and PARA 744. See also *Household Articles Ltd's Registered Design* [1998] FSR 676, Patent Court.

6 See PARA 748.

7 *Pugh v Riley Cycle Co Ltd* (1914) 31 RPC 266 at 283, HL; *Phillips v Harbro Rubber Co* (1920) 37 RPC 233, HL; *Re Universal Plastics Ltd Application (No 884,686)* [1958] RPC 439.

8 *Re Clarke's Registered Design, Clarke v Sax & Co Ltd* [1896] 2 Ch 38 at 47, 13 RPC 351 at 360, CA.

9 *Re Carr's Application* [1973] RPC 689, Registered Designs Appeal Tribunal.

- 10 *Harrison v Taylor* (1859) 4 H & N 815, Ex Ch.
- 11 See the cases cited in PARA 744 note 4.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/750. Scope of designs; statement of novelty.

750. Scope of designs; statement of novelty.

In relation to old designs¹, except in the case of a registration for the pattern or ornament of a design to be applied to a textile article, to wallpaper or similar wall covering or to lace or to sets of textile articles or lace, a statement satisfactory to the registrar² of the features of the design for which novelty³ was claimed has to appear on each representation or specimen of the design⁴. Such a statement is often of great value, as on the one hand it may prevent the registration being interpreted as made for some feature which is old, and on the other it may prevent the registration being confined to non-essential details only put in to show the real design properly⁵. The purpose of a statement of novelty is to direct attention to the part or parts of the illustrated design which are claimed to introduce into it the alleged novel contribution⁶.

In interpreting a design the court will look at it with the eye of a craftsman⁷. In the absence of a specific statement to the contrary, the statement of novelty is not assumed to claim as an essential detail something which is notoriously old⁸, nor, except in the case of some purely decorative designs⁹, is it assumed, unless stated, that the design is intended to be confined to the particular shape or kind of common article on which the design is shown, where the shape of such article has to be continually varied in common use¹⁰. A design is always to be considered as capable of being applied on a larger or smaller scale, if the proportions are kept the same¹¹. A design which is broadly new will be given a wider interpretation when testing infringement than a design which is a mere detailed modification of some older well-known design¹². Where a feature is only shown in minute form or indistinctly, the court is unwilling to presume that it is intended as a distinctive feature¹³. Subject to these rules, the registration is presumed to be for the design as a whole and not for any special feature¹⁴. Colour can be an element of the design, although normally differences in colour are unlikely to be important¹⁵.

In a claim of infringement the same construction must be put on the design for the purpose of determining the issues of novelty and of infringement, and, by analogy, in rectification proceedings, evidence of what the proprietor has claimed to cover by the registration has been admitted against him¹⁶.

1 The designs application for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 As to the registrar see PARA 684.

3 As to novelty see PARA 748.

4 See the Registered Designs Rules 1995, SI 1995/2912, r 15 (now revoked). In *Thomas N Nutbrown Ltd v Taylor, Law & Co Ltd* [1957] RPC 36, a certificate of validity was refused because no statement of the novelty claimed had been filed.

5 See *Walker, Hunter & Co v Falkirk Iron Co* (1887) 14 R 1072, Ct of Sess, at 1082-1083, 4 RPC 390 at 395; *Phillips v Harbro Rubber Co* (1920) 37 RPC 233, HL. The statement may refer to a specimen: see *Re Gutta Percha and Rubber (London) Ltd (No 789,574) Application* (1935) 52 RPC 383, Patents Appeal Tribunal.

6 *Kent and Thanet Casinos Ltd v Bailey's School of Dancing Ltd* [1965] RPC 482 (where the statement of novelty related only to a specific illustration and did not define a general class of pattern). See also *Gaskell & Chambers Ltd v Measure Master Ltd* [1993] RPC 76 (where the statement of novelty was confined to shape and

configuration, it was held that ornament was of no concern). See also *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, Patents County Court.

7 *Varley v Keighley Ironworks Society Ltd* (1896) 14 RPC 169; *Heath & Sons Ltd v Rollason* [1898] AC 499, 15 RPC 441, HL; *Phillips v Harbro Rubber Co* (1920) 37 RPC 233, HL.

8 This applies whether novelty is disputed or not: *Gramophone Co Ltd v Magazine Holder Co* (1911) 28 RPC 221, HL. See also *Walker & Co v A G Scott & Co Ltd* (1892) 9 RPC 482; *Staples v Warwick* (1906) 23 RPC 609, CA. The court is not bound by an admission as to the novelty and originality of the design: *Gramophone Co Ltd v Magazine Holder Co*.

9 See *Rollason's Registered Design* [1898] 1 Ch 237 at 244-245, 14 RPC 909 at 912, CA (where the design was for a coffin plate and Lindley MR expressed the view that, although the claim was for pattern only, the outline could not be left out of account as it really formed part of the pattern).

10 *Re Bayer's Design, Bayer v Symington* (1906) 24 RPC 65, CA; affd (1907) 25 RPC 56, HL. In *Stephenson, Blake & Co v Grant, Legros & Co* (1917) 34 RPC 192, CA, it was held that a design for a fount of type only protected the letters in the order shown. The order in this case was set aside as premature without consideration of the point. See also *Re Associated Colour Printers Ltd's Application (No 814,271)* (1937) 54 RPC 203, Patents Appeal Tribunal. As to designs for flexible articles see *Schmittzehe v Roberts* (1955) 72 RPC 122.

11 *Re Bayer's Design, Bayer v Symington* (1906) 24 RPC 65 at 72, CA; affd (1907) 25 RPC 56, HL.

12 *Simmons v Mathieson & Co Ltd* (1911) 28 RPC 486, CA. See also *Re Plackett's Registered Design* (1892) 9 RPC 436. Cf *John Harper & Co Ltd v Wright and Butler Lamp Manufacturing Co Ltd* [1896] 1 Ch 142, 12 RPC 483, CA; *Jackson v Testar* (1919) 36 RPC 289; *Repetition Woodwork Co Ltd and Hilton v Briggs (t/a Lifford Office Equipment Manufacturing Co)* (1924) 41 RPC 449; *Negretti and Zambra v W F Stanley & Co Ltd* (1925) 42 RPC 358; *Gaskell & Chambers Ltd v Measure Master Ltd* [1993] RPC 76. Cf *Bailey (t/a Elite Angling Products) v Haynes (t/a RAGS)* [2006] EWPCC 5, [2007] FSR 199.

13 *Pilkington Bros Ltd v Abrahams & Son* (1914) 32 RPC 61. In *Vandervell & Co v Lundberg & Sons* (1915) 33 RPC 60, where a design was registered for a switch box, the court refused to consider as a distinctive feature the special switch shown in the representation.

14 *Holdsworth v M'Crea* (1867) LR 2 HL 380; *Thom v Syddall* (1872) 26 LT 15; *Dover Ltd v Nürnberger Celluloidwaren Fabrick Gebrüder Wolff* [1910] 2 Ch 25, 27 RPC 498, CA; *Sackett and Barnes v Clozenberg* (1909) 27 RPC 104; *Pugh v Riley Cycle Co Ltd* [1912] 1 Ch 613 at 618, 29 RPC 196 at 202; *Pilkington Bros Ltd v Abrahams & Sons* (1914) 32 RPC 61. This rule that the design was primarily to be considered for the combination, and not for the separate parts, was not formerly clearly understood and adopted: see eg *Norton v Nicholls* (1859) 1 E & E 761. A design to be applied to both ends of an article has been held not to be infringed by an article having the design applied to one end only: see *Portable Concrete Buildings Ltd v Bathcrete Ltd* [1962] RPC 49.

15 *Smith, Kline and French Laboratories Ltd's Design Application* [1974] RPC 253, Registered Designs Appeal Tribunal; *Cook and Hurst's Design Application* [1979] RPC 197, Registered Designs Appeal Tribunal, where colours applied in particular locations were sufficient to permit the registration of a design of England football shirt. In *Re Associated Colour Printers Ltd's Application (No 814,271)* (1937) 54 RPC 203, Patents Appeal Tribunal, it was said that colour formed no part of a design, but in *Gottschalck & Co v Velez & Co* (1936) 53 RPC 403, colour was clearly taken into account as a distinguishing feature. See also *Norton v Nicholls* (1859) 1 E & E 761; *Nevill v John Bennett & Sons* (1898) 15 RPC 412. In *Re Calder Vale Manufacturing Co Ltd Registered Design, Re Lappett Manufacturing Co Ltd* (1934) 52 RPC 117 at 125, it was said that colour was of secondary importance.

16 *Benchairs Ltd v Chair Centre Ltd* [1974] RPC 429, CA. See also *Re Plackett's Registered Design* (1892) 9 RPC 436; *Re Bayer's Design, Bayer v Symington* (1906) 24 RPC 65, CA (affd (1907) 25 RPC 56, HL). It seems difficult to justify the admission of such evidence, as construction is a matter of law. In *Vandervell & Co v Lundberg & Sons* (1915) 33 RPC 60, the plaintiff's advertisements were used against them on the question of construction.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/751. Prior publication.

751. Prior publication.

In general, the registration of an old design¹ in respect of any article² is invalid if it is the same as a design which before the date of the application for registration was registered or published in the United Kingdom in respect of the same or any other article, or which differs from such a design only in immaterial details or in features which are variants commonly used in the trade³. The general rules as to what constitutes publication of a design resemble those respecting publication in relation to a patent⁴.

1 le a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 As to the meaning of 'article' see PARA 743.

3 See the Registered Designs Act 1949 s 1(4) (substituted by the Copyright, Designs and Patents Act 1988 s 265(1)). There are exceptions in relation to confidential disclosures (see PARA 752), disclosures at certified exhibitions (see PARA 753), disclosures to government departments (see PARA 755), artistic works (see PARA 754) and registration of the same design for other articles (see PARA 756).

4 See PARAS 446-451. If even a single article has passed into public use, it voids a subsequent registration: *Leatheries Ltd v Lycett Saddle and Motor Accessories Co Ltd* (1909) 26 RPC 166. Exposure in a room to which any members of the public have access is in general publication: *Barker v Associated Manufacturers (Gowns and Mantles) Ltd* (1933) 50 RPC 332; *Re Pressler & Co Ltd Registered Design (No 272,672)*, *A Pressler & Co Ltd v Gartside & Co (of Manchester) Ltd and Widd and Owen Ltd* (1933) 50 RPC 240; *Re Vredenburg's Registered Design No 788,451* (1934) 52 RPC 7; *Kangol (Manufacturing) Ltd v Centrokornise (London) Ltd* [1937] 3 All ER 179, 54 RPC 211.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/752. Confidential disclosures.

752. Confidential disclosures.

The registration of an old design¹ is not invalidated, by reason only of:

- 624 (1) the disclosure of the design by the proprietor² to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design³;
- 625 (2) the disclosure of the design in breach of good faith by any person other than the proprietor of the design⁴; or
- 626 (3) in the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design⁵.

It would seem that discussion with a view to an order is not publication if the circumstances are such that it would be contrary to good faith to disclose the design⁶.

¹ ie a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

² As to the proprietorship of current registered designs see PARA 722.

³ Registered Designs Act 1949 s 6(1)(a); cf PARA 447.

⁴ Registered Designs Act 1949 s 6(1)(b). See *Chudzikowski v Sowak* [1956] RPC 332; on appeal [1957] RPC 111, CA.

⁵ Registered Designs Act 1949 s 6(1)(c). Before the Patents and Designs Act 1907 (repealed) it was held that mere discussion with a probable customer did not invalidate registration (*Heinrichs v Bastendoff* (1893) 10 RPC 160), but that, where a traveller showed the design to customers and accepted an order, that invalidated subsequent registration (*Winfeld & Son v Snow Bros* (1890) 8 RPC 15; *Blank v Footman, Pretty & Co* (1888) 39 ChD 678, 5 RPC 653).

⁶ *Gunston v Winox Ltd* [1921] 1 Ch 664, 38 RPC 40, CA. See also *British Insulated and Helsby Cables Ltd v London Electric Wire Co and Smith's Ltd* (1913) 30 RPC 620; *Re Registered Design No 742,187 of Mallards Ltd v Gibbons Bros Rotary Co Ltd* (1931) 48 RPC 315. For another case where communication was held not to be confidential see *Kangol (Manufacturing) Ltd v Centrokomise (London) Ltd* [1937] 3 All ER 179, 54 RPC 211.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/753. Exhibitions.

753. Exhibitions.

The registration of an old design¹ is not invalidated, by reason only:

- 627 (1) that a representation of the design, or any article² to which the design had been applied, had been displayed, with the consent of the proprietor³ of the design, at an exhibition certified by the Secretary of State⁴ for this purpose⁵;
- 628 (2) that after any such display and during the period of the exhibition a representation of the design or any such article had been displayed by any person without the consent of the proprietor⁶; or
- 629 (3) that a representation of the design had been published in consequence of any such display as is mentioned in head (1) above⁷,

if the application for registration of the design was made not later than six months after the opening of the exhibition⁸.

1 le a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 As to the meaning of 'article' see PARA 743.

3 As to the proprietorship of current registered designs see PARA 722.

4 As to the Secretary of State see PARA 684. A certificate issued by the Secretary of State will be valid only if issued not later than the date on which the exhibition opened: *Mod-Tap Corp'n v BI Communications plc* [1999] RPC 333.

5 Registered Designs Act 1949 s 6(2)(a) (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 4).

6 Registered Designs Act 1949 s 6(2)(b).

7 Registered Designs Act 1949 s 6(2)(c). Publication in a journal prior to display at a certified exhibition is not in consequence of that display and is not protected: *Re W Steel & Co Ltd's Application* [1958] RPC 411.

8 Registered Designs Act 1949 s 6(2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/754. Artistic works.

754. Artistic works.

In relation to old designs¹, where an application had been made by or with the consent of the owner of copyright² in an artistic work³ for the registration of a corresponding design⁴, the design is not to be treated as being other than new by reason only of any use made of the artistic work⁵, save where the previous use consisted of or included the sale, letting for hire or offer or exposure for sale or hire of articles⁶ to which had been applied industrially⁷ the design in question or a design differing from it only in immaterial details or in features which are variants commonly used in the trade, and that previous use was made by or with the consent of the copyright owner⁸. The burden of proof under these provisions lies on the proprietor⁹.

1 le designs application for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 le under the Copyright, Designs and Patents Act 1988 Pt I (ss 1-179): see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS**.

3 For these purposes, 'artistic work' has the same meaning as in the Copyright, Designs and Patents Act 1988 Pt I (see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARA 75): Registered Designs Act 1949 s 44(1) (definition added by the Copyright Act 1956 s 44(5); and amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 31(1), (2)).

4 For these purposes, 'corresponding design', in relation to an artistic work, means a design which, if applied to an article, would produce something which would be treated for the purposes of the Copyright, Designs and Patents Act 1988 Pt I as a copy of that work: Registered Designs Act 1949 s 44(1) (definition added by the Copyright Act 1956 s 44(5); and amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 31(1), (5)). As to such copies see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS**.

5 Registered Designs Act 1949 s 6(4) (added by the Copyright Act 1956 s 44(1); substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 4).

6 le other than articles specified in rules made in pursuance of the Registered Designs Act 1949 s 1(5): see PARA 743. The benefit is not lost if the sale or hire, or offer for sale or hire, took place outside the United Kingdom: *Bissell AG's Design* [1964] RPC 125.

7 The Secretary of State may make provision by rules as to the circumstances in which a design is to be regarded for these purposes as 'applied industrially' to articles, or any description of articles: Registered Designs Act 1949 s 6(6) (added by the Copyright Act 1956 s 44(1); substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 4). A design is regarded as 'applied industrially' if it is applied to more than 50 articles which do not all together constitute a single set of articles as defined in the Registered Designs Act 1949 s 44(1) (see PARA 743) or to goods manufactured in lengths or pieces, not being hand-made goods: Registered Designs Rules 1995, SI 1995/2912, r 35 (now revoked). Whether sales have taken place is irrelevant to the question of whether a design has been applied industrially, as it is sufficient that the articles have been produced: *Bampal Materials Handling Ltd's Design* [1981] RPC 44, Design Registry.

8 Registered Designs Act 1949 s 6(5) (added by the Copyright Act 1956 s 44(1); substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 4).

9 *Bampal Materials Handling Ltd's Design* [1981] RPC 44, Design Registry.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/755. Government departments.

755. Government departments.

The registration of an old design¹ is not invalidated, by reason only of the communication of the design by the proprietor² to a government department or to a person authorised by it to consider the merits of the design, or of anything done in consequence of such a communication³.

1 The designs application for registration of which were registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

2 As to the proprietorship of current registered designs see PARA 722.

3 Registered Designs Act 1949 s 6(3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(6) VALIDITY/(ii) Old Designs/756. Registration of design for further articles.

756. Registration of design for further articles.

Where the registered proprietor¹ of an old design² registered in respect of any article³ made an application:

- 630 (1) for registration in respect of one or more other articles, of that design⁴; or
- 631 (2) for registration in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof⁵,

the registration made on that application is not invalidated by reason only of the previous registration or publication of the design⁶.

The right in a design registered by virtue of these provisions does not, however, extend beyond the end of the period, and any extended period, for which the right subsists in the original registered design⁷.

Where any person made an application for the registration of an old design in respect of any article and either:

- 632 (a) that design had been previously registered by another person in respect of some other article⁸; or
- 633 (b) the design to which the application related consisted of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof⁹,

then, if, at any time while the application was pending, the applicant became the registered proprietor of the design previously registered, the above provisions applied as if at the time of making the application the applicant had been the registered proprietor of that design¹⁰.

1 As to the meaning of 'registered proprietor' see PARA 700 note 1.

2 I.e. a design application for registration of which was registered before 9 December 2001 (see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(2), (3)): see PARA 681. As to the meaning of 'design' see PARA 740.

3 As to the meaning of 'article' see PARA 743.

4 Registered Designs Act 1949 s 4(1)(a). As to the effect of prior publication generally see PARA 751.

5 Registered Designs Act 1949 s 4(1)(b); and see *Sebel & Co Ltd's Application* [1959] RPC 12; *Sebel & Co Ltd's Application (No 2)* [1959] RPC 19.

6 Registered Designs Act 1949 s 4(1).

7 Registered Designs Act 1949 s 4(1) proviso (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 2). As to the duration of the right in a registered design see PARA 716.

8 Registered Designs Act 1949 s 4(2)(a).

9 Registered Designs Act 1949 s 4(2)(b).

10 Registered Designs Act 1949 s 4(2).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(7) DECLARATION OF INVALIDITY/757. Grounds for invalidity of registration of a current design.

(7) DECLARATION OF INVALIDITY

757. Grounds for invalidity of registration of a current design.

The registration of a current design¹ may be declared invalid:

- 634 (1) on the ground that it does not fulfil the requirements of the definition of 'design' in the Registered Designs Act 1949²;
- 635 (2) on the ground that it does not fulfil the requirements of the statutory provisions relating to novelty, technical function and public policy³; or
- 636 (3) where any statutory ground of refusal applies⁴.

The registration of a design (the 'later design') may be declared invalid if it is not new or does not have individual character when compared to a design which:

- 637 (a) has been made available to the public on or after the relevant date⁵; but
- 638 (b) is protected as from a date prior to the relevant date by virtue of (i) registration under the Registered Designs Act 1949 or the Community Design Regulation or an application for such registration; or (ii) an international registration designating the Community⁶.

The registration of a design may be declared invalid on the ground of the registered proprietor not being the proprietor of the design and the proprietor of the design objecting⁷. The registration of a design involving the use of an earlier distinctive sign may be declared invalid on the ground of an objection by the holder of rights to the sign which include the right to prohibit in the United Kingdom such use of the sign⁸. The registration of a design constituting an unauthorised use of a work protected by the law of copyright in the United Kingdom may be declared invalid on the ground of an objection by the owner of the copyright⁹.

An appeal lies from any decision of the registrar under these provisions¹⁰.

1 As to the meaning of 'design' see PARA 734. For the purposes of the Registered Designs Act 1949 ss 11ZA, 11ZB, 11ZC, 11ZE (other than s 11ZE(1): see PARA 721) references to the registration of a design include references to the former registration of a design; and those sections apply, with necessary modifications, in relation to such former registrations: s 11ZA(5) (s 11ZA added by SI 2001/3949). As to registrations under the Registered Designs Act 1949 which have resulted from applications made on or after 1 August 1989 and before 9 December 2001 see the Registered Designs Regulations 2001, SI 2001/3949, reg 12. The Registered Designs Act 1949 as it had effect immediately before the coming into force of the Registered Design Regulations 2001, SI 2001/3949, continues to apply in relation to post-1989 registrations so far as the Registered Designs Act 1949 relates to the cancellation or invalidation of such registrations (other than cancellation by virtue of s 11(3) and by reference to an expiry of copyright occurring on or after 9 December 2001 (ie the date on which the Regulations came into force)): see reg 12(2). Accordingly, the amendments and repeals made by the Registered Design Regulations 2001, SI 2001/3949, do not, so far as they relate to the cancellation or invalidation of registrations, apply in relation to post-1989 registrations: reg 12(3). For the grounds of invalidity of an old design registration see PARA 758.

2 Registered Designs Act 1949 s 11ZA(1)(a) (added by SI 2001/3949; substituted by SI 2006/1974). As to the requirements of the definition of 'design' in the Registered Designs Act 1949 s 1(2) see PARA 734. Any person interested may make an application to the registrar for a declaration of invalidity under the Registered Designs

Act 1949 s 11ZA(1)(a): s 11ZB(1) (added by SI 2001/3949; amended by SI 2006/1974). As to applications for invalidity see PARA 759.

3 Registered Designs Act 1949 s 11ZA(1)(b) (as added and substituted: see note 2). The statutory provisions referred to in the text are s 1B (novelty and individual character: see PARA 735), s 1C (designs dictated by their technical function: see PARAS 737-738), s 1D (designs contrary to public policy or morality: see PARA 739). Any person interested may make an application to the registrar for a declaration of invalidity under the Registered Designs Act 1949 s 11ZA(1)(b): s 11ZB(1) (as added and amended: see note 2).

4 Registered Designs Act 1949 s 11ZA(1)(c) (as added and substituted: see note 2). As to the statutory grounds of refusal see Sch A1; and PARA 708. Any person concerned by the use in question may make an application to the registrar for a declaration of invalidity under s 11ZA(1)(c): s 11ZB(2) (as added and amended: see note 2).

5 Registered Designs Act 1949 s 11ZA(1A)(a) (added by SI 2006/1974). 'Relevant date' means the date on which the application for the registration of the later design was made or is treated by virtue of the Registered Designs Act 1949 s 3B(2), (3) or (5) (see PARA 709) or s 14(2) (see PARA 712) as having been made: s 11ZA(1B) (added by SI 2006/1974). The relevant person may make an application to the registrar for a declaration of invalidity under the Registered Designs Act 1949 s 11ZA(1A): s 11ZB(3) (as added and amended: see note 2). 'Relevant person' means, in relation to an earlier design protected by virtue of registration under the Registered Designs Act 1949 or the Community Design Regulation or an application for such registration, the registered proprietor of the design, the holder of the registered community design or (as the case may be) the applicant: Registered Designs Act 1949 s 11ZB(4) (added by SI 2001/3949; amended by SI 2003/550).

6 Registered Designs Act 1949 s 11ZA(1A)(b) (added by SI 2006/1974; substituted by SI 2007/3378). See EC Council Regulation 6/2002 of 13 December 2001 on Community Designs (OJ L3, 5.1.2002, p 1).

7 Registered Designs Act 1949 s 11ZA(2) (as added: see note 1). As to the proprietorship of registered designs see PARA 722. The person able to make an objection under s 11ZA(2) may make an application to the registrar for a declaration of invalidity: s 11ZB(5) (added by SI 2001/3949; amended by SI 2006/1974).

8 Registered Designs Act 1949 s 11ZA(3) (as added: see note 1). As to the meaning of 'United Kingdom' see PARA 303 note 5. The person able to make an objection under s 11ZA(3) may make an application to the registrar for a declaration of invalidity: s 11ZB(5) (as added and amended: see note 7).

9 Registered Designs Act 1949 s 11ZA(4) (as added: see note 1). See further **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS**. The person able to make an objection under s 11ZA(4) may make an application to the registrar for a declaration of invalidity: s 11ZB(5) (as added and amended: see note 7).

10 Registered Designs Act 1949 s 11ZF (added by SI 2001/3949). As to the registrar see PARA 684.

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758. Cancellation of registration of old design.

At any time after an old design¹ has been registered, any person interested² may apply to the registrar³ for the cancellation of the registration of the design on the ground that:

- 639 (1) the design was not, at the date of registration⁴, new⁵, or on any other ground on which the registrar could have refused to register the design⁶;
- 640 (2) the design was at the time it was registered a corresponding design⁷ in relation to an artistic work⁸ in which copyright subsisted and the right in the registered design has expired⁹;

and the registrar must make such order on the application as he thinks fit¹⁰.

An appeal lies from an order of the registrar to the Appeal Tribunal¹¹.

1 As to the meaning of 'design' see PARA 734.

2 A person trading abroad in an area to which, by local legislation, a United Kingdom design extends is not for that reason a person interested: see *Re Israelachvili's Application* (1954) 72 RPC 1, Patents Appeal Tribunal.

3 As to the registrar see PARA 684.

4 As to the date of registration see PARA 714.

5 As to novelty see PARA 748.

6 Registered Designs Act 1949 s 11(2) (amended by the Copyright, Designs and Patents Act 1988 ss 272, 303(2), Sch 3 para 6(1), (2), Sch 8). These grounds include lack of entitlement to apply: *Leara Trading Co Ltd's Designs* [1991] RPC 609. As to the grounds for invalidity of registration of current designs see PARA 757.

A cancellation under the Registered Designs Act 1949 s 11(2) takes effect from the date of registration or from such other date as the registrar may direct: s 11(4)(b) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 6(1), (3)).

7 As to the meaning of 'corresponding design' see PARA 754 note 4.

8 As to the meaning of 'artistic work' see PARA 754 note 3.

9 Registered Designs Act 1949 s 11(3) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 6(1), (3)). See also note 6. A cancellation under the Registered Designs Act 1949 s 11(3) takes effect from the date on which the right in the registered design expired or from such other date as the registrar may direct: s 11(4)(c) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 6(1), (3)).

10 Registered Designs Act 1949 s 11(2) (as amended: see note 6), s 11(3) (as substituted: see note 9).

11 Registered Designs Act 1949 s 11(5) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 6(1), (3)). As to the Appeals Tribunal see PARAS 692-693.

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759. Application for declaration of invalidity.

An application for a declaration of invalidity may be made to the registrar in relation to a design at any time after the design has been registered¹. An application for a declaration of invalidity must be in the prescribed form and include a statement of the grounds on which the application is made². The statement of grounds must include a concise statement of the facts and grounds on which the applicant relies and be verified by a statement of truth³. The registrar⁴ must send a copy of the form and the statement of case to the registered proprietor⁵. The registrar must specify a period within which the registered proprietor must file a counter-statement⁶. The registered proprietor must file his counter-statement on the prescribed form⁷ and send a copy of it to the applicant within that period, otherwise the registrar may treat him as not opposing the application⁸. In his counter-statement the registered proprietor must include a concise statement of the facts on which he relies⁹. He must also state which of the allegations in the statement of grounds he denies, which of the allegations he is unable to admit or deny, but which he requires the applicant to prove, and also which allegations he admits¹⁰. The counter-statement must be verified by a statement of truth¹¹.

When the period specified for filing the counter-statement has expired, the registrar must specify the periods within which evidence may be filed by the parties¹². Where the applicant for a declaration of invalidity files no evidence (other than his statement of grounds) in support of his application, the registrar may treat him as having withdrawn his application¹³. The registrar may, at any time if he thinks fit, give leave to either party to file evidence upon such terms as he thinks fit¹⁴. Evidence may only be considered to be filed when it has been received by the registrar and it has been sent to all other parties to the proceedings¹⁵.

The registrar must give the parties an opportunity to be heard¹⁶, and where any party requests to be heard, the registrar must send to the parties notice of a date for the hearing¹⁷.

1 Registered Designs Act 1949 s 11ZB(6) (added by SI 2001/3949). As to who may make applications for invalidity under the Registered Designs Act 1949 s 11ZA see s 11ZB; and PARA 757 note 4. As to applications in relation to old designs see the Registered Designs Act 1949 s 11(2) (amended by the Copyright, Designs and Patents Act 1988 ss 272, 303(2), Sch 3 para 6(1), (2), Sch 8); and PARA 758.

2 Registered Designs Rules 2006, SI 2006/1975, r 15(1). The application must be made on Form DF19A: see r 15(1).

3 Registered Designs Rules 2006, SI 2006/1975, r 15(2).

4 As to the registrar see PARA 684.

5 Registered Designs Rules 2006, SI 2006/1975, r 15(3). As to the proprietorship of registered designs see PARA 722. 'Statement of case' means the statement of grounds filed by the applicant or the counter-statement filed by the registered proprietor; and references to the statement of case include part of the statement of case: r 15(7).

6 Registered Designs Rules 2006, SI 2006/1975, r 15(4).

7 See on Form DF19B: see r 15(5).

8 Registered Designs Rules 2006, SI 2006/1975, r 15(5).

9 Registered Designs Rules 2006, SI 2006/1975, r 15(6).

- 10 Registered Designs Rules 2006, SI 2006/1975, r 15(6).
- 11 Registered Designs Rules 2006, SI 2006/1975, r 15(6).
- 12 Registered Designs Rules 2006, SI 2006/1975, r 16(1).
- 13 Registered Designs Rules 2006, SI 2006/1975, r 16(2).
- 14 Registered Designs Rules 2006, SI 2006/1975, r 16(3).
- 15 Registered Designs Rules 2006, SI 2006/1975, r 16(4).
- 16 Registered Designs Rules 2006, SI 2006/1975, r 16(5).
- 17 Registered Designs Rules 2006, SI 2006/1975, r 16(6).

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760. Determination of application for declaration of invalidity.

Where an application has been made to the registrar¹ for a declaration of invalidity in relation to a registration of a current design² and it appears to the registrar that the application has not been made in accordance with any rules made under the Registered Designs Act 1949, he may refuse the application³. If it appears to the registrar that the application has not been made in accordance with the statutory provisions⁴, he must refuse the application⁵. Subject to this, the registrar must make a declaration of invalidity if it appears to him that the ground of invalidity specified in the application has been established in relation to the registration⁶. Otherwise the registrar must refuse the application⁷.

When the registrar has made a decision on the application for a declaration of invalidity, he must send the parties written notice of it, stating the reasons for his decision⁸. The date on which the decision was sent to the applicant is deemed to be the date of the decision for the purposes of any appeal⁹.

A declaration of invalidity in relation to a current design may be a declaration of partial invalidity¹⁰. Where the registrar declares the registration of a design invalid to any extent, the registration is, to that extent, treated as having been invalid from the date of registration or from such other date as the registrar may direct¹¹.

An appeal lies from any decision of the registrar under these provisions¹².

1 As to the registrar see PARA 684.

2 Registered Designs Act 1949 s 11ZC(1) (s 11ZC added by SI 2001/3949). As to applications for declarations of invalidity see PARA 759.

3 Registered Designs Act 1949 s 11ZC(2) (as added: see note 2).

4 I.e. the Registered Designs Act 1949 s 11ZB: see PARA 757.

5 Registered Designs Act 1949 s 11ZC(3) (as added: see note 2).

6 Registered Designs Act 1949 s 11ZC(4) (as added: see note 2). As to the grounds of invalidity see PARA 757.

7 Registered Designs Act 1949 s 11ZC(5) (as added: see note 2). In relation to old designs, the registrar may make such order as he thinks fit: see the Registered Designs Act 1949 s 11(2), (3) (amended by the Copyright, Designs and Patents Act 1988 ss 272, 303(2), Sch 3 para 6(1), (2), Sch 8); and PARA 758.

8 Registered Designs Rules 2006, SI 2006/1975, r 17(1).

9 Registered Designs Rules 2006, SI 2006/1975, r 17(2).

10 Registered Designs Act 1949 s 11ZC(6) (as added: see note 2).

11 Registered Designs Act 1949 s 11ZE(2) (added by SI 2001/3949). As to the effective date in relation to old designs see the Registered Designs Act 1949 s 11(4), (5) (substituted by the Copyright, Designs and Patents Act 1988 Sch 3 para 6(1), (3)); and PARA 758.

12 Registered Designs Act 1949 s 11ZF (added by SI 2001/3949).

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761. Modification of registration.

Where the registrar¹ intends to declare the registration of a current design invalid², he must inform the registered proprietor of that fact³. The registered proprietor may make an application to the registrar for the registrar to make such modifications to the registration of the design as the registered proprietor specifies in his application⁴. Such modifications may, in particular, include the inclusion on the register of a partial disclaimer by the registered proprietor⁵. If it appears to the registrar that the application has not been made in accordance with the rules made under the Registered Designs Act 1949, the registrar may refuse the application⁶. If it appears to the registrar that the identity of the design is not retained or the modified registration would be invalid⁷, the registrar must refuse the application⁸. Otherwise the registrar must make the specified modifications⁹. An appeal lies from any decision of the registrar under these provisions¹⁰.

A modification of a registration has effect, and is to be treated always to have had effect, from the grant of registration¹¹.

1 As to the registrar see PARA 684.

2 I.e. under the Registered Designs Act 1949 s 11ZA(1)(b) or (c), (1A), (3) or (4): see PARA 757.

3 Registered Designs Act 1949 s 11ZD(1), (2) (s 11ZD added by SI 2001/3949; the Registered Designs Act 1949 s 11ZD(1) amended by SI 2006/1974). This requirement does not apply to old designs: see PARA 758. As to the proprietorship of registered designs see PARA 722.

4 Registered Designs Act 1949 s 11ZD(3) (as added: see note 3).

5 Registered Designs Act 1949 s 11ZD(4) (as added: see note 3).

6 Registered Designs Act 1949 s 11ZD(5) (as added: see note 3).

7 I.e. by virtue of the Registered Designs Act 1949 s 11ZA: see PARA 757.

8 Registered Designs Act 1949 s 11ZD(6) (as added: see note 3).

9 Registered Designs Act 1949 s 11ZD(7) (as added: see note 3).

10 Registered Designs Act 1949 s 11ZF (added by SI 2001/3949).

11 Registered Designs Act 1949 s 11ZD(8) (as added: see note 3).

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(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS

762. Right given by registration of a design.

The registration of a design¹ under the Registered Designs Act 1949 gives the registered proprietor² the exclusive right to use the design and any design which does not produce on the informed user a different overall impression³.

Any reference⁴ to the use of a design includes a reference to:

- 641 (1) the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied; or
- 642 (2) stocking such a product for those purposes⁵.

In determining whether a design produces a different overall impression on the informed user, the degree of freedom of the author in creating his design is to be taken into consideration⁶.

The right conferred is subject to any limitation attaching to the registration in question, including, in particular, any partial disclaimer or any declaration by the registrar or a court of partial invalidity⁷.

The right in a registered design is infringed by a person who, without the consent of the registered proprietor, does anything which is the exclusive right⁸ of the registered proprietor⁹.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs). In relation to old designs, the registered proprietor is not entitled to prevent any person from continuing to carry out acts begun by him before 9 December 2001 and which, at that time, the registered proprietor would have been unable to prevent: see the Registered Designs Regulations 2001, SI 2001/3949, reg 14(3).

2 As to the meaning of 'registered proprietor' see PARA 700 note 1.

3 Registered Designs Act 1949 s 7(1) (s 7 substituted by SI 2001/3949). See PARA 763. This legislation also applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4). The fact that post-1989 registrations are in respect of any articles, or sets of articles, is to be disregarded: reg 12(5). As to the validity of old designs see PARA 740.

4 I.e. for the purposes of the Registered Designs Act 1949 s 7(1) and s 7A (see PARA 764).

5 Registered Designs Act 1949 s 7(2) (as substituted: see note 3).

6 Registered Designs Act 1949 s 7(3) (as substituted: see note 3). See PARA 763.

7 Registered Designs Act 1949 s 7(4) (as substituted: see note 3). See PARA 709.

8 I.e. by virtue of the Registered Designs Act 1949 s 7.

9 Registered Designs Act 1949 s 7A(1) (s 7A added by SI 2001/3949). This legislation also applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4).

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763. Test for infringement.

A design infringes the right given by registration if it does not produce on the informed user a different overall impression¹. An informed user is not the same as a person 'skilled in the art' of patent law² nor the average consumer of trade mark law³. The informed user is a user who has experience of other similar articles and who will be reasonably discriminatory; he is able to appreciate enough detail to decide whether a design creates an overall impression which has individual character and whether an alleged infringement produces a different overall impression⁴. The test of different overall impression is imprecise as it is necessarily subjective⁵. It is sufficient to avoid infringement if the accused product is of a design which produces a 'different overall impression'; there is no policy requirement that the difference be 'clear'⁶. The overall impression is what strikes the mind of the informed user when it is carefully viewed, not what he may recollect afterwards⁷.

1 See the Registered Designs Act 1949 s 7(1); and PARA 762.

2 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [16], [2007] IP & T 464 at [16], [2008] FSR 208 at [16] per Jacob LJ. As to persons skilled in the art in relation to patent law see PARA 456.

3 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [24], [2007] IP & T 464 at [24], [2008] FSR 208 at [24] per Jacob LJ.

4 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [23], [2007] IP & T 464 at [23], [2008] FSR 208 at [23] per Jacob LJ. See also *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1.

5 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [34], [2007] IP & T 464 at [34], [2008] FSR 208 at [34] per Jacob LJ. See also *J Choo (Jersey) Ltd v Towerstone Ltd* [2008] EWHC 346 (Ch), [2008] All ER (D) 35 (Jan), [2008] FSR 485.

6 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [19], [2007] IP & T 464 at [19], [2008] FSR 208 at [19] per Jacob LJ.

7 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [25], [2007] IP & T 464 at [25], [2008] FSR 208 at [25] per Jacob LJ.

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764. Exceptions to infringement.

The right in a registered design¹ is not infringed by:

- 643 (1) an act which is done privately and for purposes which are not commercial²;
- 644 (2) an act which is done for experimental purposes³;
- 645 (3) an act of reproduction for teaching purposes or for the purpose of making citations provided that the act of reproduction is compatible with fair trade practice and does not unduly prejudice the normal exploitation of the design and mention is made of the source⁴;
- 646 (4) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in the United Kingdom⁵;
- 647 (5) the importation into the United Kingdom of spare parts or accessories for the purpose of repairing such ships or aircraft⁶; or
- 648 (6) the carrying out of repairs on such ships or aircraft⁷.

The right in a registered design is not infringed by an act which relates to a product in which any design protected by the registration is incorporated or to which it is applied if the product has been put on the market in the European Economic Area by the registered proprietor or with his consent⁸.

The right in a registered design of a component part which may be used for the purpose of the repair of a complex product so as to restore its original appearance is not infringed by the use for that purpose of any design protected by the registration⁹.

No proceedings may be taken in respect of an infringement of the right in a registered design committed before the date on which the certificate of registration¹⁰ of the design under the Registered Designs Act 1949 is granted¹¹.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 Registered Designs Act 1949 s 7A(2)(a) (s 7A added by SI 2001/3949). This legislation also applies to the registration of any design application for which was made before 9 December 2001: see the Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4). As to the validity of old designs see PARA 740.

3 Registered Designs Act 1949 s 7A(2)(b) (as added: see note 2).

4 Registered Designs Act 1949 s 7A(2)(c), (3) (as added: see note 2).

5 Registered Designs Act 1949 s 7A(2)(d) (as added: see note 2). As to the meaning of 'United Kingdom' see PARA 303 note 5.

6 Registered Designs Act 1949 s 7A(2)(e) (as added: see note 2).

7 Registered Designs Act 1949 s 7A(2)(f) (as added: see note 2).

8 Registered Designs Act 1949 s 7A(4) (as added: see note 2). As to the meaning of 'registered proprietor' see PARA 700 note 1.

9 Registered Designs Act 1949 s 7A(5) (as added: see note 2).

10 As to the certificate of registration see PARA 715.

11 Registered Designs Act 1949 s 7A(6) (as added: see note 2). In relation to old designs, the registered proprietor is not entitled to prevent any person from continuing to carry out acts begun by him before 9 December 2001 and which, at that time, the registered proprietor would have been unable to prevent: see the Registered Design Regulations 2001, SI 2001/3949, reg 14(3).

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765. Claims for infringement.

An infringement of the right in a registered design¹ is actionable by the registered proprietor². In an action for infringement all such relief by way of damages³, injunctions⁴, accounts or otherwise is available to him as is available in respect of the infringement of any other property right⁵.

If in any proceedings before the court the validity of the registration of a design is contested, and it is found by the court that the design is, to any extent, validly registered, the court may certify that the validity of the registration of the design was contested in those proceedings⁶. Where any such certificate has been granted, then if in any subsequent proceedings before the court for infringement of the right in the registered design or for invalidation of the registration of the design, a final order or judgment is made or given in favour of the registered proprietor, unless the court otherwise directs, he is entitled to his costs as between solicitor and client⁷. This does not apply to the costs of any appeal in any such proceedings⁸.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs). As to the right given by registration see the Registered Designs Act 1949 s 7; and PARA 762.

2 Registered Designs Act 1949 s 24A(1) (s 24A added by SI 2006/1028). As to the meaning of 'registered proprietor' see PARA 700 note 1. The Registered Designs Act 1949 s 24A has effect subject to s 24B (exemption of innocent infringer from liability: see PARA 766): s 24A(3) (as so added). As to the concurrent right of an exclusive licensee see PARA 768.

3 The court will readily infer that a proportion of the infringing sales would have benefited the registered proprietor, even where the design is not licensed to others, but the burden of proof of loss lies on the claimant. Damages may be awarded as a reasonable royalty on infringing sales: *P B Cow Ltd v Cannon Rubber Manufacturers Ltd* [1961] RPC 236. As to damages generally see PARA 546 et seq; and **DAMAGES** vol 12(1) (Reissue) PARA 801 et seq. See also *Rosedale Associated Manufacturers v Airfix Products Ltd* [1959] RPC 249 (inquiry as to damages). An account of profits may also be granted: see **EQUITY** vol 16(2) (Reissue) PARA 553. Accounts are rarely taken.

4 The proper form of injunction is against 'infringing the design', not 'the design or any part of it', since the registration only protects the whole: *John Harper & Co Ltd v Wright and Butler Lamp Manufacturing Co Ltd* [1896] 1 Ch 142 at 158, 12 RPC 483 at 496, CA. Where, in the case of an old design, the registration is for shape only or pattern only, the injunction may be limited accordingly (*Re Manchester's Design, Manchester v Umfreville & Son* (1907) 24 RPC 782), although this would seem to be unnecessary. In *JT Smith and JE Jones Ltd v Service, Reeve & Co Ltd* [1914] 2 Ch 576, 31 RPC 319, Sargant J held that, where there had been infringement, the claimant was entitled to the publicity of an injunction; but in *Winkle & Co Ltd v Cent & Son* (1914) 31 RPC 473, CA, the court held that, where the defendant had offered an undertaking, this would in general be sufficient. As to injunctions generally see **CIVIL PROCEDURE** vol 11 (2009) PARA 331 et seq.

5 Registered Designs Act 1949 s 24A(2) (as added: see note 2). As to the reliefs available see PARA 538; and **CIVIL PROCEDURE** vol 11 (2009) PARA 315 et seq.

6 Registered Designs Act 1949 s 25(1) (amended by SI 2001/3949); Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4). As to such certificates see PARA 551.

7 Registered Designs Act 1949 s 25(2) (amended by the Copyright, Designs and Patents Act 1988 s 272, Sch 3 para 14; and by SI 2001/3949); Registered Designs Regulations 2001, SI 2001/3949, regs 1, 12(4). 'Solicitor and own client' costs no longer exist as a basis for taxation. Taxation of costs is now either on the standard basis or on the indemnity basis: see CPR 44.4; and **CIVIL PROCEDURE**.

8 Registered Designs Act 1949 s 25(2) proviso.

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766. Exemption of innocent infringer from liability.

In proceedings for the infringement of the right in a registered design¹ damages may not be awarded, and no order may be made for an account of profits², against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the design was registered³. For these purposes, a person is not deemed to have been aware or to have had reasonable grounds for supposing that the design was registered by reason only of the marking of a product⁴ with: (1) the word 'registered' or any abbreviation thereof; or (2) any word or words expressing or implying that the design applied to, or incorporated in, the product has been registered, unless the number of the design accompanied the word or words or the abbreviation in question⁵. Nothing in the above provisions affects the power of the court⁶ to grant an injunction in any proceedings for infringement of the right in a registered design⁷.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs). As to the right given by registration see the Registered Designs Act 1949 s 7; and PARA 762.

2 See **EQUITY** vol 16(2) (Reissue) PARA 553.

3 Registered Designs Act 1949 s 24B(1) (s 24B added by SI 1006/1028). This defence is not available in respect of community designs: *J Choo (Jersey) Ltd v Towerstone Ltd* [2008] EWHC 346 (Ch), [2008] All ER (D) 35 (Jan), [2008] FSR 485.

4 As to the meaning of 'product' see PARA 734 note 1.

5 Registered Designs Act 1949 s 24B(2) (as added: see note 3).

6 As to the meaning of 'court' see PARA 691.

7 Registered Designs Act 1949 s 24B(3) (as added: see note 3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS/767. Order for delivery up and disposal.

767. Order for delivery up and disposal.

Where a person:

- 649 (1) has in his possession, custody or control for commercial purposes¹ an infringing article²; or
- 650 (2) has in his possession, custody or control anything specifically designed or adapted for making articles to a particular design which is a registered design, knowing or having reason to believe that it has been or is to be used to make an infringing article,

the registered proprietor³ in question may apply to the court⁴ for an order that the infringing article or other thing be delivered up to him or to such other person as the court may direct⁵.

An application may not be made after the end of the period of six years from the date on which the article or thing in question was made, unless the registered proprietor is under a disability⁶ or is prevented by fraud or concealment from discovering the facts entitling him to apply for an order, in which case an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts⁷.

No order may be made unless the court also makes, or it appears to the court that there are grounds for making, an order as to the disposal of infringing articles⁸. A person to whom an infringing article or other thing is delivered up in pursuance of an order for delivery up, if an order as to disposal is not made, must retain it pending the making of such an order, or the decision not to make such an order⁹.

An application may be made to the court for an order that an infringing article or other thing delivered up in pursuance of an order¹⁰ must be: (a) forfeited to the registered proprietor; or (b) destroyed or otherwise dealt with as the court may think fit, or for a decision that no such order should be made¹¹. In considering what order, if any, should be made, the court must consider whether other remedies available in an action for infringement of the right in a registered design would be adequate to compensate the registered proprietor and to protect his interests¹². Where there is more than one person interested¹³ in an article or other thing, the court must make such order as it thinks just and may, in particular, direct that the thing be sold, or otherwise dealt with, and the proceeds divided¹⁴. If the court decides that no order should be made, the person in whose possession, custody or control the article or other thing was before being delivered up is entitled to its return¹⁵.

1 The reference to an act being done in relation to an article for 'commercial purposes' is to its being done with a view to the article in question being sold or hired in the course of a business: Registered Designs Act 1949 s 24C(7) (ss 24C, 24D, 24E, 24G added by SI 2006/1028).

2 In the Registered Designs Act 1949, 'infringing article', in relation to a design, is to be construed in accordance with s 24G, which states that an article is an infringing article if its making to that design was an infringement of the right in a registered design: Registered Designs Act 1949 s 24G(1), (2) (as added: see note 1). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs). As to the right given by registration see PARA 762. An article is also an infringing article if: (1) it has been or is proposed to be imported into the United Kingdom; and (2) its making to that design in the United Kingdom would have been an infringement of the right in a registered design or a breach of an exclusive licensing agreement relating to that registered design: s 24G(3) (as so added). As to the meaning of 'United Kingdom' see PARA 303 note 5. As to

exclusive licensing agreements see PARA 724. Nothing in s 24G(3) is to be construed as applying to an article which may be lawfully imported into the United Kingdom by virtue of an enforceable Community right within the meaning of the European Communities Act 1972 s 2(1) (see **CONSTITUTIONAL LAW AND HUMAN RIGHTS** vol 8(2) (Reissue) PARA 24); Registered Designs Act 1949 s 24G(5) (as so added). Where it is shown that an article is made to a design which is or has been a registered design, it is to be presumed until the contrary is proved that the article was made at a time when the right in the registered design subsisted: s 24G(4) (as so added).

3 As to the meaning of 'registered proprietor' see PARA 700 note 1.

4 As to the meaning of 'court' see PARA 691.

5 Registered Designs Act 1949 s 24C(1) (as added: see note 1). Nothing in s 24C affects any other power of the court: s 24C(8) (as added: see note 1). As to the jurisdiction of the county court in Northern Ireland see s 24E (as added: see note 1).

6 For this purpose, 'disability', in England and Wales, has the same meaning as in the Limitation Act 1980 (see **LIMITATION PERIODS** vol 68 (2008) PARA 1170) and, in Northern Ireland, has the same meaning as in the Statute of Limitations (Northern Ireland) 1958: Registered Designs Act 1949 s 24C(5) (as added: see note 1).

7 Registered Designs Act 1949 s 24C(2), (3), (4) (as added: see note 1).

8 Registered Designs Act 1949 s 24C(2) (as added: see note 1). An order as to the disposal of infringing articles is made under s 24D: see the text and notes 10-15.

9 Registered Designs Act 1949 s 24C(6) (as added: see note 1).

10 Is an order under the Registered Designs Act 1949 s 24C: see the text and notes 1-9.

11 Registered Designs Act 1949 s 24D(1) (as added: see note 1).

12 Registered Designs Act 1949 s 24D(2) (as added: see note 1).

13 References to a person having an interest in an article or other thing include any person in whose favour an order could be made in respect of it under the Registered Designs Act 1949 s 24D, under the Trade Marks Act 1994 s 19 (including that provision as applied by the Community Trade Mark Regulations 2006, SI 2006/1027, reg 4 (see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 463)), under the Copyright, Designs and Patents Act 1988 ss 114, 204, 231 (see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARAS 535, 713) or s 231 (see PARA 535); or under the Community Design Regulations 2005, SI 2005/2339, reg 1C (see PARA 779); Registered Designs Act 1949 s 24D(5) (as added: see note 1).

14 Registered Designs Act 1949 s 24D(3) (as added: see note 1).

15 Registered Designs Act 1949 s 24D(4) (as added: see note 1).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS/768. Rights and remedies of exclusive licensee.

768. Rights and remedies of exclusive licensee.

In relation to a registered design¹, an exclusive licensee² has, except against the registered proprietor³, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment⁴. His rights and remedies are concurrent with those of the registered proprietor⁵.

In an action brought by an exclusive licensee by virtue of these provisions, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the registered proprietor⁶. Where an action for infringement of the right in a registered design brought by the registered proprietor or an exclusive licensee relates (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court⁷, proceed with the action unless the other is either joined as a claimant or added as a defendant⁸.

Where an action for infringement of the right in a registered design is brought which relates (wholly or partly) to an infringement in respect of which the registered proprietor and an exclusive licensee have concurrent rights of action, the court, in assessing damages, must take into account: (1) the terms of the licence; and (2) any pecuniary remedy already awarded or available to either of them in respect of the infringement⁹. No account of profits may be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement¹⁰. If an account of profits is directed, the court may apportion the profits between the registered proprietor and the exclusive licensee as the court considers just, subject to any agreement between them¹¹. These provisions apply whether or not the proprietor and the exclusive licensee are both parties to the action¹².

The registered proprietor must notify any exclusive licensee having concurrent rights before applying for an order for delivery up of an infringing article¹³; and the court may on the application of the licensee make such order¹⁴ as it thinks fit having regard to the terms of the licence¹⁵.

1 As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs).

2 As to exclusive licensees see PARA 724.

3 As to the meaning of 'registered proprietor' see PARA 700 note 1.

4 Registered Designs Act 1949 s 24F(1) (s 24F added by SI 2006/1028). As to assignment see PARA 723.

5 Registered Designs Act 1949 s 24F(2) (as added: see note 4). References to the registered proprietor in the provisions of the Registered Designs Act 1949 relating to infringement are to be construed accordingly: s 24F(2) (as so added).

6 Registered Designs Act 1949 s 24F(3) (as added: see note 4).

7 As to the meaning of 'court' see PARA 691.

8 Registered Designs Act 1949 s 24F(4) (as added: see note 4). A registered proprietor or exclusive licensee who is added as a defendant in pursuance of s 24F(4) is not liable for any costs in the action unless he takes part in the proceedings: s 24F(5) (as added: see note 4). The provisions of s 24F(4) and (5) do not affect the

granting of interlocutory relief on the application of the registered proprietor or an exclusive licensee: s 24F(6) (as added: see note 4).

9 Registered Designs Act 1949 s 24F(7)(a) (as added: see note 4).

10 Registered Designs Act 1949 s 24F(7)(b) (as added: see note 4).

11 Registered Designs Act 1949 s 24F(7)(c) (as added: see note 4).

12 Registered Designs Act 1949 s 24F(7) (as added: see note 4).

13 Ie an order under the Registered Designs Act 1949 s 24C: see PARA 767.

14 Ie under the Registered Designs Act 1949 s 24C: see PARA 767.

15 Registered Designs Act 1949 s 24F(8) (as added: see note 4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS/769. Defences and counterclaims.

769. Defences and counterclaims.

The ordinary defences in an action for infringement are a denial of the infringement, a plea of leave and licence, or an attack on the validity of the registration¹. A defendant may counterclaim for declaration of invalidity and rectification of the register², but, if he does so, he must serve a copy of the counterclaim on the registrar, who then becomes entitled to take such part in the proceedings as he thinks fit³.

1 Such attacks are generally on the ground of default of title, or lack of novelty or subject matter, or that the applicant was not the author. As to validity see PARA 734 et seq. Where, in an action to restrain the infringement of a registered design, the defendant has admitted the novelty and originality of the claimant's design, the court is not precluded from inquiring whether the design is in fact novel and original, and, if it is of opinion that it is not so, giving judgment for the defendant on that ground: see *Gramophone Co Ltd v Magazine Holder Co* (1911) 28 RPC 221, HL, and cf *Re Schwerin's Patent* (1914) 31 RPC 229; *Vandervell & Co v Lundberg & Sons* (1915) 33 RPC 60. Defences based on the law of the European Union may be pleaded: see eg Case 187/80 *Merck & Co Inc v Stephar BV and Petrus Stephanus Exler* [1981] ECR 2063, [1981] 3 CMLR 463, ECJ (free movement of goods); Case 144/81 *Keurkoop BV v Nancy Kean Gifts BV* [1982] ECR 2853, [1983] 2 CMLR 47, ECJ (no European Community bar to infringement claim where claimant obtained design from abroad); *Merck & Co Inc v Primecrown Ltd* [1997] FSR 237, ECJ. As to a 'Gillette' defence where a defendant establishes either that a registered design did not cover the product in question or that it was invalid because of prior publication see *Carflow Products (UK) Ltd v Linwood Securities (Birmingham) Ltd* [1996] FSR 424 (no breach of registered design, as defendant's design had been registered and disclosed in circumstances of non-confidentiality prior to registration of claimant's design).

2 Where a claim is made for a declaration of invalidity and for the rectification of the register of designs, the claimant must at the same time as serving the other parties, serve a copy of the claim form and accompanying documents on the registrar; and where such documents are served on the registrar, he is entitled to take part in the proceedings: *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 16.1, 16.2.

3 See *Practice Direction--Patents and other Intellectual Property Claims* PD 63 para 16.2. See note 2.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS/770. Expert evidence.

770. Expert evidence.

The place for evidence in registered design cases is very limited¹. Generally speaking 'expert' evidence as to what the ordinary consumer would see in cases involving registered designs for consumer products is unlikely ever to be useful. Litigants should not feel that their case might be disadvantaged by not having an expert in an area when expert evidence is unnecessary. Evidence of technical or factual matters, as opposed to consumer 'eye appeal' can on the other hand, sometimes have a part to play, that would be to give the court information or understanding which it could otherwise not provide itself².

¹ See *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936 at [4], [2008] FSR 208 at [4] per Jacob LJ.

² *Oren v Red Box Toy Factory Ltd* [1999] FSR 785 at [11], [1999] All ER (D) 98 at [11] per Jacob J. See also *Thermos Ltd v Aladdin Sales and Marketing Ltd* [2000] FSR 402, [1999] All ER (D) 1160 per Jacob J at first instance ('in future in registered design actions, I think the court should take care before allowing any expert evidence'); affd [2001] EWCA Civ 667, [2001] All ER (D) 129 (May).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS/771. Claims against the Crown.

771. Claims against the Crown.

Subject to certain statutory restrictions¹, civil proceedings lie against the Crown for an infringement committed by a servant or agent of the Crown², with the authority of the Crown, of the right in a registered design³. Save as so provided, no proceedings lie against the Crown by virtue of the Crown Proceedings Act 1947 in respect of the infringement of the right in a registered design⁴.

¹ Lie subject to the provisions of the Crown Proceedings Act 1947: see **CROWN PROCEEDINGS AND CROWN PRACTICE** vol 12(1) (Reissue) PARA 102 et seq. Thus an injunction may not be granted against the Crown: see s 21(1) proviso (a); and **CROWN PROCEEDINGS AND CROWN PRACTICE** vol 12(1) (Reissue) PARA 134.

² As to the authority of agents generally see **AGENCY** vol 1 (2008) PARA 29 et seq.

³ Crown Proceedings Act 1947 s 3(1)(c) (s 3 substituted by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 4(1)).

⁴ Crown Proceedings Act 1947 s 3(1) (as substituted: see note 3). Nothing in the Crown Proceedings Act 1947 s 3 is to be construed as affecting the rights of a government department under the Registered Designs Act 1949 s 12, Sch 1 (see PARA 728 et seq) or the rights of the Secretary of State under s 5 (see PARA 710): Crown Proceedings Act 1947 s 3(2) (as substituted: see note 3).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(8) RIGHTS ON REGISTRATION; INFRINGEMENT AND THREATS/772. Proceedings for threats.

772. Proceedings for threats.

Where by circulars, advertisements or otherwise any person, whether entitled to or interested in a registered design, threatens¹ any other person with proceedings for infringement of the right in a registered design², any person aggrieved³ thereby may bring a claim⁴ against him for relief⁵. Unless in any such claim the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of the right in a registered design the registration of which is not shown by the claimant to be invalid, the claimant is entitled to the following relief:

- 651 (1) a declaration to the effect that the threats are unjustifiable;
- 652 (2) an injunction⁶ against the continuance of the threats; and
- 653 (3) such damages, if any, as he has sustained thereby⁷.

Proceedings may not, however, be brought in respect of a threat to bring proceedings for infringement alleged to consist of the making or importing of anything⁸.

There is also a common law right of action for malicious falsehood, which may be applicable if the threats have been made in bad faith and, subject to the statutory provision⁹ under which special damage need not be proved, if damage has resulted¹⁰.

1 The essence of a threat (see generally PARA 557 et seq) is an indication that the maker has rights and intends to enforce them: *Rosedale Associated Manufacturers Ltd v Airfix Products Ltd* [1956] RPC 360 (on appeal [1957] RPC 239, CA, the point did not arise). The nature of the interview at which statements are made is relevant in considering whether they amount to threats: see *Paul Trading Co Ltd v J Marksmith & Co Ltd* (1952) 69 RPC 301 at 304. See also *Finkelstein v Billig* (1930) 47 RPC 516 (threats not found).

2 A mere notification that a design is registered does not constitute a threat of proceedings: Registered Designs Act 1949 s 26(3). As to the meaning of 'design' see PARA 734 (current designs) and PARA 740 (old designs). Little more is, however, needed to constitute a threat: see eg *Jaybeam Ltd v Abru Aluminium Ltd* [1976] RPC 308.

3 As to the meaning of 'person aggrieved' cf **JUDICIAL REVIEW** vol 61 (2010) PARA 656. As to the person to whom the threats may be addressed see PARA 560.

4 If he is the registered proprietor of the design, the defendant may counterclaim for infringement and it is then open to the claimant to counterclaim further for rectification of the register: see *Lewis Falk Ltd v Jacobowitz* [1944] Ch 64, 61 RPC 116. As to claims for infringement see PARA 765; and as to counterclaims for rectification see PARA 769.

5 Registered Designs Act 1949 s 26(1) (amended by the Copyright, Designs and Patents Act 1988 s 272, Sch 3 para 15(1), (2)). The Registered Designs Act 1949 s 26 corresponds to the Patents Act 1977 s 70: see PARA 557 et seq.

Where at the trial the defendant admits the threats but counterclaims for relief for infringement, he may have the right to open the case on the questions relating to infringement: see *W Lusty & Sons Ltd v Morris Wilkinson & Co (Nottingham) Ltd* [1954] 2 All ER 347, [1954] 1 WLR 911, 71 RPC 174. The duty falling on the court is to consider what is the fair mode of trying that which is shown to be the substantial matter: see *Pearson v Holden* (1948) 65 RPC 424 at 426.

6 An interim injunction may be granted: see eg *Boneham and Hart v Hirst Bros & Co Ltd* (1917) 34 RPC 209; *International Sales Ltd v TransContinental Trading Co Ltd and Benno Maisel* (1934) 52 RPC 107; *Jaybeam Ltd v Abru Aluminium Ltd* [1976] RPC 308. In *Selsdon Fountain Pen Co Ltd v British Joint Association of Goldsmiths*,

Silversmiths, Horological and Kindred Trades (1950) 67 RPC 108, interlocutory relief was refused on the ground of delay in seeking it.

7 Registered Designs Act 1949 s 26(2) (amended by the Copyright, Designs and Patents Act 1988 Sch 3 para 15(1), (2); and SI 2006/1028).

8 Registered Designs Act 1949 s 26(2A) (added by the Copyright, Designs and Patents Act 1988 Sch 3 para 15(1), (3)). See also *Bowden Controls Ltd v Acco Cable Controls Ltd* [1990] RPC 427.

9 In the Defamation Act 1952 s 3(1): see **LIBEL AND SLANDER** vol 28 (Reissue) PARA 285.

10 See *Barley v Walford* (1846) 9 QB 197; *Jaybeam Ltd v Abru Aluminium Ltd* [1976] RPC 308; cf **LIBEL AND SLANDER** vol 28 (Reissue) PARAS 274, 285.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/773. Community designs in general.

(9) COMMUNITY DESIGNS

773. Community designs in general.

In December 2001, the Member States of the European Union agreed on a regulation creating a community design¹. The regulation creates a system in which a single design application can give protection throughout the European Union. There are two types of community design right: (1) a registered right, which gives monopoly protection to original designs for up to 25 years²; and (2) an unregistered right, which gives protection against deliberate copying of designs for up to three years³.

The unregistered design right has been available since 6 March 2002, and the registered design right since 1 April 2003. Applicants for registered community designs must apply to the Office for Harmonisation in the Internal Market (OHIM)⁴.

1 The EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation'). The Community Design Regulation has been implemented by the Community Design Regulations 2005, SI 2005/2339. A 'community design' is a design which complies with the conditions contained in the Community Design Regulation: art 1.1; Community Design Regulations 2005, SI 2005/2339, reg 1(2). The provisions governing community designs mirror the provisions of the Registered Designs Act 1949 ss 1-1D as substituted and added by the Registered Designs Regulations 2001, SI 2001/3949 (which implemented EC Directive 98/71 of the European Parliament and of the Council on the legal protection of designs (OJ L289, 28.10.1998, p 28)). See *PARAS* 734-739.

2 See *PARA* 774 et seq.

3 See the Community Design Regulation art 1.2. The protection of unregistered community designs is covered elsewhere in this work: see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS**.

4 As to the right to a community design see the Community Design Regulation arts 14-18; as to the effects of a community design see arts 19-26; as to community designs as objects of property see arts 27-34; as to applications for a registered community design see arts 35-44; as to the registration procedure see arts 45-50; as to surrender and invalidity see arts 51-54; as to appeals see arts 55-61; as to procedure before the office see arts 62-78; as to jurisdiction and procedure in legal actions relating to community designs see arts 79-94; as to the effects on member states see arts 95-96. As to the fee payable in respect of an application for a registered community see the Community Design (Fees) Regulations 2002, SI 2002/2942. As to the implementation of the Community Design Regulation and the fees payable to OHIM see EC Commission Regulation 2245/2002 (OJ L341, 17.12.2002, p 28) and EC Commission Regulation 2246/2002 (OJ L341, 17.12.2002, p 54).

UPDATE

773 Community designs in general

NOTE 4--See Case C-32/08 *Fundacion Espanola para la Innovacion de la Artesania (FEIA) v Cul de Sac Espacio Creativo* [2010] Bus LR 466, [2009] All ER (D) 53 (Jul), ECJ (Regulation 6/2002 art 14(3) did not apply to a Community design that had been produced as a result of a commission).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/774. Registrability of community designs.

774. Registrability of community designs.

A design is protected by a registered community design¹, if registered in the required manner². 'Design' means the appearance of the whole or a part of a product³ resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation⁴.

1 See PARA 773. As to the meaning of 'community design' see PARA 773 note 1.

2 EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 1.2(b). The design must be registered in the manner provided for in the Community Design Regulation: see art 1.2(b).

3 'Product' means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs: Community Design Regulation art 3(b). 'Complex product' means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product: art 3(c).

4 Community Design Regulation art 3(a). Cf the Registered Designs Act 1949 s 1(2): see PARA 734.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/775. Requirement of novelty and individual character.

775. Requirement of novelty and individual character.

A registered community design¹ is protected to the extent that it is new and has individual character². For these purposes, a design is new if no identical design or no design whose features differ only in immaterial details has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority³. A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority⁴.

In assessing individual character, the degree of freedom of the designer in developing the design is to be taken into consideration⁵.

A design applied to or incorporated in a product which constitutes a component part of a complex product is only considered to be new and to have individual character (1) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the complex product; and (2) to the extent that those visible features of the component part are in themselves new and have individual character⁶.

1 As to the meaning of 'community design' see PARA 773 note 1.

2 EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 4.1. See also PARA 735.

3 Community Design Regulation art 5.1, 5.2.

For the purpose of applying the Community Design Regulation art 5 (novelty) and art 6 (individual character), a design is deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date of filing of the application for the Community registered design except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community: art 7.1. The 'sector concerned' is that corresponding to the prior art: *Green Lane Products Ltd v PMS International Group Ltd* [2007] EWHC 1712 (Pat), [2007] All ER (D) 305 (Jul); affd [2008] EWCA Civ 358, [2008] All ER (D) 313 (Apr). A disclosure is not to be taken into consideration for the purpose of applying the Community Design Regulation arts 5 and 6 and if a design for which protection is claimed under a registered community design has been made available to the public: (1) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and (2) during the 12-month period preceding the date of filing of the application or, if a priority is claimed, the date of priority: art 7.2. Article 7.2 also applies if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title: art 7.3.

4 Community Design Regulation art 6.1. As to the interpretation of 'informed user' see *Proctor & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2008] FSR 208. See also *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1.

5 Community Design Regulation art 6.2.

6 Community Design Regulation art 4.2. 'Normal use' means use by the end user; but does not include any maintenance, servicing or repair work: art 4.3. As to the meanings of 'product' and 'complex product' see PARA 774 note 3.

UPDATE

775 Requirement of novelty and individual character

NOTE 3--*Green Lane Products*, cited, reported at [2008] EWCA Civ 358, [2009] IP & T 233.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/776. Designs dictated by their technical function.

776. Designs dictated by their technical function.

A registered community design¹ does not subsist in features of appearance of a product² which are solely dictated by the product's technical function³.

1 As to the meaning of 'community design' see PARA 773 note 1.

2 As to the meaning of 'product' see PARA 774 note 3.

3 EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 8.1. See also PARA 737.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/777. The 'must fit' exclusion.

777. The 'must fit' exclusion.

A right in a registered community design¹ does not subsist in features of appearance of a product² which must necessarily be reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against, another product so that either product may perform its function³. However, this does not prevent a community design subsisting in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system⁴.

1 As to the meaning of 'community design' see PARA 773 note 1.

2 As to the meaning of 'product' see PARA 774 note 3.

3 EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 8.2. See also PARA 737.

4 Community Design Regulation art 8.4.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/778. Designs contrary to public policy or morality.

778. Designs contrary to public policy or morality.

A registered community design¹ does not subsist in a design which is contrary to public policy or to accepted principles of morality².

1 As to the meaning of 'community design' see PARA 773 note 1.

2 EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 9.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/779. Infringement proceedings.

779. Infringement proceedings.

In an action for infringement of a community design¹ all such relief by way of damages, injunctions, accounts or otherwise is available to the holder of the community design as is available in respect of the infringement of any other property right².

Where a person: (1) has in his possession, custody or control for commercial purposes³ an infringing article⁴; or (2) has in his possession, custody or control anything specifically designed or adapted for making articles to a particular design which is a community design, knowing or having reason to believe that it has been or is to be used to make an infringing article, the holder of the community design in question may apply to the community design court for an order that the infringing article or other thing be delivered up to him or to such other person as the court may direct⁵. An application may not be made after the end of the period of six years from the date on which the article or thing in question was made, unless during the whole or any part of that period the holder of the community design is under a disability⁶, or is prevented by fraud or concealment from discovering the facts entitling him to apply for an order, in which case an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts⁷.

No order may be made unless the court also makes, or it appears to the court that there are grounds for making, an order as to disposal of infringing articles⁸. A person to whom an infringing article or other thing is delivered up in pursuance of an order for delivery up, if an order as to disposal is not made, must retain it pending the making of an order, or the decision not to make such an order⁹.

An application may be made to the community design court for an order that an infringing article or other thing delivered up in pursuance of an order¹⁰ must be: (a) forfeited to the holder of the community design; or (b) destroyed or otherwise dealt with as the court may think fit, or for a decision that no such order should be made¹¹. In considering what order, if any, should be made, the court must consider whether other remedies available in an action for infringement of the right in a community design would be adequate to compensate the holder and to protect his interests¹². Where there is more than one person interested¹³ in an article or other thing, the court must make such order as it thinks just and may, in particular, direct that the thing be sold, or otherwise dealt with, and the proceeds divided¹⁴. If the court decides that no order should be made, the person in whose possession, custody or control the article or other thing was before being delivered up is entitled to its return¹⁵.

1 As to the meaning of 'community design' see PARA 773 note 1. As to the test for infringement see *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936, [2007] IP & T 464, [2008] FSR 208; *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1; and PARA 763. See also *Green Lane Products Ltd v PMS International Group Ltd* [2007] EWHC 1712 (Pat), [2007] All ER (D) 305 (Jul), [2008] FSR 1; affd [2008] EWCA Civ 358, [2008] All ER (D) 313 (Apr). For the mirror provisions in relation to registered designs protected under the Registered Designs Act 1949 see PARA 767. The defence of innocent infringement is not available in respect of infringement of a community design: *J Choo (Jersey) Ltd v Towerstone Ltd* [2008] EWHC 346 (Ch), [2008] All ER (D) 35 (Jan), [2008] FSR 485.

2 Community Designs Regulations 2005, SI 2005/2339, reg 1A(2) (regs 1A-1D added by SI 2006/1028). The Community Designs Regulations 2005, SI 2005/2339, regs 1A-1D are without prejudice to the duties of the community design court under the provisions of EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 89(1)(a)-(c): Community Designs Regulations 2005, SI 2005/2339, reg 1A(1) (as so added). Where in an action for infringement or for threatened infringement a community design court finds that the defendant has infringed or threatened to infringe a community design, it

must, unless there are special reasons for not doing so, order the following measures: (1) an order prohibiting the defendant from proceeding with the acts which have infringed or would infringe the community design; (2) an order to seize the infringing products; (3) an order to seize materials and implements predominantly used in order to manufacture the infringing goods, if their owner knew the effect for which such use was intended or if such effect would have been obvious in the circumstances: Community Design Regulation art 89(1)(a)-(c).

For the purposes of the Community Design Regulation, the following courts are designated as community design courts: (a) in England and Wales, the High Court and any county court designated as a patents county court under the Copyright, Designs and Patents Act 1988 s 287(1) (see PARA 644); (b) in Scotland, the Court of Session; and (c) in Northern Ireland, the High Court: Community Designs (Designation of Community Design Courts) Regulations 2005, SI 2005/696, reg 2(1); Community Designs Regulations 2005, SI 2005/2339, reg 1(2). For the purpose of hearing appeals from judgments of the courts designated by reg 2(1), the following courts are designated as community design courts: (i) in England and Wales, the Court of Appeal; (ii) in Scotland, the Court of Session; (iii) in Northern Ireland, the Court of Appeal: Community Designs (Designation of Community Design Courts) Regulations 2005, SI 2005/696, reg 2(2); Community Designs Regulations 2005, SI 2005/2339, reg 1(2).

3 The reference to an act being done in relation to an article for 'commercial purposes' are to its being done with a view to the article in question being sold or hired in the course of a business: Community Designs Regulations 2005, SI 2005/2339, reg 1B(7) (as added: see note 2).

4 An article is an infringing article if its making to that design was an infringement of a community design: Community Designs Regulations 2005, SI 2005/2339, reg 1D(1), (2) (as added: see note 2). An article is also an infringing article if: (1) it has been or is proposed to be imported into the United Kingdom; and (2) its making to that design in the United Kingdom would have been an infringement of a community design or a breach of an exclusive licensing agreement relating to that community design: reg 1D(3) (as added: see note 2). As to the meaning of 'United Kingdom' see PARA 303 note 5. Where it is shown that an article is made to a design which is or has been a community design, it is presumed until the contrary is proved that the article was made at a time when the right in the community design subsisted: reg 1D(4) (as added: see note 2). Nothing in reg 1D(3) is to be construed as applying to an article which may be lawfully imported into the United Kingdom by virtue of an enforceable Community right within the meaning of the European Communities Act 1972 s 2(1): Community Designs Regulations 2005, SI 2005/2339, reg 1D(5) (as added: see note 2).

5 Community Designs Regulations 2005, SI 2005/2339, reg 1B(1) (as added: see note 2). Nothing in reg 1B affects any other power of the court: reg 1B(8) (as added: see note 2). As to the community design court see note 2.

6 For this purpose, 'disability', in England and Wales, has the same meaning as in the Limitation Act 1980 (see **LIMITATION PERIODS** vol 68 (2008) PARA 1170) and, in Northern Ireland, has the same meaning as in the Statute of Limitations (Northern Ireland) 1958: Community Designs Regulations 2005, SI 2005/2339, reg 1B(5) (as added: see note 2).

7 Community Designs Regulations 2005, SI 2005/2339, reg 1B(2), (3), (4) (as added: see note 2).

8 Community Designs Regulations 2005, SI 2005/2339, reg 1B(2) (as added: see note 2). An order as to disposal of infringing articles is made under reg 1C: see the text and notes 10-15.

9 Community Designs Regulations 2005, SI 2005/2339, reg 1B(6) (as added: see note 2).

10 Is an order under the Community Designs Regulations 2005, SI 2005/2339, reg 1B: see the text and notes 1-9.

11 Community Designs Regulations 2005, SI 2005/2339, reg 1C(1) (as added: see note 2).

12 Community Designs Regulations 2005, SI 2005/2339, reg 1C(2) (as added: see note 2).

13 References to a person having an interest in an article or other thing include any person in whose favour an order could be made in respect of it under the Community Designs Regulations 2005, SI 2005/2339, reg 1C, under the Registered Designs Act 1949 s 24D (see PARA 767), under the Copyright, Designs and Patents Act 1988 ss 114, 204, 231 (see **COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS** vol 9(2) (2006 Reissue) PARAS 535, 713) or s 231 (see PARA 535), under the Trade Marks Act 1994 s 19 (including that provision as applied by the Community Trade Mark Regulations 2006, SI 2006/1027, reg 4 (see **TRADE MARKS AND TRADE NAMES** vol 48 (2007 Reissue) PARA 463)): Community Designs Regulations 2005, SI 2005/2339, reg 1C(5) (as added: see note 2).

14 Community Designs Regulations 2005, SI 2005/2339, reg 1C(3) (as added: see note 2).

15 Community Designs Regulations 2005, SI 2005/2339, reg 1C(4) (as added: see note 2).

UPDATE

779 Infringement proceedings

NOTE 1--*Green Lane Products*, cited, reported at [2008] EWCA Civ 358, [2009] IP & T 233.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/780. Remedy for groundless threats of infringement proceedings.

780. Remedy for groundless threats of infringement proceedings.

Where any person (whether entitled to or interested in a community design¹ or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a community design², any person aggrieved thereby may bring an action against him for relief³. The claimant is entitled to the following relief: (1) a declaration to the effect that the threats are unjustifiable; (2) an injunction against the continuance of the threats; and (3) such damages, if any, as he has sustained by reason of the threats⁴. However, if the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a registered community design the claimant is entitled to the relief claimed only if he shows that the registration is invalid⁵.

Proceedings may not be brought in respect of a threat to bring proceedings for an infringement alleged to consist of the making or importing of anything⁶.

1 As to the meaning of 'community design' see PARA 773 note 1.

2 Mere notification that a design is a registered community design does not constitute a threat of proceedings for these purposes: Community Designs Regulations 2005, SI 2005/2339, reg 2(6).

3 Community Designs Regulations 2005, SI 2005/2339, reg 2(1). For the mirror provisions in relation to registered designs protected under the Registered Designs Act 1949 see PARA 772.

4 Community Designs Regulations 2005, SI 2005/2339, reg 2(2).

5 Community Designs Regulations 2005, SI 2005/2339, reg 2(3). In relation to a design protected by virtue of an international registration designating the Community, the reference to a registration being invalid includes a reference to the effects of the international registration being declared invalid: Community Designs Regulations 2005, SI 2005/2339, reg 2(6A) (added by SI 2007/3378). As to international registration see PARA 784.

6 Community Designs Regulations 2005, SI 2005/2339, reg 2(5).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/781. Falsely representing a design as a registered community design.

781. Falsely representing a design as a registered community design.

It is an offence for a person falsely to represent that a design applied to, or incorporated in, any product sold by him is a registered community design¹. It is also an offence for a person, after a registered community design has expired, to represent, expressly or by implication, that a design applied to, or incorporated in, any product sold is still registered as a community design².

1 Community Designs Regulations 2005, SI 2005/2339, reg 3(1). As to the meaning of 'community design' see PARA 773 note 1. A person guilty of such an offence is liable on summary conviction to a fine not exceeding level 3 on the standard scale: reg 3(3). As to the standard scale see PARA 609 note 2.

2 Community Designs Regulations 2005, SI 2005/2339, reg 3(2). A person guilty of such an offence is liable on summary conviction to a fine not exceeding level 1 on the standard scale: reg 3(4).

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/782. Privileged communications.

782. Privileged communications.

Any communication as to any matter relating to the protection of any design between a person and his professional designs representative¹, or for the purposes of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his professional designs representative, is privileged from disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his solicitor².

1 'Professional designs representative' means a person who is on the special list of professional representatives for design matters referred to in EC Council Regulation 6/2002 on Community Designs (OJ L3, 5.1.2002, p 1) (the 'Community Design Regulation') art 78: Community Designs Regulations 2005, SI 2005/2339, reg 4(3).

2 Community Designs Regulations 2005, SI 2005/2339, reg 4(1), (2). As to privileged communications between a person and his solicitor see **CONFIDENCE AND DATA PROTECTION** vol 8(1) (2003 Reissue) PARA 453; **LEGAL PROFESSIONS** vol 65 (2008) PARA 740-741.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(9) COMMUNITY DESIGNS/783. Use of community designs for services of the Crown.

783. Use of community designs for services of the Crown.

A government department, or a person authorised in writing by a government department, may without the consent of the holder of a community design¹: (1) do anything for the purpose of supplying products for the services of the Crown²; or (2) dispose of products no longer required for the services of the Crown; and nothing done by virtue of these provisions infringes the community design³.

The authority of a government department in respect of Crown use⁴ of a community design may be given to a person either before or after the use and whether or not he is authorised, directly or indirectly, by the holder of the community design to do anything in relation to the design⁵. A person acquiring anything sold in the exercise of such powers, and any person claiming under him, may deal with it in the same manner as if the Crown was the holder of the community design⁶.

Provision is made as to the settlement of terms for Crown use⁷, the rights of third parties in case of Crown use⁸, compensation for loss of profit⁹ and the reference of disputes relating to Crown use¹⁰.

1 As to the meaning of 'community design' see PARA 773 note 1.

2 References for this purpose to 'services of the Crown' are limited to those which are necessary for essential defence or security needs: Community Designs Regulations 2005, SI 2005/2339, reg 5, Schedule para 1(2).

3 Community Designs Regulations 2005, SI 2005/2339, Schedule para 1(1).

4 'Crown use', in relation to a community design, means the doing of anything by virtue of the provisions set out in the text which would otherwise be an infringement of the community design: Community Designs Regulations 2005, SI 2005/2339, Schedule para 1(3).

5 Community Designs Regulations 2005, SI 2005/2339, Schedule para 1(4).

6 Community Designs Regulations 2005, SI 2005/2339, Schedule para 1(5).

7 See the Community Designs Regulations 2005, SI 2005/2339, Schedule para 2.

8 See the Community Designs Regulations 2005, SI 2005/2339, Schedule para 3.

9 See the Community Designs Regulations 2005, SI 2005/2339, Schedule para 4.

10 See the Community Designs Regulations 2005, SI 2005/2339, Schedule para 5.

Halsbury's Laws of England/PATENTS AND REGISTERED DESIGNS (VOLUME 79 (2008) 5TH EDITION)/12. REGISTERED DESIGNS/(10) INTERNATIONAL REGISTRATION/784-800.
International registration.

(10) INTERNATIONAL REGISTRATION

784-800. International registration.

The Hague System of international registrations of industrial designs is applicable among the countries party to the Hague Agreement¹. It is administered by the International Bureau of the World Intellectual Property Organisation (WIPO) located in Geneva, Switzerland². The Hague system allows the owner of an industrial design to have his design protected in several countries by filing a single application with the International Bureau of WIPO, in one language, with one set of fees in one currency³. An international registration produces the same effects in each of the designated countries as if the design had been registered there directly unless protection is refused by the competent office of that country⁴.

The Hague System also simplifies the subsequent management of the industrial design, since it is possible to record subsequent changes or to renew the registration through a simple single procedural step with the International Bureau of WIPO⁵.

1 I.e the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (2 July 1999). The European Community acceded to the Geneva Act on 1 January 2008: see EC Council Decision 954/2006 (OJ L386, 29.12.2006, p 28).

2 See the Geneva Act art 22.

3 See the Geneva Act Ch I (arts 3-18).

4 See the Geneva Act art 14.

5 See the Geneva Act art 16.